No. 18-302	
Title:	**Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, Patent and Trademark Office, Petitioner** **v.** **Erik Brunetti**
Docketed:	September 7, 2018
Linked with 18A15	
Lower Ct:	United States Court of Appeals for the Federal Circuit
Case Numbers:	(2015-1109)
Decision Date:	December 15, 2017
Rehearing Denied:	April 12, 2018
Questions Presented	

DATE	PROCEEDINGS AND ORDERS
Jun 29 2018	Application (18A15) to extend the time to file a petition for a writ of certiorari from July 11, 2018 to August 10, 2018, submitted to The Chief Justice. **Main Document** **Lower Court Orders/Opinions** **Proof of Service**
Jul 05 2018	Application (18A15) granted by The Chief Justice extending the time to file until August 10, 2018.
Jul 31 2018	Application (18A15) to extend further the time from August 10, 2018 to September 7, 2018, submitted to The Chief Justice. **Written Request** **Proof of Service**
Aug 01 2018	Application (18A15) granted by The Chief Justice extending the time to file until September 7, 2018.
Sep 07 2018	Petition for a writ of certiorari filed. (Response due October 9, 2018) **Petition** **Proof of Service**
Sep 28 2018	Motion to extend the time to file a response from October 9, 2018 to November 8, 2018, submitted to The Clerk. **Main Document** **Proof of Service**
Oct 02 2018	Motion to extend the time to file a response is granted and the time is extended to and including November 8, 2018.
Nov 08 2018	Brief of respondent Erik Brunetti filed.

	Main Document **Other** **Proof of Service**
Nov 28 2018	DISTRIBUTED for Conference of 1/4/2019.
Dec 11 2018	Reply of petitioners Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office filed. (Distributed) **Proof of Service** **Main Document**
Jan 04 2019	Petition GRANTED.
Feb 11 2019	SET FOR ARGUMENT on Monday, April 15, 2019
Feb 15 2019	Joint appendix filed. **Main Document** **Proof of Service**
Feb 15 2019	Brief of petitioner Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office filed. **Proof of Service** **Main Document**
Feb 19 2019	Brief amicus curiae of Kurt M. Anderson filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Feb 19 2019	Consents for amicus brief of Kurt M. Anderson not accepted for filing. (March 04, 2019 – Document not of the type that is to be filed electronically)
Feb 25 2019	Brief amicus curiae of The American Intellectual Property Law Association in support of neither party filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Feb 26 2019	Brief amicus curiae of New York Intellectual Property Law Association in support of neither party filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Mar 18 2019	Brief of respondent Erik Brunetti filed. **Main Document** **Other** **Certificate of Word Count** **Proof of Service**
Mar 20 2019	CIRCULATED
Mar 21 2019	Record requested from the U.S.C.A. Federal Circuit.
Mar 21 2019	Brief amicus curiae of Pacific Legal Foundation filed. (Distributed) **Main Document** **Certificate of Word Count** **Proof of Service**
Mar 22 2019	Brief amicus curiae of Simon Tam filed. (Distributed)

	Main Document	**Certificate of Word Count**	**Proof of Service**
Mar 25 2019	Brief amici curiae of Professors Barton Beebe and Jeanne Fromer filed. (Distributed)		
	Main Document	**Certificate of Word Count**	**Proof of Service**
Mar 25 2019	Brief amicus curiae of The Rutherford Institute filed. (Distributed)		
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Mar 25 2019	Brief amici curiae of American Civil Liberties Union and the ACLU of the District of Columbia filed. (Distributed)		
	Main Document	**Proof of Service**	
Mar 25 2019	Brief amici curiae of The Cato Institute, et. al. filed. (Distributed)		
	Main Document	**Certificate of Word Count**	**Proof of Service**
Mar 25 2019	Brief amicus curiae of International Trademark Association filed. (Distributed)		
	Main Document	**Certificate of Word Count**	**Proof of Service**
Mar 27 2019	Record from the U.S.C.A. Federal Circuit is electronic and located on Pacer.		
Apr 02 2019	Reply of petitioner Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office filed. (Distributed)		
	Proof of Service	**Main Document**	
Apr 15 2019	Argued. For petitioner: Malcolm L. Stewart, Deputy Solicitor General, Department of Justice, Washington, D. C. For respondent: John R. Sommer, Irvine, Cal.		
Jun 24 2019	Adjudged to be AFFIRMED. Kagan, J., delivered the **opinion** of the Court, in which Thomas, Ginsburg, Alito, Gorsuch and Kavanaugh, JJ., joined. Alito, J., filed a concurring opinion. Roberts, C. J., and Breyer, J., filed opinions concurring in part and dissenting in part. Sotomayor, J., filed an opinion concurring in part and dissenting in part, in which Breyer, J., joined.		

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No.

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter." The question presented is as follows:

Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

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In the Supreme Court of the United States

No.

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

The Solicitor General, on behalf of the Director of the United States Patent and Trademark Office, respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (App., *infra*, 1a-54a) is reported at 877 F.3d 1330. The opinion of the Trademark Trial and Appeal Board (App., *infra*, 55a-67a) is available at 2014 WL 3976439.

JURISDICTION

The judgment of the court of appeals was entered on December 15, 2017. A petition for rehearing was denied on April 12, 2018 (App., *infra*, 68a-69a). On July 5, 2018, the Chief Justice extended the time within which to file

a petition for a writ of certiorari to and including August 10, 2018. On July 31, 2018, the Chief Justice further extended the time to and including September 7, 2018. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The First Amendment to the Constitution provides, in relevant part: "Congress shall make no law * * * abridging the freedom of speech." U.S. Const. Amend. I. Section 1052 of Title 15 of the United States Code is reproduced in the appendix to this petition. App., *infra*, 70a-73a.

STATEMENT

This case involves a facial First Amendment challenge to a century-old provision of federal trademark law that directs the United States Patent and Trademark Office (USPTO) to refuse registration of trademarks containing "scandalous" or "immoral" matter. 15 U.S.C. 1052(a). Respondent sought federal registration for the mark FUCT in connection with a clothing line. The USPTO refused registration under Section 1052(a) on the ground that the mark would be perceived as equivalent to the vulgar word for which it is a homonym. App., *infra*, 55a-67a. The court of appeals held that Section 1052(a)'s ban on federal registration of scandalous or immoral marks is facially invalid under the First Amendment. *Id.* at 1a-54a.

1. A trademark is a "word, name, symbol, or device" used by a person "to identify and distinguish his or her goods" in commerce and "to indicate the source of the goods." 15 U.S.C. 1127. "[T]rademarks desirably promote competition and the maintenance of product quality." *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*,

469 U.S. 189, 193 (1985). Trademark law also protects the public by preventing competing merchants from misleading consumers through the use of confusingly similar marks, see, *e.g.*, *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992), and by favoring marks that "reduce[] the customer's costs of shopping and making purchasing decisions," *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 163-164 (1995) (citation omitted).

Federal law does not create trademark rights. See *Matal* v. *Tam*, 137 S. Ct. 1744, 1751 (2017); *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Rather, trademarks have been protected by the common law and in equity since the founding, and that protection continues today through the common law and statutes of many States. *Tam*, 137 S. Ct. at 1751. Federal law, however, has long provided an additional layer of trademark protection. See Act of Feb. 20, 1905 (1905 Act), ch. 592, 33 Stat. 724; Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 210-212.

Since 1946, that federal protection has been provided through the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*). Under the Lanham Act, certain federal remedies for infringement, dilution, and unfair competition are available to owners of all marks used in interstate or foreign commerce, regardless of whether a mark is registered. See 15 U.S.C. 1125(a) (federal cause of action for representations about the origin of goods or services that are likely to confuse consumers); 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(d) (remedy for cybersquatting); see also *Tam*, 137 S. Ct. at 1752 (federal cause of action for infringement applies to all mark owners).

Congress has also created a federal registration program that confers additional benefits on owners of registered marks. See *Tam*, 137 S. Ct. at 1752. Registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with certain goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). Registration also authorizes registrants to use the ® symbol, 15 U.S.C. 1111, and provides constructive notice of the registrant's claim of ownership of the mark, 15 U.S.C. 1072. After a mark has been registered for five years, an owner's right to use it can become "incontestable" and may be challenged only on very limited grounds. 15 U.S.C. 1065, 1115(b).

The Lanham Act authorizes registration of trademarks that are "used in commerce" and meet certain criteria. 15 U.S.C. 1051(a)(1); see 15 U.S.C. 1052 (directing the USPTO to "refuse[] registration" of certain marks "on account of [their] nature"). This case concerns one of the requirements for federal trademark registration—namely, that the mark not consist of or comprise "immoral" or "scandalous" matter. 15 U.S.C. 1052(a).[1] The ban on federal registration of scandalous marks predates the Lanham Act, and it has been a feature of federal trademark-registration programs since 1905. See 1905 Act § 5, 33 Stat. 725. Although the Lanham Act separately bars registration of "scandalous" and "immoral" marks, the USPTO has long treated the

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[1] Other criteria include that the marks not be deceptive, 15 U.S.C. 1052(a); not contain a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); not include a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); not so resemble other marks as to create a likelihood of confusion, 15 U.S.C. 1052(d); not be merely descriptive, 15 U.S.C. 1052(e)(1); and not be functional, 15 U.S.C. 1052(e)(5).

two terms as composing a single category, and we accordingly refer to them collectively as the "scandalous marks" provision.

To determine whether that ban applies to a particular mark, the USPTO asks whether a "'substantial composite of the general public' would find the mark scandalous." App., *infra*, 3a (citation omitted). The USPTO generally defines "scandalous" as "'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation.'" *Ibid.* (citation omitted). The agency understands, and the Federal Circuit has held, that the term includes "[v]ulgar" marks, *i.e.*, those "'lacking in taste, indelicate, [and] morally crude.'" *Ibid.* (citation omitted; second set of brackets in original). Over the years, the USPTO has refused to register a variety of vulgar and lewd marks based on this provision.[2]

2. This case arises from the USPTO's refusal of respondent Erik Brunetti's application to register the mark "FUCT" for his clothing line. Respondent has used the mark in connection with his clothing line since 1990. App., *infra*, 4a. In 2011, he applied for the first time for federal registration of the mark. *Ibid.* A USPTO examining attorney refused registration under Section 1052(a), based on evidence showing that FUCT will be perceived as a scandalous term. See C.A. App. A78-A87, A201-A260.

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[2] A sample of particularly offensive marks that were submitted to the USPTO and that were refused registration under the scandalous-marks provision can be found in the appendix to the government's supplemental brief in the court of appeals. See U.S. C.A. Suppl. Letter Br. Add. 1 (July 20, 2017).

The USPTO's Trademark Trial and Appeal Board (Board) affirmed. App., *infra*, 55a-67a. The Board observed that respondent used the mark in connection with apparel and promotional material displaying "strong, and often explicit, sexual imagery that objectifies women and offers degrading examples of extreme misogyny." *Id.* at 63a-64a. It found that respondent's use of the mark would "be perceived by his targeted market segment" as the obscene word for which it is a homonym. *Id.* at 64a. The Board concluded on that basis that the mark was vulgar and therefore unregistrable under 15 U.S.C. 1052(a). App., *infra*, 67a. Although respondent argued that the scandalous-marks provision violated the First Amendment, the Board explained that determining the constitutionality of the provision was beyond its statutory authority. *Ibid.*

3. a. Respondent sought review of the Board's decision in the Federal Circuit. While the case was pending in the court of appeals, this Court issued its decision in *Matal* v. *Tam*, *supra*, concerning the constitutionality of Section 1052(a)'s ban on registration of "disparag[ing]" trademarks, 15 U.S.C. 1052(a). All eight Justices who participated in *Tam* agreed that the disparagement provision was facially invalid under the First Amendment, but no single rationale commanded a majority of the Court. See 137 S. Ct. at 1751.

b. After supplemental briefing and re-argument in light of *Tam*, the court of appeals reversed the Board's decision in this case. App., *infra*, 1a-46a. The court first upheld the Board's determination that respondent's mark is "scandalous" under Section 1052(a). *Id.* at 6a-10a. The court held that substantial evidence supported the Board's findings that respondent's mark is a "'phonetic twin'" of a vulgar term, and that a "'substantial

composite' of the American public would find the mark vulgar." *Id.* at 6a-7a, 9a (citation omitted). The court further held that, given those findings, federal registration of the mark was barred by Section 1052(a)'s scandalous-marks provision. *Id.* at 9a-10a.

The court of appeals concluded, however, that Section 1052(a)'s scandalous-marks provision is facially invalid under the First Amendment. App., *infra*, 11a-46a. While assuming *arguendo* that the ban on registration of scandalous marks is viewpoint-neutral, the court held that "the provision impermissibly discriminates based on content in violation of the First Amendment." *Id.* at 14a. In reaching that conclusion, the court began from the premise that content discrimination of any kind is subject to strict scrutiny unless some alternative First Amendment framework applies. *Id.* at 15a. The court then rejected each of the government's arguments that the statutory criteria for obtaining the benefits of federal trademark registration should not receive the same First Amendment scrutiny that applies to a content-based prohibition on speech.

The court of appeals rejected the government's argument that the trademark-registration program should be analyzed as a government subsidy for marks that the government wishes to promote, rather than as a restriction on the marks that are excluded. App., *infra*, 16a-22a. The court distinguished prior decisions recognizing Congress's broad authority to define the scope of government programs, *e.g.*, *Rust* v. *Sullivan*, 500 U.S. 173 (1991), on the ground that "[t]rademark registration does not implicate Congress' power to spend funds." App., *infra*, 19a. The court concluded that government-subsidy case law does not apply out-

side the Spending Clause context, and that the trademark-registration program is not a spending program. *Id.* at 21a-22a. The court also distinguished precedents related to limited public forums, *id.* at 22a-28a, concluding that limited-public-forum principles apply only when the government restricts speech on its own property, *id.* at 25a.

Having rejected the subsidy and limited-public-forum-frameworks, the court of appeals analyzed the scandalous-marks provision as a direct restriction on speech. The court concluded that the ban on registering scandalous marks regulates speech based on its expressive (and not just commercial) content; that it is not related to the trademark-registration program's commercial purpose of facilitating source identification; and that it is therefore subject to strict scrutiny. App., *infra*, 29a-31a. Noting that the government had not suggested that the provision could survive strict scrutiny, the court concluded that the scandalous-marks provision was facially invalid. *Id.* at 31a.

In the alternative, the court of appeals concluded that the scandalous-marks provision could not survive under the First Amendment standards that apply to regulation of commercial speech. App., *infra*, 31a-42a; see *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 566 (1980) (explaining that First Amendment analysis of restrictions on commercial speech turns on whether (1) the speech being regulated concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) the regulation is "more extensive than is necessary to serve that interest"). The court concluded that the

government has no legitimate substantial interest in declining to encourage graphic sexual images as source identifiers in commerce, because registration does not associate the government with those marks and because speech cannot be suppressed merely because it will be off-putting to others. App., *infra*, 32a-38a. The court further held that, even if the government interest in declining to promote the use of such marks were viewed as legitimate, refusing to register those marks would not advance the government's interest because it would not meaningfully reduce the prevalence of similar terms and images in society at large. *Id.* at 38a-39a. The court further found that the refusal to register scandalous marks mandated by Section 1052(a) is not sufficiently tailored to the government's interest because there is no clear standard for determining which marks are "scandalous," and the USPTO has applied the provision inconsistently in the past. *Id.* at 39a-41a.

c. Judge Dyk concurred in the judgment. App., *infra*, 47a-54a. He "agree[d] with the majority" that this Court's decision in *Tam* "does not dictate the facial invalidity of the immoral-scandalous provision." *Id.* at 47a. Rather than resolve the "serious First Amendment questions" left open in *Tam*, however, Judge Dyk would have avoided those issues by construing the bar on registration of scandalous marks as applicable only to obscene material that is unprotected by the First Amendment. *Id.* at 48a. Judge Dyk concluded that respondent would prevail under that construction "[b]ecause there is no suggestion that Mr. Brunetti's mark is obscene." *Id.* at 54a.

4. The court of appeals denied the government's petition for rehearing en banc without noted dissent. App., *infra*, 68a-69a.

REASONS FOR GRANTING THE PETITION

The court of appeals held that the ban on registration of scandalous trademarks imposed by Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), is facially unconstitutional. That holding is incorrect and warrants this Court's review.

The scandalous-marks provision does not prohibit any speech, proscribe any conduct, or restrict the use of any trademark. Nor does it restrict a mark owner's common-law trademark protections. Rather, it simply directs the USPTO to refuse, on a viewpoint-neutral basis, to provide the benefits of federal registration to scandalous marks. Although this Court recently concluded in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), that a different provision of Section 1052(a) was facially unconstitutional, no rationale garnered the assent of a majority of the Court, and neither of the lead opinions in *Tam* endorsed the approach that the court of appeals adopted here. Under the proper analysis, the First Amendment does not prohibit Congress from making vulgar terms and graphic sexual images ineligible for federal trademark registration.

The statutory provision at issue here has guided the USPTO's decisions for 113 years. Absent this Court's review, the ruling below will effectively preclude the USPTO from enforcing Section 1052(a)'s scandalous-marks provision nationwide because any applicant who is refused trademark registration may seek review of the USPTO's decision in the Federal Circuit. The petition for a writ of certiorari should be granted.

I. THE COURT OF APPEALS' INVALIDATION OF AN ACT OF CONGRESS WARRANTS THIS COURT'S REVIEW

The court of appeals held that Section 1052(a)'s ban on federal registration of immoral or scandalous marks

is facially unconstitutional. See App., *infra*, 46a. Facial invalidation of a statute under the First Amendment is "strong medicine" that should be employed "sparingly and only as a last resort." *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613 (1973). And any decision invalidating an Act of Congress on constitutional grounds is significant. See *Rostker* v. *Goldberg*, 453 U.S. 57, 64 (1981) (noting that judging the constitutionality of an Act of Congress is "the gravest and most delicate duty that this Court is called upon to perform") (quoting *Blodgett* v. *Holden*, 275 U.S. 142, 148 (1927) (Holmes, J.)). This Court has often reviewed holdings that a federal law is invalid under the First Amendment, even in the absence of a circuit split. See, *e.g.*, *Tam*, 137 S. Ct. at 1755; *United States* v. *Alvarez*, 567 U.S. 709, 715 (2012); *Holder* v. *Humanitarian Law Project*, 561 U.S. 1, 14 (2010); *United States* v. *Stevens*, 559 U.S. 460, 467 (2010); *United States* v. *Williams*, 553 U.S. 285, 292 (2008); *Ashcroft* v. *ACLU*, 542 U.S. 656, 664 (2004).

Under the decision below, the USPTO may not invoke Section 1052(a) to refuse registration of even the most "shocking" graphic sexual imagery and marks that the court of appeals acknowledged are "lewd, crass, or even disturbing." App., *infra*, 45a-46a. More generally, by treating eligibility criteria for participation in a voluntary federal program as constitutionally equivalent to affirmative restrictions on speech, the court of appeals has cast doubt on Congress's ability to determine when the federal government will lend its assistance to private actors. That decision warrants this Court's review.

II. THE COURT OF APPEALS ERRED IN HOLDING THAT THE SCANDALOUS-MARKS PROVISION IS UNCONSTITUTIONAL

In prohibiting the federal registration of "immoral" or "scandalous" trademarks, Section 1052(a) does not restrict any speech or restrain any form of expression. The scandalous-marks provision simply reflects Congress's judgment that the federal government should not affirmatively promote the use of graphic sexual images and vulgar terms by granting them the benefits of registration. The First Amendment does not prohibit Congress from making that judgment.

A. This Court's Decision In *Matal* v. *Tam* Is Not Controlling Here

In *Tam*, this Court held that the disparagement provision in Section 1052(a)—which prohibits registration of marks that "disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute"—violates the First Amendment. 137 S. Ct. at 1751, 1753 (citation omitted). No rationale garnered the assent of a majority of the Court, however, and neither of the lead opinions supports the court of appeals' analysis here.

1. All eight Justices who participated in *Tam* agreed that federal trademark registration confers important legal rights and benefits, and that the trademark-registration program is not government speech. 137 S. Ct. at 1757-1760. But the rest of the Court's analysis was split between two opinions, neither of which secured a majority.

Justice Alito, writing in relevant part for four Justices, rejected the government's arguments that the trademark-registration program should be analyzed

under the framework applicable to government subsidies. *Tam*, 137 S. Ct. at 1760-1761. He further concluded that the disparagement provision discriminates based on viewpoint and could not be sustained as a permissible limitation on a government program or limited public forum. *Id.* at 1762-1763. Finally, Justice Alito assumed without deciding that restrictions on trademark registration should be analyzed under the standard applicable to restrictions on commercial speech, and he concluded that the disparagement provision could not be sustained because it was not sufficiently tailored to a substantial governmental interest. *Id.* at 1763-1765.

Justice Kennedy, writing on behalf of the four remaining Justices, concurred on narrower grounds. Those Justices did not reject the government's argument that the trademark-registration program is properly analyzed as a government subsidy. Rather, they concluded that the disparagement provision "constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny"—and that such discrimination made it unnecessary to further consider the appropriate framework for evaluating the constitutionality of Section 1052(a)'s criteria for federal registration. *Tam*, 137 S. Ct. at 1765; see *id.* at 1768 ("[T]he Court's precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf.").[3]

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[3] Although Justice Thomas joined Justice Alito's First Amendment analysis in full, he also filed a short concurrence expressing the view that the disparagement provision should be subject to strict scrutiny even if it affects only commercial speech. *Tam*, 137 S. Ct. at 1769.

2. a. This Court's decision in *Tam* is not controlling here. See App., *infra*, 14a; *id.* at 47a-48a (Dyk, J., concurring). Because Justice Kennedy found that the disparagement provision discriminates based on viewpoint, he reserved "the question of how other [viewpoint-neutral] provisions of the Lanham Act should be analyzed under the First Amendment." *Tam*, 137 S. Ct. at 1768. And while Justice Alito addressed the government's arguments in greater detail, most of his opinion did not speak for the Court, and both the portions that did and those that did not command a majority emphasized the viewpoint-discriminatory character of the disparagement provision. See *id.* at 1758, 1760 (majority op.); *id.* at 1763 (Alito, J.).

Although the court of appeals expressed doubt on the point, App., *infra*, 14a, it ultimately did not break with the significant body of precedent holding that restrictions on the use of profanity and sexual images are viewpoint neutral. See, *e.g.*, *Bethel Sch. Dist. No. 403* v. *Fraser*, 478 U.S. 675, 685 (1986) (describing "lewd and indecent speech" that was "unrelated to any political viewpoint"); *Perry* v. *McDonald*, 280 F.3d 159, 170 (2d Cir. 2001) (holding that prohibition on using "combination of letters that stands in part for the word 'shit' . . . does not discriminate on the basis of viewpoint"); *General Media Commc'ns, Inc.* v. *Cohen*, 131 F.3d 273, 276 (2d Cir. 1997) ("Congress has regulated * * * a particular subject matter—lascivious depictions of nudity including sexual or excretory activities or organs—not those reflecting particular viewpoints."), cert. denied, 524 U.S. 951 (1998); *id.* at 280-282; *PMG Int'l Div., L.L.C.* v. *Rumsfeld*, 303 F.3d 1163, 1171 (9th Cir. 2002) (similar). By prohibiting the registration of such terms

by all commercial actors, the scandalous-marks provision does not affect expression on only one side of "an otherwise includible subject." *Tam*, 137 S. Ct. at 1766 (Kennedy, J.) (citation omitted). Nor is the "motivating ideology or the opinion or perspective of the speaker" the rationale for the limitation. *Rosenberger* v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). The scandalous-marks provision precludes the federal registration of respondent's mark not because of any view, opinion, or perspective expressed by that mark, but because respondent "us[ed] a combination of letters that stands * * * for" a vulgar and obscene term. *Perry*, 280 F.3d at 170.

b. Relying in part on *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015), the court of appeals stated that "[c]ontent-based statutes are presumptively invalid" and "must withstand strict scrutiny" in order to survive First Amendment review. App., *infra*, 15a. That reasoning closely tracks the Federal Circuit's prior analysis in *Tam*. See *In re Tam*, 808 F.3d 1321, 1339 (2016) (en banc) ("Because § 2(a) discriminates on the basis of the content of the message conveyed by the speech, it follows that it is presumptively invalid, and must satisfy strict scrutiny to be found constitutional."). But when *Tam* reached this Court, neither of the lead opinions concluded that strict scrutiny applies to viewpoint-neutral limitations on the registrability of trademarks. Indeed, content-based restrictions on registration are a longstanding feature of federal trademark law, including in provisions that have never been viewed as constitutionally suspect. See p. 4 n.1, *supra*.

B. Section 1052(a) Does Not Restrict Speech

Properly analyzed, Section 1052(a)'s bar on federal registration of scandalous marks is not an unconstitutional "abridg[ement of] the freedom of speech." U.S. Const. Amend. I.

1. Section 1052(a) does not restrict the terms or images that may lawfully be used as trademarks. A trademark is "any word, name, symbol, or device" used by a person "to identify and distinguish his or her goods" in commerce and "to indicate the source of the goods." 15 U.S.C. 1127. Trademark rights are created not by federal law, but by use of a mark to identify goods and services in commerce. See *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015) (explaining that "federal law does not create trademarks"; rather, a person who "first uses a distinct mark in commerce * * * acquires rights to that mark"); see also *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

Even without federal registration, respondent may use vulgar terms or symbols to identify his goods in commerce, and he may seek to enforce his chosen mark in both state and federal courts against others whom he believes have misused it or have misappropriated any goodwill associated with it. Respondent may invoke both common-law protections and Lanham Act remedies, such as a cause of action for false association, 15 U.S.C. 1125(a); a prohibition on importing goods bearing confusingly similar marks, 15 U.S.C. 1125(b); protection against cybersquatting, 15 U.S.C. 1125(d); and authorization of treble-damages awards for certain types of infringement, 15 U.S.C. 1117(a). See *Tam*, 137 S. Ct. at 1752-1753.

2. The court of appeals therefore erred in treating Section 1052(a)'s scandalous-marks provision as an affirmative restriction on speech. Section 1052 defines the categories of marks that are not "registrable on [the] principal register." 15 U.S.C. 1052. If a mark does not satisfy the statutory criteria, the only consequence is that it is refused registration. Although refusal of registration renders certain federal benefits unavailable, "a valid trademark may still be used in commerce." *Tam*, 137 S. Ct. at 1752.

Since 1990, respondent has used and promoted his unregistered mark in connection with his clothing line. App., *infra*, 4a. Indeed, the court of appeals recognized that, "[r]egardless of whether a trademark is federally registered, an applicant can still brand clothing with his mark, advertise with it on the television or radio, or place it on billboards along the highway." *Id.* at 38a. The court counter-intuitively concluded, however, that this fact weighed *against* the constitutionality of the scandalous-marks provision, on the theory that the registration ban would do little to reduce the prevalence of scandalous commercial speech. *Id.* at 38a-39a.

Citing this Court's decision in *United States* v. *Playboy Entertainment Group, Inc.*, 529 U.S. 803 (2000), the court of appeals found that strict scrutiny presumptively applies to any content-based discrimination "whether a government statute bans or merely burdens protected speech." App., *infra*, 15a (citing *Playboy*, 529 U.S. at 812). But the criteria for federal registration in Section 1052(a) are nothing like the restrictions at issue in *Playboy*. Although the provision struck down in *Playboy* did not impose a "complete prohibition" on sexually explicit television programming, its practical effect was to compel a substantial number of cable operators to

"silence[]" such programming "for two-thirds of the day in every home in a cable service area." 529 U.S. at 812. By contrast, Section 1052(a) does not restrict respondent's ability to express himself, through use of his mark or otherwise, but simply denies him the advantages associated with federal trademark registration.

C. The Scandalous-Marks Provision Establishes A Lawful Eligibility Requirement For Federal Trademark Registration

1. In a variety of contexts, this Court has distinguished between restrictions on speech and the refusal to provide government benefits or other resources in support of expressive activity. That distinction follows from the First Amendment's text, which "prohibits government from 'abridging the freedom of speech'" but "does not confer an affirmative right" to government assistance in speaking. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009) (quoting U.S. Const. Amend. I). Recognizing that distinction, this Court has "reject[ed] the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) (citation and internal quotation marks omitted). This Court has also consistently recognized that the government may "selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way." *Rust* v. *Sullivan*, 500 U.S. 173, 193 (1991).

Congress's directive that the USPTO refuse federal trademark registration to vulgar words and lewd sexual images is consistent with those First Amendment principles. Congress legitimately determined that a federal

agency should not use government funds to issue certificates "in the name of the United States of America" conferring statutory benefits for use of vulgar words and lewd sexual images. 15 U.S.C. 1057(a). Although respondent has a First Amendment right to use a vulgar word as a mark for his clothing line, he has no comparable right to require the government to register vulgar terms, issue registration certificates for them in the name of the United States, inscribe them on the USPTO's Principal Register, and bestow valuable benefits on the markholders' use of the terms in commerce.

That does not mean that the criteria for federal trademark registration are beyond constitutional scrutiny. As the Court's *Tam* decision establishes, such criteria must be viewpoint-neutral to survive Free Speech Clause review. The unconstitutional-conditions doctrine also provides robust protection against any attempt by the government to leverage the trademark-registration program to "regulate speech outside the contours" of the program. See *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 214-215 (2013). And other constitutional provisions afford additional protection against, for example, denying registration on the basis of a suspect classification, such as race or national origin, see *Regan*, 461 U.S. at 546-547, or on account of the markholder's religious identity or beliefs, see *Trinity Lutheran Church of Columbia, Inc.* v. *Comer*, 137 S. Ct. 2012, 2019 (2017).

None of those constitutional limitations has been violated here. Unlike the disparagement provision that the Court struck down in *Tam*, the scandalous-marks provision is viewpoint-neutral. See pp. 14-15, *supra*. It does not restrict any registrant's speech or otherwise regulate conduct outside the registration program. See

Agency for Int'l Dev., 570 U.S. at 218-219. Respondent may register any non-scandalous mark that satisfies the statutory criteria, while continuing to use unregistered vulgar marks and other vulgar speech to market and promote his goods in commerce. And respondent does not allege, and the court below did not suggest, that the scandalous-marks provision discriminates based on a suspect classification or a registration applicant's religious identity or beliefs.

2. The court of appeals erred in deeming this Court's government-subsidy decisions inapplicable.

a. The court of appeals described the Court's government-subsidy precedents as applying only to programs that "'involve[] financial benefits'" or "implicate Congress' power to spend funds." App., *infra*, 19a, 21a (citation omitted). But the principle that the First Amendment does not confer an affirmative right to government assistance does not depend on the form of the assistance offered. This Court's decisions in *Ysursa* and in *Davenport* v. *Washington Education Ass'n*, 551 U.S. 177 (2007)—both of which the court of appeals simply ignored—involved forms of assistance other than the direct provision of money. In each of those cases, the crucial point was that, as here, the plaintiff had sought government support or assistance for its communicative efforts, rather than simply the right to speak free from government interference.

b. The court of appeals also found "no principled basis to distinguish between the registration of trademarks and the registration of copyrights under the government program rationale." App., *infra*, 22a. But neither the government's argument nor this Court's decisions imply that limits on government programs are wholly exempt from constitutional scrutiny. See p. 19,

supra. If Congress barred the U.S. Copyright Office from registering copyrights in particular types of creative works, the First Amendment analysis would depend in part on the precise legal consequences that denial of registration entailed and on the justifications offered for the ban. But to the extent that the hypothetical statute would more greatly burden expression than does the denial of trademark registration (*e.g.*, because of differences between trademarks and copyrights, because the hypothetical law would deny registration to an entire work based on isolated words, or because it would preempt state registration programs), the First Amendment inquiry could take account of that greater burden. In conducting that analysis, moreover, a court could consider the different purposes that trademark and copyright laws have historically served, see, *e.g.*, *Dastar Corp.* v. *Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003), and the special role that copyright has historically played as "the engine of free expression," *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003).

3. The court of appeals made two other important errors.

a. The court of appeals failed to recognize that the trademark-registration program operates exclusively in the sphere of commercial speech. See *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987). This case involves a dispute not about political speech, but about use of a mark to identify goods and services in commerce. See *Friedman* v. *Rogers*, 440 U.S. 1, 11 (1979) (explaining that trade names are used to identify source and to symbolize the goodwill associated with the source, not to "editorialize on any subject, cultural, philosophical, or political"). Even if Section 1052(a) actually restricted

speech (*e.g.*, by proscribing the use of certain terms or symbols as names of businesses, products, or services), the standards set out in *Central Hudson Gas & Electric Corp.* v. *Public Service Commission*, 447 U.S. 557, 566 (1980), would apply.

As explained above, Section 1052(a) does not prohibit or restrict speech, but instead establishes eligibility criteria for a particular form of federal assistance. But just as restrictions on commercial speech are subject to less demanding First Amendment scrutiny than other speech restrictions, the fact that the advantages conferred by federal trademark registration are economic in nature provides a further reason to uphold the viewpoint-neutral eligibility criterion at issue here.

b. The court of appeals likewise erred in dismissing the government's legitimate justifications for denying the benefits of federal trademark registration to sexually explicit content. "[S]ociety's interest in protecting [sexually explicit] expression is of a wholly different, and lesser, magnitude than the interest in untrammeled political debate." *City of Renton* v. *Playtime Theatres, Inc.*, 475 U.S. 41, 49 n.2 (1986) (citation omitted); see *FCC* v. *Fox Television Stations, Inc.*, 556 U.S. 502, 529 (2009) (recognizing that "references to excretory and sexual material surely lie at the periphery of First Amendment concern") (citation and internal quotation marks omitted). The decision below would force the government to register "highly offensive, even shocking, images" and profanities that fall squarely within the ambit of these precedents. App., *infra*, 45a; see p. 5 n.2, *supra*.

The court of appeals stated that "the government does not have a substantial interest in protecting the public from scandalousness and profanities," and that the scandalous-marks provision cannot meaningfully

advance any government interest because "[i]n this electronic/Internet age, to the extent that the government seeks to protect the general population from scandalous material, with all due respect, it has completely failed." App., *infra*, 36a, 38a-39a. But the fact that lewd speech is readily accessible to those who seek it out should not obligate the government actively to promote its use. The benefits of federal trademark registration —which include nationwide constructive notice of the registrant's claim of ownership in the mark and certain presumptions in litigation—flow directly from the government's examining the mark, publishing it on the USPTO's Principal Register, permitting registrants to use the ® symbol to notify the public that the mark is federally registered, and working with other countries' governments to facilitate international protection of the mark.

Governments commonly exclude lewd pictures, profanity, and sexually explicit imagery from non-public and limited public fora. A city government might decide, for instance, that graphic sexual imagery should not appear on advertisements on city buses. Or the federal government might impose similar restrictions on expression within a military cemetery. If (as the court of appeals concluded) the government has no legitimate interest in protecting the public from scandalous images, App., *infra*, 36a, the constitutionality of such reasonable regulations might be called into doubt.

Registration of a trademark does not signal government endorsement of any particular product, service, mark, name, or registrant. But the government's registration of a scandalous term as a trademark, which results in publication of that mark on the Principal Register and allows the registrant to use the mark with the ® symbol, would convey to the public that the United

States regards scandalous images and terms as appropriate source identifiers in commerce.[4] Congress could also reasonably conclude that commercial actors are more likely to choose marks for which the advantages of federal registration are available, and it could reasonably decline to provide this incentive to the use of sexual imagery and other scandalous marks. Those government interests are fully sufficient to justify Section 1052(a)'s exclusion of such marks from the federal trademark-registration program.

III. THE QUESTION PRESENTED IS IMPORTANT

The provision at issue here requires the USPTO to refuse registration to marks containing profanities and graphic sexual images, such as renderings of genitalia or sexual acts. Many attempts have already been made to register "highly offensive, even shocking, images," App., *infra*, 45a; see p. 5 n.2, *supra*, and more such applications are likely to be submitted if the court of appeals' decision is allowed to stand.

Congress has prohibited federal registration of trademarks containing scandalous matter since the registration system was created in 1905. See 1905 Act § 5, 33 Stat. 725. The USPTO has repeatedly applied these provisions to refuse registration of scandalous marks. The court below nevertheless invalidated Section 1052(a)'s scandalous-marks provision on its face, so that the USPTO cannot invoke it to refuse registration of even the most vulgar terms and lewd sexual images.

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[4] That is especially true because owners of registered marks may ask the USPTO to transmit their applications to international bodies for recognition. See 15 U.S.C. 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6*quinquies*, July 14, 1967, 21 U.S.T. 1643, 828 U.N.T.S. 331 (providing for transmittal of certificates of registration to other countries).

By statute, any applicant who is refused trademark registration may seek review of the USPTO's decision in the Federal Circuit. See 15 U.S.C. 1071(a); 28 U.S.C. 1295(a)(4)(B). Pending the Court's disposition of this petition, the USPTO therefore has suspended action on trademark applications that otherwise would be refused under the scandalous-marks provision of Section 1052(a). See USPTO, *Examination Guide 2-18: Examination Guidance for Compliance with Section 2(a)'s Scandalousness Provision While Constitutionality Remains in Question during Period to Petition for Certiorari to U.S. Supreme Court* (May 24, 2018), http://www.uspto.gov/trademark/guides-and-manuals/trademark-examination-guides. Unless this Court reviews and sets aside the Federal Circuit's decision in this case, there is consequently no meaningful likelihood that any further dispute concerning the constitutionality of the scandalous-marks provision will again be presented for judicial resolution.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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SEPTEMBER 2018

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 2015-1109

IN RE: ERIK BRUNETTI, APPELLANT

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85310960.

Decided: Dec. 15, 2017

Before: DYK, MOORE, and STOLL, *Circuit Judges*.

Opinion for the Court filed by *Circuit Judge* MOORE.

Concurring opinion filed by *Circuit Judge* DYK.

MOORE, *Circuit Judge*.

Erik Brunetti appeals from the decision of the Trademark Trial and Appeal Board ("Board") affirming the examining attorney's refusal to register the mark FUCT because it comprises immoral or scandalous matter under 15 U.S.C. § 1052(a) ("§ 2(a)"). We hold substantial evidence supports the Board's findings and it did not err concluding the mark comprises immoral or scandalous matter. We conclude, however, that § 2(a)'s bar on registering immoral or scandalous marks is an unconstitutional restriction of free speech. We therefore reverse the Board's holding that Mr. Brunetti's mark is unregistrable.

BACKGROUND

I. Section 2(a)'s Bar on Registration of Immoral or Scandalous Marks

Section 2(a) of the Lanham Act provides that the Patent and Trademark Office ("PTO") may refuse to register a trademark that "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute . . . ." 15 U.S.C. § 1052(a). While § 2(a) identifies "immoral" and "scandalous" subject matter as separate bases to refuse to register a trademark—and are provisions separated by the "deceptive" provision—the PTO generally applies the bar on immoral or scandalous marks as a unitary provision ("the immoral or scandalous provision"). *See* TMEP § 1203.01 ("Although the words 'immoral' and 'scandalous' may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter."); *In re McGinley*, 660 F.2d 481, 485 n.6 (CCPA 1981) ("Because of our holding, infra, that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied."); *see also* Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476, 1489 (2011) ("U.S. courts and the Board have not distinguished between 'immoral' and 'scandalous' and have focused on whether marks are scandalous or offensive rather than contrary to some accepted standard of morality." (citation omit-

ted)). The bar on immoral or scandalous marks was first codified in 1905, *see* Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725, and reenacted in the Lanham Act in 1946, Pub. L. 79-489, § 2(a), 60 Stat. 427, 428 (codified at 15 U.S.C. § 1052(a)).

To determine whether a mark should be disqualified under § 2(a), the PTO asks whether a "substantial composite of the general public" would find the mark scandalous, defined as "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (alterations omitted) (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)). Alternatively, "the PTO may prove scandalousness by establishing that a mark is 'vulgar.'" *Id.* (quoting *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003)). Vulgar marks are "lacking in taste, indelicate, [and] morally crude . . . ." *See McGinley*, 660 F.2d at 486 (quoting *In re Runsdorf*, 171 U.S.P.Q. 443, 443-44 (1971)). The PTO makes a determination as to whether a mark is scandalous "in the context of contemporary attitudes" and "in the context of the marketplace as applied to only the goods described in the application." *Fox*, 702 F.3d at 635 (internal quotation marks and alterations omitted) (quoting *Mavety*, 33 F.3d at 1371).

Because the scandalousness determination is made in the context of contemporary attitudes, the concept of what is actually immoral or scandalous changes over time. Early cases often, but not always, focused on religious words or symbols. *See, e.g.*, *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (CCPA 1938) (MADONNA

for wine); *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (Comm'r Pat. 1938) (QUEEN MARY for women's underwear); *Ex Parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. 22 (Comm'r Pat. 1943) (AGNUS DEI for safes); *In re P. J. Valckenberg, Gmbh*, 122 U.S.P.Q. 334 (T.T.A.B. 1959) (MADONNA for wine); *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (SENUSSI (a Muslim sect that forbids smoking) for cigarettes); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968) (MESSIAS for wine and brandy). In later cases, the PTO rejected a wider variety of marks as scandalous. *See, e.g., Runsdorf*, 171 U.S.P.Q. at 443 (BUBBY TRAP for brassieres); *McGinley*, 660 F.2d at 482 (mark consisting of "a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia" for a swingers newsletter); *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863 (T.T.A.B. 1981) (BULLSHIT on handbags, purses, and other personal accessories); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988) (mark depicting a defecating dog); *Mavety*, 33 F.3d 1367 (BLACK TAIL for adult entertainment magazines).

II. Facts of This Case

Mr. Brunetti owns the clothing brand "fuct," which he founded in 1990. In 2011, two individuals filed an intent-to-use application (No. 85/310,960) for the mark FUCT for various items of apparel. The original applicants assigned the application to Mr. Brunetti, who amended it to allege use of the mark. The examining attorney refused to register the mark under § 2(a) of the Lanham Act, finding it comprised immoral or scan-

dalous matter. The examining attorney reasoned that FUCT is the past tense of the verb "fuck," a vulgar word, and is therefore scandalous. J.A. 203.

Mr. Brunetti requested reconsideration and appealed to the Board. The examining attorney denied reconsideration, and the Board affirmed. In its decision, the Board stated the dictionary definitions in the record uniformly characterize the word "fuck" as offensive, profane, or vulgar. The Board noted that the word "fuct" is defined by Urban Dictionary as the past tense of the verb "fuck" and pronounced the same as the word "fucked," and therefore found it is "recognized as a slang and literal equivalent of the word 'fucked,'" with "the same vulgar meaning." J.A. 6-7 & n.6. Based on the examining attorney's Google Images search results, the Board stated Mr. Brunetti used the mark in the context of "strong, and often explicit, sexual imagery that objectifies women and offers degrading examples of extreme misogyny," with a theme "of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." J.A. 8-9. The Board explained that Mr. Brunetti's use of the mark "will be perceived by his targeted market segment as the phonetic equivalent of the wor[d] 'fucked.'" J.A. 9. In light of the record, it found Mr. Brunetti's assertion that the mark "was chosen as an invented or coined term stretches credulity." *Id.* It concluded that the mark is vulgar and therefore unregistrable under § 2(a) of the Lanham Act. Mr. Brunetti appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4).

DISCUSSION

Mr. Brunetti argues substantial evidence does not support the Board's finding the mark FUCT is vulgar under § 2(a) of the Lanham Act. He argues even if the mark is vulgar, § 2(a) does not expressly prohibit the registration of vulgar marks and a mark should be approved for registration when there is doubt as to its meaning, as he alleges there is here. Alternatively, Mr. Brunetti challenges the constitutionality of § 2(a)'s bar on immoral or scandalous marks.

I. The Mark FUCT is Vulgar and Therefore Scandalous

The determination that a mark is scandalous is a conclusion of law based upon underlying factual inquiries. *Fox*, 702 F.3d at 637. We review the Board's factual findings for substantial evidence and its ultimate conclusion de novo. *Id.* Substantial evidence is "more than a mere scintilla" and "such relevant evidence as a reasonable mind might accept as adequate" to support a conclusion. *Consol. Edison v. NLRB*, 305 U.S. 197, 229 (1938).

It is undisputed that the word "fuck" is vulgar. Dictionaries in the record characterize the word as "taboo," "one of the most offensive" English words, "almost universally considered vulgar," and an "extremely offensive expression." J.A. 5-6; J.A. 206 (Collins Online Dictionary); J.A. 209 (Vocabulary.com); J.A. 211 (Wikipedia.com); J.A. 351 (MacMillan Dictionary). Mr. Brunetti argues that the vulgarity of "fuck" is irrelevant to whether the mark FUCT is vulgar. We do not agree.

Substantial evidence supports the Board's finding that "fuct" is a "phonetic twin" of "fucked," the past

tense of the word "fuck." J.A. 10. Urban Dictionary defines "fuct" as the "past tense of the verb fuck." J.A. 83. MacMillan Dictionary indicates that the word "fucked" is pronounced phonetically as /fʌkt/, which the Board found sounds like "fukt" or "fuct." J.A. 6 & n.6. This evidence linking the two terms is sufficient to render the vulgarity of the word "fuck" relevant to the vulgarity of Mr. Brunetti's mark.

Evidence of the use of Mr. Brunetti's mark in the marketplace further buttresses the Board's finding of a link between the mark and the word "fuck." The Board found the term "fuct" is used on products containing sexual imagery and that consumers perceive the mark as having "an unmistakable aura of negative sexual connotations." J.A. 9. One T-shirt—captioned the "FUCT Orgy" shirt—depicts a group sex scene. J.A. 346. Another T-shirt contains the word "FUCK" in yellow letters, with a "T" superimposed over the "K" such that the word FUCK is still visible. J.A. 325. A third T-shirt has the brand name FUCT depicted above the slogan "1970 smokin dope & fucking in the streets." J.A. 312. Because one meaning of "fuck" is "to have sex with someone," the placement of the mark on products containing sexual imagery makes it more likely that the mark will be perceived as the phonetic equivalent of the word "fucked." J.A. 9.

Mr. Brunetti challenges the evidence on which the Board relied in making the vulgarity finding. He argues that Urban Dictionary is not a standard dictionary edited by lexicographers and the author of the definition cited by the Board lacks lexicographic expertise. He argues that the Board did not consider his current line of products, which he provided to the examining

attorney, but instead relied on a random collection of outdated products collected from Google Images. He argues the Board should not have considered these images because they lack foundation, are inadmissible hearsay, and are irrelevant to the current perception of the mark in the marketplace. He also argues that the majority of the marked products contain no sexual imagery.

Mr. Brunetti's arguments have no merit. For ex parte proceedings, the Board permits the examining attorney to consider materials from the Internet, having adopted a "somewhat more permissive stance with respect to the admissibility and probative value of evidence." TBMP §§ 1208, 1208.03. The pedigree of the author of a definition may affect the weight that evidence is given but does not render the definition irrelevant. Similarly, the ages of the images collected by the examining attorney may affect evidentiary weight, not relevance.

Mr. Brunetti also argues that the Board ignored probative evidence that the mark is not vulgar. He argues that both he and the owner of a high-end clothing store declared that the mark was not vulgar. He argues that the meaning of the term "fuct" is ambiguous, but that to the extent it has any meaning, it is "Friends yoU Can't Trust." *See Mavety*, 33 F.3d at 1374 ("commend[ing] the practice" of erring on the side of publication when marks are not clearly scandalous). He claims that in over twenty years of operation, he received only a single complaint about his brand name and the brand is mass-distributed by "high-end national retailers" like Urban Outfitters. Appellant's Br. 8. Finally, he argues that two of Urban Dictionary's seven

definitions of the term "fuct" refer to his brand name, while only one definition is vulgar.

Mr. Brunetti's proffered evidence does not change our conclusion that substantial evidence supports the Board's findings. The Board explicitly considered Mr. Brunetti's declaration and found it "stre[t]che[d] credulity" that "fuct" was chosen as an invented or coined term for "Friends yoU Can't Trust," given the contradictory record evidence. J.A. 9-10. Mr. Brunetti's unverifiable claim about the number of customer complaints may demonstrate that the mark is not offensive to a certain segment of the market. That does not satisfy his burden on appeal, however, to establish that the Board lacked substantial evidence for its determination that a "substantial composite" of the American public would find the mark vulgar. And the fact that the Board could have relied on one of the other five definitions of the term "fuct" on Urban Dictionary—a website to which anyone can anonymously submit definitions—does not demonstrate that the Board's reliance on that website is not substantial evidence. The Board reasonably focused on the highest rated definition, suggesting that it is more common or accurate than the alternative, non-vulgar definitions.

Mr. Brunetti argues that even if FUCT is vulgar, § 2(a) does not prohibit the registration of vulgar marks—only "immoral" or "scandalous" marks. He argues that to be immoral or scandalous, a mark must be more than merely vulgar. He argues that extending § 2(a) to vulgar marks is contrary to the plain language of the statute.

We do not agree. We have previously held "the PTO may prove scandalousness by establishing that a mark

is 'vulgar.'" *Fox*, 702 F.3d at 635; *see also Boulevard Entm't*, 334 F.3d at 1340 ("A showing that a mark is vulgar is sufficient to establish that it 'consists of or comprises immoral . . . or scandalous matter' within the meaning of section 1052(a)."). We are bound by these holdings.

Even if we could overrule our prior holding that a showing of vulgarity is sufficient to establish that a mark "consists of or comprises immoral . . . or scandalous matter," we see no justification for doing so in light of the evidence of record. At the time of the passage of the Lanham Act, dictionaries defined "scandalous" as "shocking to the sense of truth, decency, or propriety," "[g]iving offense to the conscience or moral feelings," or "calling out [for] condemnation." *McGinley*, 660 F.2d at 485-86 (citing Webster's New International Dictionary (2d ed. 1942); Funk & Wagnalls New Standard Dictionary (1945)). Other definitions characterize scandalous as "disgraceful," "offensive," or "disreputable." *Id.* (citing Webster's New International Dictionary (2d ed. 1942); Funk & Wagnalls New Standard Dictionary (1945)). We see no definition of scandalous that, in light of the PTO's fact findings, would exempt Mr. Brunetti's mark.

We see no merit in Mr. Brunetti's arguments relating to whether the mark is scandalous and therefore prohibited registration under § 2(a). Substantial evidence supports the Board's finding the mark FUCT is vulgar and therefore the Board did not err in concluding the mark is not registrable under § 2(a).

II. Section 2(a)'s Bar on Immoral or Scandalous Marks is Unconstitutional Under the First Amendment

When Mr. Brunetti filed his appeal, his constitutional argument was foreclosed by binding precedent. In *McGinley*, our predecessor court held the refusal to register a mark under § 2(a) does not bar the applicant from using the mark, and therefore does not implicate the First Amendment. 660 F.2d at 484. Commentators heavily criticized *McGinley* and our continued reliance on it, particularly in light of the many changes to First Amendment jurisprudence over the last thirty years. *In re Tam*, 808 F.3d 1321, 1333-34 & n.4 (Fed. Cir. 2015) (en banc). We reconsidered *McGinley* en banc in *Tam*, which held the disparagement provision of § 2(a) unconstitutional under the First Amendment because it discriminated on the basis of content, message, and viewpoint. *Id.* at 1334-37, 1358. We held that, although trademarks serve a commercial purpose as source identifiers in the marketplace, the disparagement provision of § 2(a) related to the expressive character of marks, not their commercial purpose. *Id.* at 1337-39. As either a content-based or viewpoint-based regulation of expressive speech, the disparagement provision was subject to strict scrutiny. *Id.* at 1339. It was undisputed that the measure did not survive such scrutiny. *Id.*

We rejected the government's arguments that § 2(a) did not implicate the First Amendment, holding instead that the PTO's denial of marks had a chilling effect on speech. *Id.* at 1339-45. We also rejected the government's arguments that trademark registration was government speech, *id.* at 1345-48, and that trademark registration was a federal subsidy, *id.* at 1348-55. Fi-

nally, we held the disparagement provision did not survive even the lesser scrutiny afforded to commercial speech under *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557, 563 (1980), because the government had put forth no substantial interests justifying the regulation of speech. *Tam*, 808 F.3d at 1355-58.

The en banc court noted that § 2(a) contains a hodgepodge of differing prohibitions on registration, and as such, the holding in *Tam* was limited to § 2(a)'s disparagement provision. *Id.* at 1330; *see also id.* at 1330 n.1. However, the court left open whether other portions of § 2 may also be unconstitutional, and held that *McGinley* was overruled insofar as it could prevent a future panel from reconsidering the constitutionality of other portions of § 2. *Id.* at 1330 n.1.

Following the issuance of our en banc decision in *Tam*, we requested additional briefing from both parties in this case on "the impact of the *Tam* decision on Mr. Brunetti's case, and in particular whether there is any basis for treating immoral and scandalous marks differently than disparaging marks." *In re Brunetti*, No. 15-1109, Docket No. 51 (Fed. Cir. Dec. 22, 2015). Both parties filed letter briefs. The government stated that "given the breadth of the Court's *Tam* decision and in view of the totality of the Court's reasoning," there is no reasonable basis for treating immoral or scandalous marks differently than disparaging marks. Gov't Letter Br. 2, *In re Brunetti*, No. 15-1109, Docket No. 52 (Fed. Cir. Jan. 21, 2016). It maintained, however, that if the Solicitor General sought Supreme Court review of our en banc decision in *Tam*, "the government may argue that, under reasoning less sweeping

than that adopted in *Tam*, the bar on registration of scandalous and immoral marks would survive even if the bar on registration of disparaging marks were held invalid." *Id.* at 4. The Supreme Court subsequently granted certiorari. *Lee v. Tam*, 137 S. Ct. 30 (2016).

On June 19, 2017, the Supreme Court unanimously affirmed our en banc decision in *Tam*. *Matal v. Tam*, 137 S. Ct. 1744 (2017). The Court held that trademarks are private, not government, speech. *Id.* at 1757-61. Pursuant to two opinions authored by Justice Alito and Justice Kennedy, it concluded that § 2(a)'s bar on the registration of disparaging marks discriminated based on viewpoint. *Id.* at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). The Court explained the disparagement provision "offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend." *Id.* at 1751 (Alito, J.); *accord id.* at 1766 (Kennedy, J.). The plurality opinion, authored by Justice Alito and joined by Chief Justice Roberts, Justice Thomas, and Justice Breyer, further concluded that the constitutionality of the disparagement provision could not be sustained by analyzing trademark registration as either a federal subsidy or a federal program. *Id.* at 1760-63 (Alito, J.). The remaining four participating Justices opined, in a concurring opinion authored by Justice Kennedy, that "the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties." *Id.* at 1765 (Kennedy, J.).

Both opinions held the disparagement provision unconstitutionally restricted free speech, left open was "the question of whether *Central Hudson* provides the appropriate test for deciding free speech challenges to

provisions of the Lanham Act." *Id.* at 1764 n.17 (Alito, J.); *see also id.* at 1767 (Kennedy, J.). Justice Alito's opinion concluded the disparagement provision failed even the intermediate test under *Central Hudson* because the prohibition was not narrowly drawn to a substantial government interest. *Id.* at 1764-65 (Alito, J.). Justice Kennedy's opinion concluded that, because the disparagement provision discriminates based on viewpoint, it was subject to heightened scrutiny, which it did not withstand. *Id.* at 1767-68 (Kennedy, J.). Neither opinion reached the constitutionality of other provisions of § 2 of the Lanham Act. *See, e.g., id.* at 1768 (Kennedy, J.).

Following the issuance of the Supreme Court's decision in *Tam*, we requested additional briefing from the parties regarding the impact of the Supreme Court's decision on Mr. Brunetti's case. *In re Brunetti*, No. 15-1109, Docket No. 58 (Fed. Cir. June 20, 2017). Both parties submitted letter briefs and we heard oral argument on August 29, 2017. The government contends *Tam* does not resolve the constitutionality of § 2(a)'s bar on registering immoral or scandalous marks because the disparagement provision implicates viewpoint discrimination, whereas the immoral or scandalous provision is viewpoint neutral. Gov't Letter Br. 6-9, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017).

While we question the viewpoint neutrality of the immoral or scandalous provision, we need not resolve that issue. Independent of whether the immoral or scandalous provision is viewpoint discriminatory, we conclude the provision impermissibly discriminates based on content in violation of the First Amendment.

A. Section 2(a)'s Bar on Registering Immoral or Scandalous Marks is an Unconstitutional Content-Based Restriction on Speech

The government restricts speech based on content when "a law applies to particular speech because of the topic discussed or the idea or message expressed." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015). Content-based statutes are presumptively invalid. *RAV v. City of St. Paul, Minn.*, 505 U.S. 377, 382 (1992). To survive, such statutes must withstand strict scrutiny review, which requires the government to "prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest." *Reed*, 135 S. Ct. at 2231 (quoting *Ariz. Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 734 (2011)); *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 813 (2000) ("If a statute regulates speech based on its content, it must be narrowly tailored to promote a compelling Government interest. If a less restrictive alternative would serve the Government's purpose, the legislature must use that alternative."). Strict scrutiny applies whether a government statute bans or merely burdens protected speech. *See Playboy*, 529 U.S. at 812 ("The Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.").

The government concedes that § 2(a)'s bar on registering immoral or scandalous marks is a content-based restriction on speech. Oral Arg. at 11:57-12:05. And the government does not assert that the immoral or scandalous provision survives strict scrutiny review. Instead, the government contends § 2(a)'s content-based bar on registering immoral or scandalous marks does not implicate the First Amendment because trademark

registration is either a government subsidy program or limited public forum. Gov't Letter Br. 14, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017); Oral Arg. at 12:06-21, 18:15-39. Alternatively, the government argues trademarks are commercial speech implicating only the intermediate level of scrutiny set forth in *Central Hudson*. Gov't Letter Br. 15, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017); Oral Arg. at 35:05-17. Under a less exacting degree of scrutiny, the government argues the immoral or scandalous provision is an appropriate content-based restriction tailored to substantial government interests. We consider these arguments in turn.

1. Trademark Registration is Not a Government Subsidy Program

The Spending Clause of the U.S. Constitution "provides Congress broad discretion to tax and spend for the 'general Welfare,' including by funding particular state or private programs or activities." *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2327-28 (2013); U.S. Const. art. I, § 8, cl. 1. Within this discretion is the authority to attach certain conditions to the use of its funds "to ensure they are used in the manner Congress intends." *Id.* at 2328; *see also Rust v. Sullivan*, 500 U.S. 173, 198 (1991) ("The condition that federal funds will be used only to further the purposes of a grant does not violate constitutional rights."). Other government-imposed conditions may impermissibly impinge the First Amendment rights of fund recipients. Pursuant to the long-established unconstitutional conditions doctrine, the government may not restrict a recipient's speech simply because the government provides him a benefit:

> [E]ven though a person has no "right" to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.

Perry v. Sindermann, 408 U.S. 593, 597 (1972); *accord Bd. of Cty. Comm'rs v. Umbehr*, 518 U.S. 668, 674 (1996) ("[T]he threat of the loss of [a valuable financial benefit] in retaliation for speech may chill speech on matters of public concern . . . ."). Conditions attached to government programs may unconstitutionally restrict First Amendment rights even if the program involves Congress' authority to direct spending under the Spending Clause. *See, e.g.*, *Agency for Int'l Dev.*, 133 S. Ct. at 2330-31 (holding Congress could not restrict appropriations aimed at combating the spread of HIV/AIDS to only organizations that affirmatively opposed prostitution and sex trafficking); *FCC v. League of Women Voters*, 468 U.S. 364, 399-400 (1984) (rejecting the government's argument that Congress' spending power justified conditioning funding to public broadcasters on their refraining from editorializing). The constitutional line, while "hardly clear," rests between "conditions that define the limits of the government spending program—those that specify the activities Congress wants to subsidize—and conditions that seek to leverage funding to regulate speech outside the contours of the program itself." *Agency for Int'l Dev.*, 133 S. Ct. at 2328.

The government argues, pursuant to the government subsidy framework articulated in *Agency for Interna-*

tional Development, that § 2(a)'s bar on registering immoral or scandalous marks is simply a reasonable exercise of its spending power, in which the bar on registration is a constitutional condition defining the limits of trademark registration. Our court rejected the applicability of this analysis to trademark registration, 9-3, in our en banc decision in *Tam*.[1] 808 F.3d at 1348-55. The four Justices who reached the issue in *Tam* likewise held the government subsidy framework does not apply to trademark registration. 137 S. Ct. at 1761 (Alito, J.). Justice Alito explained in his plurality opinion that while the constitutional framework articulated in *Agency for International Development* "'is not always self-evident,' no difficult question is presented here." *Id.* (quoting 133 S. Ct. at 2330 (alterations omitted)).

Unlike trademark registration, the programs at issue in the Supreme Court's cases upholding the constitutionality of conditions under the Spending Clause necessarily and directly implicate Congress' power to spend or control government property. For example, *Rust* addressed a condition on the distribution of federal funds for family planning services. 500 U.S. at 177.

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[1] The government maintains that our en banc decision in *Tam* is not binding on this panel in light of the Supreme Court's decision in *Tam*. Oral Arg. at 12:23-13:36, 15:43-54. We question the force of this assertion because the Supreme Court did not reverse or otherwise cast doubt on the continuing validity of our government subsidy analysis and other aspects of our decision in *Tam*. *See Chen v. Allstate Ins. Co.*, 819 F.3d 1136, 1138 n.1 (9th Cir. 2016); *Balintulo v. Ford Motor Co.*, 796 F.3d 160, 166 n.28 (2d Cir. 2015). Because we independently reach the same conclusion as the en banc court, we need not decide whether that holding continues to bind future panel decisions in this circuit.

The Supreme Court's plurality opinion in *United States v. American Library Association, Inc.* upheld a condition on federal funding for Internet access to public libraries. 539 U.S. 194, 212 (2003). While *Regan v. Taxation with Representation of Washington* concerned tax exemptions and deductions, the Supreme Court specified, "[b]oth tax exemptions and tax-deductibility are a form of subsidy that is administered through the tax system." 461 U.S. 540, 544 (1983). "The federal registration of a trademark is nothing like the programs at issue in these cases." *Tam*, 137 S. Ct. at 1761 (Alito, J.).

Trademark registration does not implicate Congress' power to spend funds. An applicant does not receive federal funds upon the PTO's consideration of, or grant of, a trademark. The only exchange of funds flows from the applicant to the PTO. The applicant pays the applicable trademark process and service fees set forth in 37 C.F.R. § 2.6(a)(1), which are then made "available to the Director to carry out the activities of the [PTO]." 35 U.S.C. § 42(c)(1). As explained in our en banc opinion in *Tam*, since 1991, trademark registration fees—not appropriations from taxpayers—have entirely funded the direct operating expenses associated with trademark registration. 808 F.3d at 1353 (citing, e.g., *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006)). Congress' authority to direct funds is thus not implicated by either the operating expenses necessary to examine a proposed mark or the PTO's ultimate grant of trademark registration. Of course, trademark registration does not persist entirely independent of federal funds. The government must expend certain federal funds, including but not limited to the cost of PTO employee benefits and costs associated with trademark enforcement, in connection with trademark registra-

tion. *See id.* (citing *Figueroa*, 466 F.3d at 1028). But to the extent government resources are tangentially involved with trademark registration, "just about every government service requires the expenditure of government funds." *Tam*, 137 S. Ct. at 1761 (listing, for example, police and fire protection, and copyright and motor vehicle registrations) (Alito, J.); *Tam*, 808 F.3d at 1353 ("Trademark registration does not implicate the Spending Clause merely because of this attenuated spending, else every benefit or regulatory program provided by the government would implicate the Spending Clause."). The government's involvement in processing and issuing trademarks does not transform trademark registration into a government subsidy.

Nor is the grant of trademark registration a subsidy equivalent. "Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (quotation marks omitted). These benefits are numerous and include the "right to exclusive nationwide use of that mark where there was no prior use by others," *Tam*, 808 F.3d at 1328, a presumption of validity, 15 U.S.C. § 1057(b), incontestability in certain situations, *id.* § 1065, the right to sue in federal court, *id.* § 1121, the right to recover treble damages for willful infringement, *id.* § 1117, a complete defense to state or common law claims of trademark dilution, *id.* § 1125(c)(6), the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124; 19 U.S.C. § 1526, the right to prevent "cybersquatters" from misappropriating a domain name, 15 U.S.C. § 1125(d), and qualification for a simplified process for obtaining recognition and pro-

tection of a mark in countries that have signed the Paris Convention, *see id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6*quinquies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. While these benefits are valuable, they are not analogous to Congress' grant of federal funds. The benefits of trademark registration arise from the statutory framework of the Lanham Act, and the Lanham Act in turn derives from the Commerce Clause.

Our sister courts confirm that when government registration does not implicate Congress' authority under the Spending Clause, the government subsidy line of case law does not govern the constitutionality of § 2(a)'s bar on registering immoral or scandalous marks. *See, e.g.*, *Dep't of Tex., Veterans of Foreign Wars v. Tex. Lottery Comm'n*, 760 F.3d 427, 436 (5th Cir. 2014) (en banc) (holding a bingo program that was "merely licensed and regulated by the state" was "wholly distinguishable from the subsidies in *Taxation with Representation* and *Rust* simply because no public monies or 'spending' by the state are involved"); *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 503, 509 (9th Cir. 1988) (explaining that a treaty under which certain "educational, scientific and cultural audio-visual materials" were granted various benefits, but no federal funds, was "fundamentally different" from government subsidy programs). As the D.C. Circuit noted, "[t]he Supreme Court has never extended the subsidy doctrine to situations not involving financial benefits." *Autor v. Pritzker*, 740 F.3d 176, 182-83 (D.C. Cir. 2014) (declining to apply the subsidy doctrine to a presidential directive that impacted committee members who were unpaid).

We can see no reason to treat trademark registration differently.

If the government is correct that a registration program, such as this, gives the government the authority to regulate the content of speech, then every government registration program would provide the government with similar censorship authority. For example, there is no principled basis to distinguish between the registration of trademarks and the registration of copyrights under the government program rationale. The subsidy line of case law cannot justify the government's content-based bar on registering immoral or scandalous marks.

2. Trademark Registration is Not a Limited Public Forum

The constitutionality of speech restrictions on government property are analyzed under the Supreme Court's "forum analysis," which "determine[s] when a governmental entity, in regulating property in its charge, may place limitations on speech." *See, e.g., Christian Legal Soc'y of the Univ. of Cal. Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 669 (2010). The forum analysis is driven by the principle that "the government need not permit all forms of speech on property that it owns and controls." *Int'l Soc. for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672, 678 (1992); *see also Lehman v. City of Shaker Heights*, 418 U.S. 298, 303 (1974) ("In much the same way that a newspaper or periodical, or even a radio or television station, need not accept every proffer of advertising from the general public, a city transit system has discretion to develop and make reasonable choices concerning the type of advertising that may be displayed in its vehicles.").

The government may not, however, restrict all private speech on its property solely because it is the owner. To determine the constitutional bounds of speech restrictions on government property, the forum analysis instructs us to first classify the government's property as one of three forums.

The first two forums are traditional public forums and designated public forums. Traditional public forums are places such as "streets and parks which have immemorially been held in trust for the use of the public and, time out of mind, have been used for purposes of assembly, communicating thoughts between citizens, and discussing public questions." *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983) (quotation marks omitted). Designated public forums are created when "government property that has not traditionally been regarded as a public forum is intentionally opened up for that purpose." *Pleasant Grove City, Utah v. Summum*, 555 U.S. 460, 469 (2009). In these forums, "the government's ability to permissibly restrict expressive conduct is very limited." *United States v. Grace*, 461 U.S. 171, 177 (1983). Content-based restrictions on speech "must be narrowly tailored to serve a compelling government interest, and restrictions based on viewpoint are prohibited." *Pleasant Grove*, 555 U.S. at 469 (internal citation omitted).

The remaining forum category is the limited public forum, at times referred to as a non-public forum. Limited public forums are places the government has "limited to use by certain groups or dedicated solely to the discussion of certain subjects." *Id.* at 470. As with traditional and designated public forums, regulations that discriminate based on viewpoint in limited public

forums are presumed unconstitutional. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995). Content-based restrictions on speech are subject to a lesser degree of scrutiny and remain constitutional "so long as the distinctions drawn are reasonable in light of the purpose served by the forum." *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 806 (1985). Thus, where the government has opened its property for a limited purpose, it can constitutionally restrict speech consistent with that purpose as long as "the regulation on speech is reasonable and not an effort to suppress expression merely because officials oppose the speaker's view." *Perry*, 460 U.S. at 46.

The government argues that the federal trademark registration program is a limited public forum, subjecting § 2(a)'s content-based restriction on marks comprising immoral or scandalous subject matter to a less demanding degree of scrutiny. Gov't Letter Br. 14-15, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017). Without articulating why the federal trademark registration program is a limited public forum, the government's letter brief analogizes trademark registration to city buses and a military cemetery. *Id.* at 14. At oral argument, the government identified the principal register as the limited public forum, which it contended is a metaphysical forum much like the forum at issue in *Rosenberger*. Oral Arg. at 28:40-58.[2]

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[2] Apart from the inconsistency of this argument with the government's previous representation in *Tam*—in which it stated it did not believe the forum analysis applied to trademark registration, and in particular that it did not "regard the register itself as a forum"—this argument fails as a legal matter. *See Tam*, 808 F.3d 1321, Oral Arg. at 1:14:25-1:14:58; *Tam*, 808 F.3d at 1353 n.12.

The Supreme Court has found the existence of a limited public forum only when the government restricts speech on its own property. At one end of that spectrum are venues that are owned and controlled by government entities. *See, e.g., Greer v. Spock*, 424 U.S. 828, 838 (1976) (military base); *Jones v. N.C. Prisoners' Labor Union, Inc.*, 433 U.S. 119, 134 (1977) (prison facilities); *Int'l Soc. for Krishna Consciousness*, 505 U.S. at 680-83 (Port Authority airport terminal). These cases unquestionably concern "a governmental entity, . . . regulating property in its charge." *See Christian Legal*, 561 U.S. at 669. Other cases involve property that is clearly government owned, although present in public locations. *See, e.g., United States v. Kokinda*, 497 U.S. 720, 727-30 (1990) (sidewalk outside of Postal Service); *Members of City Council of L.A. v. Taxpayers for Vincent*, 466 U.S. 789, 814 (1984) (public utility poles). Several of the Court's remaining limited public forum cases involve speech restrictions that occur on public school property. *See, e.g., Christian Legal*, 561 U.S. at 679 n.12 (registered student organization); *Good News Club v. Milford Cent. Sch.*, 533 U.S. 98, 106 (2001) (public school opened for instruction and recreation); *Lamb's Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 390-92 (1993) (public school opened for social, civic, and recreational uses); *Perry*, 460 U.S. at 46-47 (public school mail facilities).

While some of the Supreme Court's limited public forum cases have involved forums that exist "more in a metaphysical than in a spatial or geographic sense," these forums have nonetheless been tethered to government properties. *See Rosenberger*, 515 U.S. at 830. In *Rosenberger*, the Supreme Court considered a University's distribution of funds through a Student Activ-

ities Fund ("SAF") intended to "support a broad range of extracurricular student activities that 'are related to the educational purpose of the University.'" *Id.* at 824. The Court concluded the SAF was a limited public forum that "effects a sweeping restriction on student thought and student inquiry in the context of University sponsored publications." *Id.* at 829-30, 836. Although the SAF was "metaphysical"—in that it concerned use of the University's funds rather than the University's facilities, *id.* at 830—the effect of its restrictions on speech were felt on the government's property, the University. *See id.* at 836 (explaining the SAF "risks the suppression of free speech and creative inquiry in one of the vital centers for the Nation's intellectual life, its college and university campuses"). The forum at issue in *Cornelius* likewise involved a more abstract forum—a charity drive—but that drive was "conducted in the federal workplace during working hours." 473 U.S. at 790. And while the Supreme Court has applied the forum analysis to broadcasting, it did so in the context of a state-owned broadcaster's sponsorship of a particular debate at its facilities. *See Ark. Educ. Television Comm'n v. Forbes*, 523 U.S. 666, 669, 672 (1998).

Because trademarks are by definition used in commerce, the trademark registration program bears no resemblance to these limited public forums. The speech that flows from trademark registration is not tethered to a public school, federal workplace, or any other government property. A principal feature of trademarks is that they help "consumers identify goods and services that they wish to purchase, as well as those they want to avoid." *Tam*, 137 S. Ct. at 1751. "These marks make up part of the expression of everyday life, as with

the names of entertainment groups, broadcast networks, designer clothing, newspapers, automobiles, candy bars, toys, and so on." *Id.* at 1768 (Kennedy, J.). By their very purpose, trademarks exist to convey messages throughout commerce. It is difficult to analogize the Nike swoosh or the Nike JUST DO IT mark located on a Nike shirt in a Nike store as somehow a government created limited public forum. The registration and use of registered trademarks simply does not fit within the rubric of public or limited public forum cases. "[T]he forum analysis requires consideration not only of whether government property has been opened to the public, but also of the nature and purpose of the property at issue." *Preminger*, 517 F.3d 1299 (internal citations omitted); *see also Cornelius*, 473 U.S. at 805 (examining the nature of the government property involved).

A snapshot of marks recently rejected under the immoral or scandalous provision reveals the breadth of goods and services impacted by § 2(a)'s bar on such marks, including speech occurring on clothing, books, websites, beverages, mechanical contraptions, and live entertainment. These refusals chill speech anywhere from the Internet to the grocery store. And none of them involve government property over which the government can assert a right to "legally preserve the property under its control for the use to which it is dedicated." *Lamb's Chapel*, 508 U.S. at 390.

That registered marks also appear on the government's principal register does not transform trademark registration into a limited public forum. The government does not open the principal register to any exchange of ideas—it is ancillary to trademark registration. The principal register is simply a database iden-

tifying the marks approved for use in commerce. Oral Arg. at 29:28-41. Apart from its function as a database, the government has been unable to define exactly what the principal register is, or where it is located. *Id.* at 29:34-54. If the government can constitutionally restrain the expression of private speech in commerce because such speech is identified in a government database, so too could the government restrain speech occurring on private land or in connection with privately-owned vehicles, simply because those private properties are listed in a database. *Cf. Tam*, 137 S. Ct. at 1760 ("For if the registration of trademarks constituted government speech, other systems of government registration could easily be characterized in the same way."). As the government recognized, such a suppression of speech would raise serious concerns under the unconstitutional conditions doctrine. *See* Oral Arg. at 29:56-30:34 ("[T]he key difference there is the application of the unconstitutional conditions doctrine, which is the significant constraint on the government's ability to abuse its power over something like a land registry to influence speech outside a program."). The government fails to articulate a reason why the government's listing of registered trademarks in a database creates a limited public forum. And if it did then every government registration program including titles to land, registration of cars, registration of wills or estates, copyrights, even marriage licenses could similarly implicate a limited public forum. We thus conclude that government registration of trademarks does not create a limited public forum in which the government can more freely restrict speech.

3. The Prohibition on the Registration of Immoral or Scandalous Trademarks Targets the Expressive Content of Speech and Therefore Strict Scrutiny Should Be Applied

Commercial speech is speech which does "no more than propose a commercial transaction." *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (citation omitted). Trademarks certainly convey a commercial message, but not exclusively so. There is no doubt that trademarks "identify the source of a product or service, and therefore play a role in the 'dissemination of information as to who is producing and selling what product, for what reason, and at what price.'" *Tam*, 808 F.3d at 1338 (quoting *Va. State Bd. of Pharmacy*, 425 U.S. at 765). However, trademarks—including immoral or scandalous trademarks—also "often have an expressive content." *Tam*, 137 S. Ct. at 1760. For immoral or scandalous marks, this message is often uncouth. But it can espouse a powerful cause. *See, e.g.*, FUCK HEROIN, Appl. No. 86,361,326; FUCK CANCER, Appl. No. 86,290,011; FUCK RACISM, Appl. No. 85,608,559. It can put forth a political view, *see* DEMOCRAT.BS, Appl. No. 77,042,069, or REPUBLICAN.BS, Appl. No. 77,042,071. While the speech expressed in trademarks is brief, "powerful messages can sometimes be conveyed in just a few words." *Tam*, 137 S. Ct. at 1760.

The test used by the PTO to prohibit immoral or scandalous marks is whether a "substantial composite

of the general public"[3] would find the mark "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation." *Fox*, 702 F.3d at 665. There can be no question that the immoral or scandalous prohibition targets the expressive components of the speech. As in this case, the agency often justifies its rejection of marks on the grounds that they convey offensive ideas. J.A. 8-9 (explaining that Mr. Brunetti's use of his trademark is scandalous because his mark "objectifies women and offers degrading examples of extreme misogyny" and contains a theme "of extreme nihilism" with "anti-social imagery" and is "lacking in taste"). These are each value judgments about the expressive message behind the trademark. Whether marks comprise immoral or scandalous subject matter hinges on the expressive, not source-identifying, nature of trademarks.

While different provisions of the Lanham Act may appropriately be classified as targeting a mark's source-identifying information—for example, § 2(e)'s bar on registering marks that are "merely descriptive" or "geographically descriptive"—the immoral or scandalous provision targets a mark's expressive message, which is separate and distinct from the commercial purpose of a mark as a source identifier. Justice Kennedy explained in his concurrence: "The central purpose of trademark registration is to facilitate source identification. . . . Whether a mark is disparaging bears no plausible relation to that goal." 137 S. Ct. at 1768 (Kennedy, J.).

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[3] The PTO justifies its refusals by "tying censorship to the reaction of the speaker's audience." *See Tam*, 137 S. Ct. at 1766 (Kennedy, J.).

We find the same logic applies to the immoral or scandalous prohibition. As in the case of disparaging marks, the PTO's rejections under § 2(a)'s bar on immoral or scandalous marks are necessarily based in the government's belief that the rejected mark conveys an expressive message—namely, a message that is scandalous or offensive to a substantial composite of the general population. *See Tam*, 808 F.3d at 1338. Section 2(a) regulates the expressive components of speech, not the commercial components of speech, and as such it should be subject to strict scrutiny. *See Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565 (2011). There is no dispute that § 2(a)'s bar on the registration of immoral or scandalous marks is unconstitutional if strict scrutiny applies.

4. Section 2(a)'s Bar on Immoral or Scandalous Marks Does Not Survive Intermediate Scrutiny

Section 2(a)'s bar on the registration of immoral or scandalous marks is unconstitutional even if treated as a regulation of purely commercial speech reviewed according to the intermediate scrutiny framework established in *Central Hudson*, 447 U.S. at 566. Intermediate scrutiny requires that "the State must show at least that the statute directly advances a substantial governmental interest and that the measure is drawn to achieve that interest." *Sorrell*, 564 U.S. at 572.

Commercial speech is subject to a four-part test which asks whether (1) the speech concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) whether the regulation is "not more extensive than necessary to serve that interest." *Central Hudson*, 447 U.S. at 566; *see also Bd. of Tr. of State Univ. of N.Y. v. Fox*,

492 U.S. 469, 479-80 (1989) (explaining the fourth prong of *Central Hudson* requires "not necessarily the least restrictive means but . . . a means narrowly tailored to achieve the desired objective"). "Under a commercial speech inquiry, it is the State's burden to justify its content-based law as consistent with the First Amendment." *Sorrell*, 564 U.S. at 565.

The immoral or scandalous provision clearly meets the first prong of the *Central Hudson* test, which requires we first confirm the speech "concern lawful activity and not be misleading." 447 U.S. at 566. Section 2(a)'s provision barring immoral or scandalous marks, like the disparagement provision, does not address misleading, deceptive, or unlawful marks. Rather it is concerned with whether a mark is offensive, scandalous, or vulgar to a substantial composite of the general public.

Central Hudson's second prong, requiring a substantial government interest, is not met. The only government interest related to the immoral or scandalous provision that we can discern from the government's briefing is its interest in "protecting public order and morality." Gov't Letter Br. 15 & n.6, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017).[4] At oral argument, the government struggled to identify the substantial interest in barring registration of trademarks comprising immoral or scandalous subject mat-

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[4] The government's brief also made an errant reference to its interest "in the orderly flow of commerce." Gov't Letter Br. 15, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017). While we do not question the substantiality of this interest, the government has failed to articulate how this interest is in any way advanced by the immoral or scandalous prohibition, or how that provision is narrowly tailored to that interest.

ter. The government framed its interest based on the government's own perception of proposed marks, including what types of marks the government would "want to promote" or "has deemed to be most suitable." Oral Arg. at 22:35-41, 22:56-23:00. At another point, the government indicated its interest is to shield its examiners from immoral or scandalous marks: "whether or not its examiners are forced to decide whether one drawing of genitalia is confusingly similar to another drawing of genitalia." *Id.* at 21:51-22:12. Ultimately, the government stated, "Congress' primary interest is the promotion of the use of non-scandalous marks in commerce." *Id.* at 23:33-42; *see also id.* at 25:21-32 ("Promoting commerce that doesn't include the use of source identifiers that are graphic sexual images or profanities that are going to be off-putting to a substantial composite of the public."). Whichever articulation of the government's interest we choose, the government has failed to identify a substantial interest justifying its suppression of immoral or scandalous trademarks.[5]

First, the government does not have a substantial interest in promoting certain trademarks over others. The Supreme Court rejected the government's claim that trademarks are government speech. *Tam*, 137 S. Ct. at 1757-61. Our conclusion that trademark registration

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[5] We note that the government hardly met its burden to identify a government interest at all. To identify this purported interest, the government has done no more than "taken the *effect* of the statute and posited that effect as the State's interest. If accepted, this sort of circular defense can sidestep judicial review of almost any statute, because it makes all statutes look narrowly tailored." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 120 (1991).

is neither a government subsidy nor a limited public forum forecloses any remaining interest the government may have in approving only marks it "has deemed to be most suitable." Oral Arg. at 22:56-23:00; *see also Tam*, 137 S. Ct. at 1760-63 (plurality rejecting the government subsidy argument) (Alito, J.).

Second, Supreme Court precedent makes clear that the government's general interest in protecting the public from marks it deems "off-putting," whether to protect the general public or the government itself, is not a substantial interest justifying broad suppression of speech. "[T]he fact that society may find speech offensive is not a sufficient reason for suppressing it." *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983) ("At least where obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression." (citation omitted)); *Cohen v. California*, 403 U.S. 15, 21 (1971) ("[T]he mere presumed presence of unwitting listeners or viewers does not serve automatically to justify curtailing all speech capable of giving offense."); *Cox*, 379 U.S. at 551 ("[C]onstitutional rights may not be denied simply because of hostility to their assertion or exercise."). "Where the designed benefit of a content-based speech restriction is to shield the sensibilities of listeners, the general rule is that the right of expression prevails, even where no less restrictive alternative exists." *Playboy*, 529 U.S. at 813.

The Supreme Court's decision in *Tam* supports our conclusion that the government's interest in protecting the public from off-putting marks is an inadequate government interest for First Amendment purposes. *See*,

e.g., 137 S. Ct. at 1764 (applying *Central Hudson* and rejecting the government's "interest in preventing speech expressing ideas that offend" because "that idea strikes at the heart of the First Amendment") (Alito, J.). In *Tam*, the Court acknowledged that it is a "bedrock First Amendment principle" that "Speech may not be banned on the ground that it expresses ideas that offend." *Tam*, 137 S. Ct. at 1751 (Alito, J.); *see also id.* at 1767 ("[T]he Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed.") (Kennedy, J.). Both Justice Alito's and Justice Kennedy's opinions support their conclusions that the disparagement provision is unconstitutional citing cases holding "the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers." *Id.* at 1763 (collecting cases) (quoting *Street v. New York*, 394 U.S. 576, 592 (1969)) (Alito, J.); *id.* at 1767 (citing Justice Alito's opinion at 1763-64) (Kennedy, J.); *see also Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable."); *Coates v. Cincinnati*, 402 U.S. 611, 615 (1971) ("[M]ere public intolerance or animosity cannot be the basis for abridgment of these constitutional freedoms."). The government's interest in suppressing speech because it is off-putting is unavailing.

While the government's interest in *Tam* related to a viewpoint-based restriction on speech, we note the cases on which the Supreme Court relied are not so limited. The cases cited in *Tam* are directed to speech

that may be offensive, but not all involve speech that is disparaging or viewpoint discriminatory. Many involve speech that, rather than disparaging others, involved peaceful demonstrations. *See, e.g.*, *Bachellar v. Maryland*, 397 U.S. 564, 566-67 (1970) (peaceful Vietnam war protest carrying signs such as "Make Love not War"); *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 509-14 (1969) (wearing black armbands to protest Vietnam war); *Cox v. Louisiana*, 379 U.S. 536, 545, 550-51 (1965) (protesting segregation and discrimination); *De Jonge v. Oregon*, 299 U.S. 353, 365 (1937) (peaceful political meeting). Several other cases do not appear to involve viewpoint discrimination at all. For example, *Hustler Magazine* concerned a parody interview of Jerry Falwell in which the actor playing him stated his "'first time' was during a drunken incestuous rendezvous with his mother in an outhouse." 485 U.S. at 48. While such a parody interview is offensive, its function as a parody does not clearly involve the expression of beliefs, ideas, or perspectives. Similarly, the ordinance at issue in *Coates* was not limited to restricting disparaging speech or certain viewpoints, but prohibited any conduct perceived as "annoying to persons passing by." 402 U.S. at 611. The Supreme Court's narrative that the government cannot justify restricting speech because it offends, together with its reliance on cases involving a variety of different speech restrictions, reinforce our conclusion that the government's interest in protecting the public from off-putting marks is not substantial.

Finally, the government does not have a substantial interest in protecting the public from scandalousness and profanities. The government attempts to justify this interest by pointing to the Supreme Court's deci-

sion in *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978). In *Pacifica*, the Supreme Court upheld the constitutionality of the FCC's declaratory order determining that an afternoon radio broadcast of George Carlin's "Filthy Words" monologue was indecent and potentially sanctionable. *Id.* at 730-32. The Court explained "references to excretory and sexual material . . . merely lie at the periphery of First Amendment concern." *Id.* at 742. The Court justified the FCC's order, however, because radio broadcasting has "a uniquely pervasive presence in the lives of all Americans" and is "uniquely accessible to children, even those too young to read," confronting Americans "in the privacy of the home, where the individual's right to be left alone plainly outweighs the First Amendment rights of an intruder." *Id.* at 749. The Court stressed: "It is appropriate to emphasize the narrowness of our holding." *Id.* at 750. Subsequent precedent explained that other mediums of communication, such as dial-in-services or the Internet, are "manifestly different from a situation in which a listener does not want the received message." *Sable Commc'ns of Cal., Inc. v. FCC*, 492 U.S. 115, 128 (1989) ("Unlike an unexpected outburst on a radio broadcast, the message received by one who places a call to a dial-a-porn service is not so invasive or surprising that it prevents an unwilling listener from avoiding exposure to it."); *Reno v. Am. Civil Liberties Union*, 521 U.S. 844, 868-69 (1997) (explaining *Pacifica* does not control because "the Internet is not as 'invasive' as radio or television").

The government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*. A trademark is not foisted

upon listeners by virtue of its being registered. Nor does registration make a scandalous mark more accessible to children. Absent any concerns that trademark registration invades a substantial privacy interest in an intolerable manner, the government's interest amounts to protecting everyone, including adults, from scandalous content. But even when "many adults themselves would find the material highly offensive," adults have a First Amendment right to view and hear speech that is profane and scandalous. *Playboy*, 529 U.S. at 811 (First Amendment right to view "sexually explicit adult programming or other programming that is indecent"); *Sable*, 492 U.S. at 115 ("Sexual expression which is indecent but not obscene is protected by the First Amendment."). In crafting a substantial government interest, "the government may not 'reduce the adult population . . . to . . . only what is fit for children.'" *Bolger*, 463 U.S. at 73 (citation omitted); *cf. Sable*, 492 U.S. at 131 ("[T]he statute's denial of adult access to telephone messages which are indecent but not obscene far exceeds that which is necessary to limit the access of minors to such messages . . . .").

Even if we were to hold that the government has a substantial interest in protecting the public from scandalous or immoral marks, the government could not meet the third prong of *Central Hudson*, which requires the regulation directly advance the government's asserted interest. 447 U.S. at 566. As the government has repeatedly exhorted, § 2(a) does not directly prevent applicants from using their marks. Regardless of whether a trademark is federally registered, an applicant can still brand clothing with his mark, advertise with it on the television or radio, or place it on billboards along the highway. In this electronic/Internet

age, to the extent that the government seeks to protect the general population from scandalous material, with all due respect, it has completely failed.

Finally, no matter the government's interest, it cannot meet the fourth prong of *Central Hudson*. The PTO's inconsistent application of the immoral or scandalous provision creates an "uncertainty [that] undermines the likelihood that the [provision] has been carefully tailored." *See Reno*, 521 U.S. at 871. Nearly identical marks have been approved by one examining attorney and rejected as scandalous or immoral by another. The PTO registered the mark FUGLY for use on clothing, but refused registration for use on alcoholic beverages. *Compare* Reg. No. 5,135,615, *with* Appl. No. 78,866,347. *See also* COCAINE, Appl. No. 78,829,207 (rejected), COCAINE, Reg. No. 1,340,874 (accepted). The PTO registered NO BS! BRASS, Reg. No. Reg. No. 5,053,827, for entertainment services but rejected NO BS ZONE, Appl. No. 76,626,390, for internet training. NO $#!+, Appl. No. 85,855,449, was rejected, but $#*! MY DAD SAYS, Reg. No. 4,142,745, was allowed. *See also* ROLL TURD, Appl. No. 86,448,988 (rejected), TURD HERDERS, Reg. No. 5,180,286 (registered). Although the language in these marks is offensive, we cannot discern any pattern indicating when the incorporation of an offensive term into a mark will serve as a bar to registration and when it will not.

One commentator has written that, of the forty marks containing the acronym MILF for which written records were available as of 2011, twenty marks received an office action refusing registration based on § 2(a), while twenty did not. Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be*

Scandalous or Immoral, 101 Trademark Rep. 1476, 1478-82 (2011). It is difficult to understand what distinguished the refused marks, which included GOT MILF (clothing), MILF MANIA (adult online services), MILF SEEKER (adult entertainment services), and FROM SOCCER MOM TO MILF (self-help books for women), from the marks which were registered, including DIARY OF A MILF (adult online services), BACKROOM MILF (adult online services), FAT MILF (sandwich), and MILF NEXT DOOR (adult online services). *Id.* Another empirical study identified words that served as the basis of a § 2(a) refusal in some marks but were material components of other marks approved by the PTO. The authors found that to the extent there are general trends in the PTO's treatment of the offensive terms, "those general trends are apparently inconsistent with one another." Meghan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L.J. 321, 356-61 (2015). Even marks that reference the indisputably vulgar term "fuck," like the mark at issue here, are not always rejected as a matter of course. The PTO registered the mark FCUK, but rejected the marks FUCT and F**K PROJECT as scandalous. It allowed the registration of MUTHA EFFIN BINGO, Reg. No. 4,183,272, and IF WE TOUCH IT, IT'S FN GOLDEN, Reg. No. 4,100,978, but not F ALL F'S APPAREL FOR THE F'N ANGRY, Appl. No. 78,420,315.[6]

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[6] The PTO's inconsistent rejections under the immoral or scandalous provision also raise concerns about the provision's vagueness. *See Tam*, 808 F.3d at 1359 (O'Malley, J., concurring) (opining that § 2(a)'s bar on disparaging marks was unconstitutionally vague

The Trademark Trial and Appeal Board has itself noted the vague and subjective nature of the scandalous inquiry. *In re In Over Our Heads, Inc.*, 1990 WL 354546 at *1 ("[T]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one."). It can no doubt be a difficult task to determine public perceptions of a trademark's morality or immorality, offensiveness, or even vulgarity. As the Supreme Court has explained, "it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen*, 403 U.S. at 25. To be sure, there are other trademark's whose offensiveness cannot be reasonably questioned; the government attached an appendix with examples of such marks which it has rejected to this court. But the subjectivity in the determination of what is immoral or scandalous and the disparate and unpredictable application of these principles cause us to conclude that the prohibition at issue in this case would also fail the fourth prong of the *Central Hudson* analysis.

We conclude that the government has not presented us with a substantial government interest justifying the § 2(a) bar on immoral or scandalous marks. As we concluded in *Tam*, "All of the government's proffered interests boil down to permitting the government to burden speech it finds offensive." *Tam*, 808 F.3d at

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and identifying examples "where there is no conceivable difference between the applied-for marks, yet one is approved and the other rejected"). We need not reach whether the immoral or scandalous provision is so vague that it violates the Fifth Amendment.

1357. We also conclude that the government has failed to demonstrate that its restriction will advance the interests it asserts and that it is narrowly tailored to achieve that objective. Section 2(a)'s bar on immoral or scandalous marks does not survive intermediate scrutiny under *Central Hudson*.

5. There Is No Reasonable Definition of the Statutory Terms Scandalous and Immoral Which Would Preserve Their Constitutionality

We construe statutes narrowly to preserve their constitutionality, when possible. *See Schneider v. Smith*, 390 U.S. 17, 26 (1968). However, "[t]he infringement of First Amendment rights will not be cured if the narrowing construction is so unforeseeable that men of common intelligence could not have realized the law's limited scope at the only relevant time, when their acts were committed, or if the law remains excessively sweeping even as narrowed." *Gregory v. City of Chi.*, 394 U.S. 111, 121 (1969) (citations omitted). Our duty to avoid constitutional questions "is not a license for the judiciary to rewrite language enacted by the legislature. Any other conclusion, while purporting to be an exercise in judicial restraint, would trench upon the legislative powers vested in Congress." *United States v. Albertini*, 472 U.S. 675, 680 (1985) (citations omitted). It is thus permissible to construe a statute in a manner that preserves its constitutionality only where the construction is reasonable.

The concurrence agrees that the scandalous and immoral prohibitions as construed by the government, this court, and our predecessor court are unconstitutional. This court and its predecessor have consistently defined "scandalous" as "shocking to the sense of truth,

decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation." *Fox*, 702 F.3d at 635; *accord McGinley*, 660 F.2d at 485; *Riverbank Canning Co.*, 95 F.3d at 328. The concurrence proposes that we "narrow the immoral-scandalous provision's scope to obscene marks in order to preserve its constitutionality." Conc. Op. 5-6. While the legislature could rewrite the statute to adopt such a standard, we cannot.

It is not reasonable to construe the words immoral and scandalous as confined to obscene material. There is no dispute that an obscene mark would be scandalous or immoral; however, not all scandalous or immoral marks are obscene. All apples are fruit, but not all fruits are apples. As the PTO has explained, "the threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene.'" J.A. 4 (citation omitted); *accord McGinley*, 660 F.2d at 487 n.9. The PTO has for a century rejected marks as scandalous or immoral that are clearly not obscene. As set forth above, many of the early cases applying the immoral or scandalous provision involved blasphemous marks touching on religion, which were not obscene.[7]

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[7] With no authority, the concurrence suggests "the central aim of the immoral-scandalous provision . . . has been sexual material." Conc. Op. 6-7. To the contrary, there is a long history of rejecting numerous categories of non-sexual material under this provision. *See generally* LaLonde & Gilson, *supra*, at 1510-14, 1517-33 (discussing the application of the provision to marks related to religion, drug references, violence, disparaging patriotic symbols, mild profanity, and scatological references). Moreover, the concurrence suggests narrowing the immoral or scandalous provision to obscene material would be consistent with PTO action. The marks cited by the concurrence, like the FUCT mark at issue in this case, would not

The Supreme Court has made clear that the definition of obscenity for purposes of the First Amendment is "material which deals with sex in a manner appealing to prurient interest," *i.e.*, "material having a tendency to excite lustful thoughts." *Roth v. United States*, 354 U.S. 476, 487 & n.20 (1957). This "definition does not reflect the precise meaning of 'obscene' as traditionally used in the English language," and instead is limited to "obscene material '*which deals with sex.*'" *Miller v. California*, 413 U.S. 15, 20 n.2 (1973) (emphasis added).

Despite the concurrence's suggestion to the contrary, none of the dictionary definitions cited define "immoral" or "scandalous" in sexual terms.[8] *Immoral*, *Black's Law Dictionary* (1st ed. 1891) ("Contrary to good morals; inconsistent with the rules and principles of morality which regard men as living in a community, and which are necessary for the public welfare, order, and decency."); *Immoral*, *Webster's Collegiate Dictionary* (1898) ("Not moral; inconsistent with good morals; contrary to conscience or the divine law."); *Scandalous*, *Id.* ("1. Giving offense to the conscience or moral feelings. 2. Disgraceful to reputation; opprobrious. 3. Defamatory; libelous."); *Immoral*, *Webster's Complete Dictionary* (1886) ("Not moral; inconsistent rectitude; contrary

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be properly refused under a prohibition limited to obscenity. *See* Conc. Op. 7 n.7.

[8] The concurrence's reliance on overlapping dictionary definitions of "immoral," "scandalous," and "obscene" ignores this important limitation. The question before us is not whether the obscene material is "immoral" and "scandalous," but rather whether Congress intended the terms "immoral" or "scandalous" to be confined to material that is "obscene" for the purposes of a First Amendment analysis.

to conscience or the divine law; wicked; unjust; dishonest; vicious"); *Scandalous*, *Id.* ("1. Giving offense; exciting reprobation; calling out condemnation; extremely offensive to duty or propriety" "2. Disgraceful to reputation; bringing shame or infamy; opprobrious" "3. Defamatory; libelous").

Unlike the terms "immoral" and "scandalous," the statutory terms at issue in the cases cited in the concurrence are by their nature limited to material "which deals with sex." *See, e.g., Brockett v. Spokane Arcades, Inc.*, 472 U.S. 491, 494 (1985) (construing phrase "that which incites lasciviousness or lust"); *Manual Enters., Inc. v. Day*, 370 U.S. 478, 482-83 (1962) (opinion of Harlan, J.) ("While in common usage the words have different shades of meaning, the statute since its inception has always been taken as aimed at obnoxiously debasing portrayals of sex." (footnote omitted)); *Swearingen v. United States*, 161 U.S. 446, 451 (1896) ("The words 'obscene,' 'lewd,' and 'lascivious,' as used in the statute, signify that form of immorality which has relation to sexual impurity . . . ."). We do not see how the words "immoral" and "scandalous" could reasonably be read to be limited to material of a sexual nature. We cannot stand in the shoes of the legislature and rewrite a statute.

CONCLUSION

The trademark at issue is vulgar. And the government included an appendix in its briefing to the court which contains numerous highly offensive, even shocking, images and words for which individuals have sought trademark registration. Many of the marks rejected under § 2(a)'s bar on immoral or scandalous marks, including the marks discussed in this opinion,

are lewd, crass, or even disturbing. We find the use of such marks in commerce discomforting, and are not eager to see a proliferation of such marks in the marketplace. There are, however, a cadre of similarly offensive images and words that have secured copyright registration by the government. There are countless songs with vulgar lyrics, blasphemous images, scandalous books and paintings, all of which are protected under federal law. No doubt many works registered with the Copyright Office offend a substantial composite of the general public. There are words and images that we do not wish to be confronted with, not as art, nor in the marketplace. The First Amendment, however, protects private expression, even private expression which is offensive to a substantial composite of the general public. The government has offered no substantial government interest for policing offensive speech in the context of a registration program such as the one at issue in this case.

We hold that the bar in § 2(a) against immoral or scandalous marks is unconstitutional because it violates the First Amendment. We reverse the Board's holding that Mr. Brunetti's mark is unregistrable under § 2(a).

REVERSED

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 2015-1109

IN RE: ERIK BRUNETTI, APPELLANT

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85310960.

DYK, *Circuit Judge*, concurring in the judgment.

The majority today strikes down as unconstitutional a century-old provision of the Lanham Act that prohibits the registration of "immoral . . . or scandalous" marks. 15 U.S.C. § 1052(a). In doing so, it notes our obligation to "construe statutes narrowly to preserve their constitutionality, when possible." Maj. Op. 38. It concludes, however, that there is no such reasonable narrow construction. *Id.* at 38-41. I think that such a saving construction is possible and that we are obligated to adopt it.

As an initial matter, I agree with the majority that the Supreme Court's recent decision in *Matal v. Tam*, 137 S. Ct. 1744 (2017), does not dictate the facial invalidity of the immoral-scandalous provision. *Tam* held only that the disparagement provision of the Lanham Act was unconstitutional because it was not viewpoint neutral; it did not address the immoral-scandalous provision at issue here. *See id.* at 1763-65 (plurality op.); *id.* at 1765-69 (Kennedy, J., concurring in part and concurring in the judgment). So too did the opinions

reserve judgment as to the other Lanham Act provisions. *Id.* at 1763 n.16 (plurality op.) ("We leave open the question whether this is the appropriate framework for analyzing free speech challenges to provisions of the Lanham Act."); *id.* at 1768 (Kennedy, J.) ("This case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment."). Nonetheless, I also agree that the immoral-scandalous provision raises some serious First Amendment questions, as the majority opinion concludes. *See* Maj. Op. 28-38.[1]

I think that we are obligated to construe the statute to avoid these constitutional questions. Courts must, "where possible, construe federal statutes so as 'to avoid serious doubt of their constitutionality.'" *Stern v. Marshall*, 564 U.S. 462, 477 (2011) (quoting *Commodity Futures Trading Comm'n v. Schor*, 478 U.S. 833, 841 (1986)). A saving construction of a statute need only be "fairly possible," and "every reasonable construction must be resorted to." *Nat'l Fed'n of Indep. Bus. v. Sebelius*, 567 U.S. 519, 563 (2012) (first quoting *Crowell v. Benson*, 285 U.S. 22, 62 (1932); then quoting *Hooper v. California*, 155 U.S. 648, 657 (1895)).

One such fairly possible reading is available to us here by limiting the clause's reach to obscene marks, which are not protected by the First Amendment. Where the regulation of speech is concerned, the Supreme Court has a long history of narrowing the scope

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[1] The majority states that I "agree[] that the scandalous and immoral prohibitions . . . are unconstitutional." *Id.* at 38. As discussed more fully below, following the Supreme Court's instructions, I would adopt a narrowing construction specifically in order to avoid these difficult constitutional questions.

of similarly worded statutes to cover only obscene speech. The most prominent examples are the federal obscenity statutes. In 1896, the Supreme Court considered an early version of these laws, which criminalized the mailing of "obscene, lewd or lascivious" materials. *Swearingen v. United States*, 161 U.S. 446, 450 (1896). While acknowledging that "it might be inferred that each of those epithets pointed out a distinct offense" —the familiar canon against superfluities—the Court nevertheless construed the statute narrowly to "describ[e] one and the same offense," namely, the mailing of obscene materials. *Id.*

The obscenity statutes were later amended to include an even broader description of the targeted matter. Today, 18 U.S.C. § 1461 criminalizes the mailing of any "obscene, lewd, lascivious, indecent, filthy or vile article," and § 1462 criminalizes the importation of "obscene, lewd, lascivious, or filthy" materials. Nonetheless, in a series of opinions in the 1960s and '70s, the Supreme Court construed this broader language narrowly to apply only to obscenity in order to avoid constitutional doubts. *See Hamling v. United States*, 418 U.S. 87, 114 (1974) (limiting § 1461 to obscenity to avoid a vagueness challenge); *United States v. 12 200-Ft. Reels of Super 8mm. Film*, 413 U.S. 123, 129-30, 130 n.7 (1973) (same with respect to § 1462); *Manual Enters., Inc. v. Day*, 370 U.S. 478, 482-83 (1962) (plurality op.) (footnote omitted) ("While in common usage the words have different shades of meaning, the statute since its inception has always been taken as aimed at obnoxiously debasing portrayals of sex."). The Supreme Court took a similar approach when rejecting an overbreadth challenge to a Washington statute that defined "prurient" as "that which incites lasciviousness or lust," *Brockett*

v. Spokane Arcades, Inc., 472 U.S. 491, 494 (1985), construing the statute's reference to lust to reach only obscenity, *id.* at 504-05.[2]

As the Supreme Court has done with the obscenity statutes, here when faced with constitutional doubt as to the immoral-scandalous provision, we should adopt a narrowing construction and limit the statute to obscenity.[3] As in the earlier Supreme Court cases, there is no question that the trademark statute bars registration of obscene marks. While the statute does not use the word "obscene" to define its scope, the absence of the word in my view makes a narrowing construction easier rather than more difficult, since it suggests that the drafters did not use the word "obscene" to differentiate "immoral" and "scandalous" material from obscenity.[4]

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[2] I am aware of only one case in which the Supreme Court declined to construe similar language as limited to obscenity. *FCC* v. *Pacifica Foundation*, 438 U.S. 726, 738-41, 741 n.17 (1978), having arisen in the broadcasting context, is quite different from the present situation.

[3] Of course, if this were a state rather than federal statute, the different standard for narrowing constructions might dictate a different result. *See, e.g., Conchatta Inc.* v. *Miller*, 458 F.3d 258, 263-65 (3d Cir. 2006).

[4] Our predecessor court noted that "the threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene,'" which suggests that any marks meeting the threshold for obscenity would also be considered scandalous. *In re McGinley*, 660 F.2d 481, 485 n.9 (CCPA 1981), *overruled on other grounds by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *aff'd*, 137 S. Ct. 1744. To the extent that *McGinley* supports a construction of the immoral-scandalous provision that is broader than just obscenity, we are not bound by that construction given the constitutional doubts raised in this case and the intervening changes in the case law since that 1981 decision, including *Tam*.

And the fact that the immoral-scandalous provision may appear to be broader than obscenity does not preclude our adopting a narrowing construction of the statute. Contemporary dictionaries from the period before the 1905 enactment of the provision suggest that "immoral" and "scandalous" were understood as equivalent to "obscene." For example, "obscene" was itself listed as a synonym for "immoral."[5]

Under these circumstances, we can appropriately narrow the immoral-scandalous provision's scope to obscene marks in order to preserve its constitutionality, and we are obligated to do so.[6]

See, e.g., Troy v. Samson Mfg. Corp., 758 F.3d 1322, 1326 (Fed. Cir. 2014).

[5] *Immoral*, *Webster's Collegiate Dictionary* (1898); *Immoral*, *Webster's Complete Dictionary* (1886). In addition, all three words were defined in terms of giving offense to morals, and "obscene" and "immoral" were specifically defined in opposition to chastity. *Immoral*, *Webster's Collegiate Dictionary* ("inconsistent with good morals," "unchaste"); *Obscene*, *id.* ("[o]ffensive to chastity"); *Scandalous*, *id.* ("[g]iving offense to the conscience or moral feelings"); *Immoral*, *Black's Law Dictionary* (1st ed. 1891) ("[c]ontrary to good morals"); *Obscene*, *id.* ("calculated to shock the moral sense of man by a disregard of chastity or modesty"); *Immoral*, *Webster's Complete Dictionary* ("[n]ot moral," "unchaste"); *Obscene*, *id.* ("[o]ffensive to chastity and delicacy"); *Scandalous*, *id.* ("[g]iving offense"). Finally, "immoral" and "obscene" shared a number of other synonyms, including "lewd," "impure," and "indecent." *Immoral*, *Webster's Collegiate Dictionary* ("impure," "lewd"); *Obscene*, *id.* ("indecent; impure; lewd"); *Immoral*, *Webster's Complete Dictionary* ("impure," "lewd"); *Obscene*, *id.* ("[i]mpure," "indecent," "lewd"); *Obscene*, *Black's Law Dictionary* ("[l]ewd; impure; indecent").

[6] We are under this obligation notwithstanding the fact that the government has not advocated for such a narrowing construction. For example, in *Spokane Arcades*, the Supreme Court adopted a

The majority recognizes that we have an obligation to construe statutes to preserve their constitutionality. Maj. Op. 38. But the majority provides no plausible reason for failure to narrowly construe the language in § 1052(a) to avoid the evident problems created by a broader construction. To be sure, as the majority points out, the words "immoral" and "scandalous" could have a broader meaning than "obscenity," a broader meaning fraught with constitutional problems. But the potential breadth of the language is hardly a reason to reject a narrowing construction; rather, it is the very reason that a narrowing construction is appropriate. And the majority offers no convincing basis for distinguishing this case from the Supreme Court cases, discussed above, narrowing the construction of very similar language to obscenity. The majority appears to suggest that in those Supreme Court cases, the statutory concern with sexual representations was evident but that here that connection is absent. In fact, the central aim of the immoral-scandalous provision in this court's cases has been sexual material reflected in trademarks.[7] So too, the vast majority of PTO rejec-

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narrowing construction despite the state officials' arguments that the statute was facially constitutional and not in need of narrowing. 472 U.S. at 501-05; *see also SKF USA, Inc. v. U.S. Customs & Border Prot.*, 556 F.3d 1337, 1353 (Fed. Cir. 2009) ("[T]he government's arguments [against a saving construction] cannot relieve us of our obligation to construe the Byrd Amendment to avoid a finding of unconstitutionality.").

[7] *See In re Fox*, 702 F.3d 633 (Fed. Cir. 2012) (affirming refusal to register COCK SUCKER mark for lollipops); *McDermott v. S.F. Women's Motorcycle Contingent*, 240 F. App'x 865 (Fed. Cir. 2007) (per curiam) (finding no standing to oppose registration of DYKE mark); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336 (Fed Cir. 2003) (affirming refusal to register JACK-OFF marks); *In re Mavety*

tions under the immoral-scandalous provision in recent decades have related to sex.[8] The existence of isolated decisions viewing the provision as having a secondary concern with non-sexual marks[9] cannot make a narrowing construction inappropriate. Interestingly, the scholarly analysis of the scandalous-immoral provision relied on by the majority has suggested that an amendment to the statute narrowing its scope to obscene marks would preserve the core of the provision.[10]

* * *

The First Amendment does not protect obscene speech. *E.g.*, *United States v. Williams*, 553 U.S. 285, 288 (2008). Under the narrow construction I have proposed, then, the bar on the registration of obscene marks would withstand constitutional challenge. If Congress wished to expand the scope of § 1052(a), it could enact

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Media Grp. Ltd., 33 F.3d 1367 (Fed. Cir. 1994) (vacating refusal to register BLACK TAIL mark); *McGinley*, 660 F.2d 481 (affirming refusal to register mark depicting genitalia).

[8] See, for example, Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare*, 101 Trademark Rep. 1476, 1510-33 (2011), in which the examples of recent rejections are predominantly sexual references.

[9] *See, e.g.*, *In re Riverbank Canning Co.*, 95 F.2d 327 (CCPA 1938) (affirming refusal to register MADONNA mark for wine). Although LaLonde and Gilson provide other historical examples of prior rejections for religious references, LaLonde & Gilson, *supra*, at 1510-13, they also explain that the PTO has since directed that rejections based on offense to religion should be grounded in the (now-invalidated) disparagement provision rather than the scandalous-immoral provision, *see id.* at 1511.

[10] *See id.* at 1534 (noting that narrowing "immoral" and "scandalous" to "obscene" would ensure that the provision no longer applies to marks "at the edges of scandalousness").

new legislation, which could then be constitutionally tested. Without this saving construction, the majority's result leaves the government with no authority to prevent the registration of even the most patently obscene marks.

Because there is no suggestion that Mr. Brunetti's mark is obscene, however, I agree that the decision of the Trademark Trial and Appeal Board must be reversed. For these reasons, I concur in the judgment.

APPENDIX B

UNITED STATES PATENT AND
TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Serial No. 85310960

IN RE BRUNETTI[1]

Mailed: Aug. 1, 2014

Before: Bucher, Wellington and Wolfson, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Erik Brunetti ("Applicant") seeks registration on the Principal Register of the term **fuct** (*in standard character format*) for "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas,

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[1] This application was originally filed by joint applicants, David Gollup and Christopher MacLachlan, of Cary, NC, on May 3, 2011. On May 12, 2012, joint applicants (Messrs. Gollop and MacLachlan) assigned their entire interest in the ITU application for the term **fuct** to Erik Brunetti of Los Angeles, California, which assignment document was received by the Assignment Branch of the United States Patent and Trademark Office on May 14, 2012. The Assignors allegedly assigned, transferred and conveyed " . . . all right, title and interest in and to the trademark **fuct** along with all goodwill associated therewith and that portion of the business of assignor's business to which the trademark pertains . . . ." *See* Section 10 of the Trademark Act, 15 U.S.C. § 1060; 37 C.F.R. § 3.16; and TMEP § 501.01(a).

rompers and one-piece garments" in International Class 25.[2]

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), because the applied-for mark comprises immoral or scandalous matter.

According to the Trademark Examining Attorney, the term "Fuct" is the phonetic equivalent of the word "Fucked," the past tense form of the verb "fuck." For this reason, the Office maintains this term is "vulgar, profane and scandalous slang." Applicant, on the other hand, contends that: with the Trademark Examining Attorney's focus on the alleged "vulgar" nature of this term, the Office has employed an incorrect standard in refusing registration under Section 2(a) of the Trademark Act; that the evidence of record is not sufficient to prove that the term "Fuct" is "so scandalous" as to justify the refusal to register; that the applied-for mark, **fuct** is a coined word that has no meaning other than as Applicant's brand name; and finally, that the Board should narrow the scope of the statutory bar under "scandalous and immoral" in light of evolving First Amendment jurisprudence and the opinions of respected legal commentators that this provision of the Trademark Act, as currently enforced by the Office, is simply unconstitutional.

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[2] Application Serial No. 85310960 was filed on May 3, 2011, based upon Applicant's allegation of a *bona fide* intention to use the term in commerce under Section 1(b) of the Trademark Act. On May 18, 2012, Mr. Brunetti filed an Amendment to Allege Use (AAU) claiming first use anywhere and use in commerce, through his predecessors-in-interest, since at least as early as December 31, 1991.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the request for reconsideration, the appeal was resumed. As explained below, we agree with the Trademark Examining Attorney, and affirm the refusal to register.

I. Preliminary matter

The Trademark Examining Attorney has objected to "Exhibit A" and arguments related to that exhibit, which Applicant submitted for the first time with its appeal brief. Under our Trademark Rules, the record in an application should be complete prior to the filing of an appeal. 37 C.F.R. § 2.142(d). Inasmuch as this new evidence and arguments were submitted in an untimely manner, we have not considered these tardy submissions. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1990-91 (TTAB 2011); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011); and TBMP §§ 1203.02(e), 1207.01 (2014).

II. Brunetti's "Streetwear"

Erik Brunetti is an artist and entrepreneur whose graphics are infused with cultural strands from skateboarding, graffiti culture, punk rock music, and remnants of Situationist Ideal ideologies. He has been a trailblazer since the early nineties in popularizing "streetwear" having revolutionary themes, proudly subversive graphics and in-your-face imagery. His assaults on American culture critique capitalism, government, religion and pop culture. Brunetti's blog is directed to a cult following that he, his company, Fuct Manuf. Co., and Fuct's "Same Shit Different Day" line of clothing

have developed since he allegedly first adopted this designation in 1991.

III. Legal standard for determining whether a term is scandalous

The determination of whether a term is scandalous is a conclusion of law based on the underlying facts. *See, e.g., In re Fox*, 702 F.3d 633, 105 USPQ2d 1247, 1249 (Fed. Cir. 2012). The U.S. Patent and Trademark Office has the burden of proving that a trademark falls within the prohibition of Section 2(a). *Id.* To prove that the term **fuct** is scandalous, it is sufficient if the Trademark Examining Attorney shows that the term is vulgar. *Id.* at 1248; *Luxuria*, 100 USPQ2d at 1148. Our primary reviewing Court has consistently held that "the threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene.'" *In re McGinley*, 660 F.2d 481, 211 USPQ 668, 673 n.9 (CCPA 1981).

In determining whether a particular designation is scandalous, we must consider the term in the context of the marketplace as applied to applicant's identified goods. *In re Fox*, 105 USPQ2d at 1248. Furthermore, the analysis must be made (1) from the standpoint of a substantial composite of the general public, and (2) in terms of contemporary attitudes. *Id.* Thus, even though "the news and entertainment media today [may be] vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast" [*In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923, 1926 (Fed. Cir. 1994)], there are still terms that are sufficiently vulgar that they fall under the prohibition of Section 2(a). *See In re Tinseltown, Inc.*, 212 USPQ

863, 866 (TTAB 1981) ("the fact that profane words may be uttered more freely does not render them any the less profane"; refusing to register **BULLSHIT** for personal accessories and clothing). *See also In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059 (TTAB 2013) (**AWSHIT WORKS** refused as vulgar); *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (**BULLSHIT** refused as vulgar). While each of these decisions was decided on its own merits and record relevant to the time of decision, they illustrate the enduring vulgarity of some terms, despite changing times or norms.

IV. The evidence

A. Dictionary Evidence

From the dictionary entries placed into the record by the Trademark Examining Attorney, we have no doubt but that the word "fuck" continues correctly to be characterized as "offensive,"[3] "extremely offensive," "highly offensive," "intentionally offensive," an "obscenity," "vulgar slang," the "f-bomb," and at the root of a number of other twisted and angry expressions.[4]

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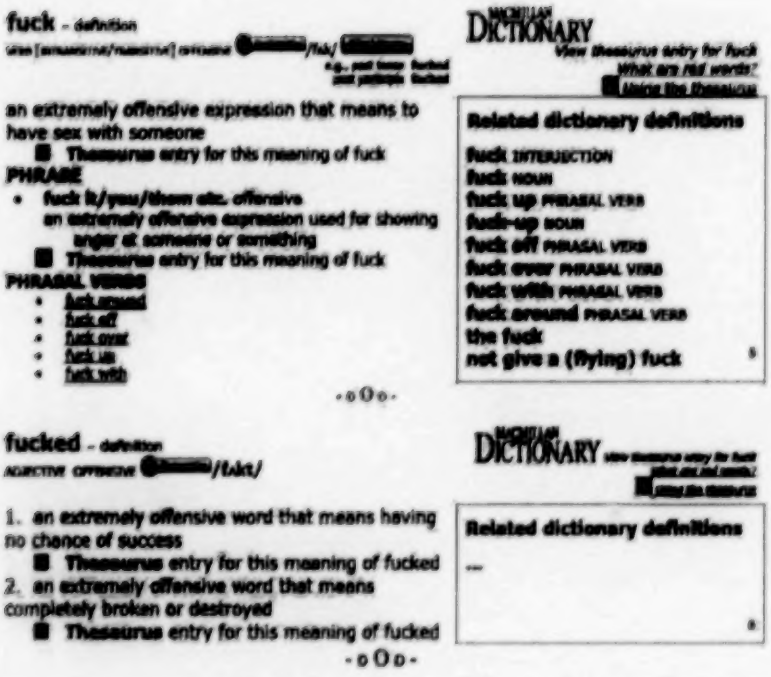
[3] **Fuck:** *Fuck* is one of the most common words in English—it's also *one of the most offensive.* Its main meaning is "have sex," but it has hundreds of other uses.

This slang term for sexual intercourse is not a word to be used lightly—it's an obscenity that, if used on some television networks, could cost the person who "dropped the f-bomb" thousands of dollars. Despite all the people who don't want to hear it, *fuck* is one of the most common obscenities, and can be used as a noun, verb, adjective, and adverb. It's often used as a modifier to add emphasis to another word, as in "that's so *fucking* stupid!" vocabulary.com, as attached to Final Office action of January 27, 2013.

[4] For example, from the Wikipedia entry, under the heading "*Offensiveness*": " . . . It is unclear whether the word has al-



fuck - definition

[redacted] /fʌk/ [redacted]

e.g., past tense fucked past participle fucked

an extremely offensive expression that means to have sex with someone

■ Thesaurus entry for this meaning of fuck

PHRASE

- **fuck it/you/them etc.** offensive
  an extremely offensive expression used for showing anger at someone or something

■ Thesaurus entry for this meaning of fuck

PHRASAL VERBS

- fuck around
- fuck off
- fuck over
- fuck up
- fuck with

-oOo-

MACMILLAN DICTIONARY

View thesaurus entry for fuck

What are rad words?

■ Make the thesaurus

Related dictionary definitions

fuck INTERJECTION
fuck NOUN
fuck up PHRASAL VERB
fuck-up NOUN
fuck off PHRASAL VERB
fuck over PHRASAL VERB
fuck with PHRASAL VERB
fuck around PHRASAL VERB
the fuck
not give a (flying) fuck [5]

fucked - definition

ADJECTIVE OFFENSIVE [redacted] /fʌkt/

1. an extremely offensive word that means having no chance of success

■ Thesaurus entry for this meaning of fucked

2. an extremely offensive word that means completely broken or destroyed

■ Thesaurus entry for this meaning of fucked

-oOo-

MACMILLAN DICTIONARY [redacted]

Related dictionary definitions

...

[6]

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ways been considered *vulgar*, and if not, when it first came to be used to describe (often in an extremely angry, hostile or belligerent manner) unpleasant circumstances or people in an intentionally offensive way, such as in the term *motherfucker*, one of its more common usages in some parts of the English-speaking world . . . ." wikipedia.org, as attached to Final Office action of January 27, 2013.

The terms "fuck" and "motherfucker" are two on the list of "George Carlin's Seven Dirty Words." 10 TTABVue at 7 of 7.

[5] macmillandictionary.com, (American English definition), Macmillan Publishers Limited, as attached to Office action denying Applicant's Request for Reconsideration, dated Aug. 20, 2013, 9 TTABVue at 3 of 8.

[6] The Trademark Examining Attorney asked that we take judicial notice of this entry, including its pronunciation, as shown at

Fuck (fŭk) *Vulgar Slang*
v. **fucked, fuck·ing, fucks**
v.tr.

1. To have sexual intercourse with.
2. To take advantage of, betray, or cheat; victimize.
3. Used in the imperative as a signal of angry dismissal.

v.intr.

1. To engage in sexual intercourse.
2. To act wastefully or foolishly.
3. To interfere; meddle. Often used with *with*.[7]

The term "fuct" is recognized as a slang and literal equivalent of the word "fucked," and having the same vulgar meaning. The Trademark Examining Attorney provided a copy of an entry for the term "fuct" from the Urban Dictionary that equates the two:[8]

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macmillandictionary.com. Macmillan Publishers Limited. The Board may take judicial notice of dictionary definitions that appear in printed publications, including online dictionaries with regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d at 1378; *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We note that in applying the Macmillan phonetic guides for "American English" to the vowel sound of the "ʌ" creating the strong form of the stressed syllable in the word "fucked" [/fʌkt/], one would have an adjectival form pronounced phonetically as "fukt." Because the letters "c" and "k" can be pronounced identically, the pronunciations would then be identical.

[7] The American Heritage Dictionary of the English Language, Fourth Edition, available at thefreedictionary.com.

[8] As attached to initial refusal under Section 2(a) in Office action of July 3, 2012.

Fuct

- The past tense of the verb fuck. Also used to express a general state of incapability.
  We are so fuct!
  She fuct me like a dog in heat!
  That's fuct up!
  (Rural definition) *Hey maw, I just fuct yer best frind [sic].*
  . . .
- fuct—friends u can trust
  fuct for life bro
  without a doubt brother

B. Applicant's declaration

According to Mr. Brunetti's declaration drafted during this proceeding:

> ¶4. The name of the FUCT brand is an arbitrary made up word. However, to the extent I am asked for a meaning I refer to FRIENDS U CAN'T TRUST. See Exhibit "4."[9]
>
> ¶5. The FUCT brand does not refer to "fuck" or the act of sexual intercourse.
>
> ¶6. In the 22 years since its creation, the FUCT brand has been sold throughout the United States and worldwide. The brand has been sold in a vari-

---

[9] A wiki contribution to THE URBAN DICTIONARY lists "friends u can trust" as an expression supporting one alleged origin of the term "FUCT." However, consistent with Applicant's overall philosophy, he seems to have adopted FRIENDS U CAN'T TRUST—the opposite meaning—as a justification for his having selected his fuct term.

> ety of retailers, from small skate and street fashion shops up to the worldwide retailer Urban Outfitters . . . .
>
> ¶7. FUCT's products do not show anything that refers to sexual intercourse. Nor does its blog. Exhibit "3." In fact, there is very little in FUCT's products that could even be considered in bad taste.

In this context, Applicant's response of January 2, 2013, argues as follows:

> . . . Although the brand is cutting edge, there is nothing on the labeling to imply any connection with sexual intercourse. When the clothing products themselves are examined, they do not have any graphics that would suggest that FUCT means "fuck": there are no graphics of nude or even semi-nude persons.

C. Evidence of Applicant's FUCT line of clothing and accessories

Both the Trademark Examining Attorney and Applicant have made of record hundreds of visuals—many of them taken from applicant's website and online blog titled "The Love Awareness Program"—showing Applicant's use of the term **fuct** on T-shirts, other goods and related blog postings.[10] These pictures show that Applicant's website and products contain strong, and often explicit, sexual imagery that objectifies women and

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[10] blog.fuct.com. As noted, the blog is titled "The Love Awareness Program." However, apart from suggesting objects of sexual desire, any of the more common connotations of "Love" (such as "affection," "devotion," "tenderness" or "warmth") are not readily apparent from a perusal of Applicant's blog entries over a period of years.

offers degrading examples of extreme misogyny, generally immediately next to Applicant's use of his proposed mark. It is clear from the record that the term "Fuct," as used by applicant, will be perceived by his targeted market segment as the phonetic equivalent of the work "fucked," and leaves an unmistakable aura of negative sexual connotations.

Further, moving to the secondary definitions of "fucked" and "fuct" that connote lives "having no chance of success," the dictionaries make it clear, in this context, that the term "fucked" (or "fuct") is still "an extremely offensive word." *See* macmillandictionary.com. We conclude from a review of the entire record that Applicant's clothing and website also mirror the offensive nature of the word in this context as well. In response to the pessimistic, rhetorical question of "just how 'fuct' are we?," the imagery Applicant employs throughout this record is one of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste, usually in close proximity to Applicant's use of his proposed mark.

V. Analysis

In light of the evidence recited above, with the prevalence of various meanings of the term "fucked" (e.g., having decidedly-negative sexual connotations, as well as extreme misogyny, depravity, violence, intolerance, anger, and imagery of being "doomed" or a "loser," etc.) that dominate applicant's themes and designs, we find that applicant's declaration statements that "fuct" was chosen as an invented or coined term stretches

credulity. Although counsel explicitly argues that Applicant's repeated reliance upon the acronym explanation allegedly drawn from the phrase FRIENDS U CAN'T TRUST is "*not just a façade* [for Applicant] to hide [behind]" (*emphasis* supplied), we conclude, to the contrary, that the term "fuct" was chosen precisely because it was knowingly calibrated to be simultaneously alluring, offensive, and corporate (i.e., "mainstream")—retaining just enough ambiguity to provide plausible deniability when necessary around the question of whether it is merely another way to say "fucked," while knowing that members of its specially target audience would never be fooled.

As to Applicant's claim that "vulgar" is not the correct standard under Section 2(a), we find that while various precedential cases of our primary reviewing court define the meaning of "scandalous" in additional and more comprehensive terms, the word "vulgar" captures the essence of the prohibition against registration in the case at bar, and therefore, we have chosen to use the term "vulgar" to facilitate our analysis and discussion, and to encapsulate what the Trademark Examining Attorney called "vulgar, profane and scandalous slang."

We have seen from the dictionary definitions of record that "fucked" and its phonetic twin, "fuct," are both vulgar terms. Whether one considers "fucked" as a sexual term, or finds that Applicant has used "fucked/fuct" in the context of extreme misogyny, nihilism or violence, we have no question but that these are still extremely offensive terms in the year 2014. That there has been a U.S. band performing and recording under the name "Fucked Up" is irrelevant to our determination. Similarly, that the United States Patent and

Trademark Office may have issued trademark registrations where the composite mark contained the word "Screwed" is also of no moment in our determination of whether the terms "fucked/fuct" are scandalous.

As to the fact that **fuct** has served as applicant's source identifier for decades, we reiterate that our responsibility under the Lanham Act is to determine the question of registrability based upon our applying contemporary standards to the specific evidence of record. We find that the Trademark Examining Attorney has shown by a preponderance of the evidence that a substantial composite[11] of the general public would find this designation vulgar.[12] Applicant's cult following may well represent a reliable niche market for its goods and ideology. While the existence of this market segment may reveal differing opinions within the consumer community, once a substantial composite has been found to consider the term scandalous, the mere existence of differing opinions cannot change the conclusion. *Cf. Amanda Blackhorse, et al. v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1111 (TTAB 2014) (in the recent "Redskins case," the issue was disparagement, not scandalousness, but the principle as to the effect of our finding a "substantial composite" is the same). Moreover, that any given Trademark Examining Attorney may have initially failed to make a scandalous refusal under

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[11] A substantial composite is "not necessarily a majority." *See In re Mavety Media Group Ltd.*, 31 USPQ2d at 1925 (quoting *In re McGinley*, 211 USPQ at 673).

[12] *See In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (the Board should consider the views of the general public and not just consumers of the particular goods/services—in *Manwin*, online porn).

Section 2(a) of the Trademark Act is also immaterial to our decision herein.

Finally, we readily recognize the statutory limitations of this tribunal. It is abundantly clear that the Trademark Trial and Appeal Board is not the appropriate forum for re-evaluating the impacts of any evolving First Amendment jurisprudence within Article III courts upon determinations under Section 2(a) of the Lanham Act, or for answering the Constitutional arguments of legal commentators or blog critics.

Decision: The refusal to register Applicant's applied-for term, **fuct**, under Section 2(a) of the Lanham Act is hereby affirmed.

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 2015-1109

IN RE: ERIK BRUNETTI, APPELLANT

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85310960.

Filed: Apr. 12, 2018

ON PETITION FOR REHEARING EN BANC

Before: PROST, *Chief Judge*, NEWMAN, LOURIE, DYK, MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

ORDER

Appellee Andrei Iancu filed a petition for rehearing en banc. A response to the petition was invited by the court and filed by appellant Erik Brunetti. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on Apr. 19, 2018.

FOR THE COURT

Apr. 12, 2018
Date

/s/ PETER R. MARKSTEINER
PETER R. MARKSTEINER
Clerk of Court

APPENDIX D

1. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the

mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to

a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

No. 18-302

In The
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR RESPONDENT

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QUESTIONS PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. §1502(a), prohibits the registration of a trademark that "Consists of or comprises immoral . . . or scandalous matter. . . ." (Hereinafter referred to as the "Scandalous Clause.")

The Questions Presented are:

1. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment. *(This is identical to the Government's question presented.)*

2. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is unconstitutionally vague under the First and Fifth Amendments. *(This is an additional question proposed by Brunetti.)*

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STATEMENT

The decision below is correct. The Court of Appeals correctly concluded that the Scandalous Clause discriminated on content and therefore is subject to strict scrutiny. The Clause fails to survive such scrutiny and therefore is facially unconstitutional. The Court of Appeals also correctly rejected the Government's defenses. Brunetti is entitled to register his mark.

Although the decision below is correct, Brunetti concedes that certiorari should be granted. Brunetti acknowledges that when the Government requests review of the invalidation of an act of Congress on constitutional grounds, such request should be given significant deference. Brunetti also agrees that the questions presented are of great importance to the Government, other trademark owners, the public, and to Brunetti.

In *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Disparagement Clause was held facially invalid by a unanimous Court. However, some issues, including the level of scrutiny and some of the government's defenses, were decided by a four-to-four plurality. It is unclear how *Marks v. United States*, 430 U.S. 188 (1977), applies in such a situation. If certiorari is granted, this Court can clarify how *Marks* is to be applied.

The questions are squarely presented, they are ripe for adjudication, and they cannot reasonably be postponed to some future case.

There is no substantial dispute about the background of this case, which is well described in the Court of Appeals' decision, so it is not repeated here.

ARGUMENT

Brunetti concedes that the Government's petition for certiorari should be granted. However, unless the Court affirms based on the first question presented, the Court should consider the second question proposed by Brunetti.

I. Certiorari Should Be Granted

First, this Court's jurisprudence shows that it often reviews cases invalidating acts of Congress on constitutional grounds if requested by the Government. Brunetti does not dispute that it is sound policy, consistent with the separation of powers, to give deference to the Executive Branch's decision about which acts of Congress should be defended, up to and including review by this Court.

Second, the Government is correct that this is an important case with immediate and irreversible consequences. If certiorari is denied, the Government must start issuing registrations for purportedly scandalous marks. Once that begins, it will be difficult to reverse.

Third, the extent to which "scandalous" speech is constitutionally protected impacts a broad swath of governmental and private activity.

Fourth, lower courts need guidance on the appropriate level of scrutiny and the merits of the government's other arguments. *Tam* does not unambiguously provide that guidance because of the four-to-four plurality. In deciding this case, the Court will not only answer what *Tam* decided, but in doing so, the Court can elucidate how the *Marks* analysis is to be performed. Providing guidance to lower courts on the application of *Marks* is an equally important reason for granting certiorari in this case.

II. The Court Should Decide How *Marks* Applies to the Plurality Opinions in *Tam*

If the Court grants review, the Court likely will address the extent to which *Tam* is a binding precedent. *Marks* provides guidance about elucidating holdings from plurality opinions. "When a fragmented Court decides a case and no single rationale explaining the result enjoys the assent of five Justices, the holding of the Court may be viewed as that position taken by those Members who concurred in the judgments on the narrowest grounds." *Marks*, 430 U.S. at 193. However, there are many unanswered questions about how *Marks* is to be applied in practice.[1]

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[1] *See, e.g.*, Re, Richard M., *Beyond the* Marks *Rule*, 132 Harv. L. Rev. (forthcoming 2019) (*available at* https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3090620); Williams, Ryan C., *Questioning* Marks*: Plurality Decisions and Precedential Constraint*, 69 Stan. L. Rev. 795 (2017); Thurmon, Mark A., *When the Court Divides: Reconsidering the Precedential Value of Supreme Court Plurality Decisions*, 42 Duke L.J. 419 (1992).

It is not necessary in this brief to advance detailed contentions about what holdings in *Tam* are properly deduced using a *Marks* analysis. But a few comments may be useful now. In *Tam*, there are a number of issues essential to the judgment, some of which were decided unanimously. Other issues were decided four-to-four. Is *Marks* to be applied issue-by-issue or some other way? Justice Kennedy's opinion did not decide the government's defenses, even though some were explicitly rejected by Justice Alito in his opinion. Are the preliminary issues or defenses decided by Justice Alito considered "narrowest" under *Marks*?

Justice Kennedy applied "heightened scrutiny," which he also referred to as "rigorous constitutional scrutiny." *Tam*, 137 S. Ct. at 1750, 1765 (Kennedy, J.). That is not *Central Hudson* "intermediate scrutiny." Nor, apparently, is it "strict scrutiny." Does Justice Thomas' concurrence, together with the four justices joining Justice Kennedy's opinion, make five for scrutiny greater than intermediate scrutiny? Can a level of scrutiny be a subset of another level (so one is "narrowest")? Or instead, do we look at the justices' reasoning (*i.e.*, in a Venn diagram, the circles of the justices' reasoning do not overlap). If the latter, was the level of scrutiny decided by an evenly divided court and therefore, without precedential effect, at least as to that issue? If *Tam* was not precedential on some issues, then the Court will need to decide such issues *de novo* in this case.

A bright line rule for applying *Marks* would be beneficial. A separate Question Presented on the applicability of *Marks* is not required since the Questions

Presented necessarily include whether *Tam* is a binding precedent under *Marks*.[2]

III. The Scandalous Clause Is a Restriction on Speech

A. *Tam* Held that the Disparagement Clause Is a Restriction on Free Speech; the Scandalous Clause Is No Different

The Government contends that the Scandalous Clause is simply a "lawful eligibility requirement for federal trademark registration." Petition at 18. It argues that the Court of Appeals "erred in treating [the Scandalous Clause] as an affirmative restriction on speech." Petition at 17. The Government concludes from that incorrect premise that the Scandalous Clause requires no constitutional scrutiny, or possibly only a rational basis analysis. Petition at 22 to 23. However, *Tam* recognized that federal trademark registration confers significant benefits. 137 S. Ct. at 1753, Part I-B. The opinions of both Justice Alito and Justice Kennedy in *Tam* recognized that refusal to register marks due to the Disparagement Clause is unconstitutional despite the fact that such marks could still be used. *See id.* at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). No principled reason exists for distinguishing the Disparagement Clause from the Scandalous Clause as

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[2] In *Hughes v. United States*, 138 S. Ct. 1765 (2018), the Court granted certiorari to consider the application of *Marks*, but the Court found it unnecessary to reach the *Marks* issue. *Id.* at 1772.

to whether the refusal to register is a constitutionally relevant restriction on speech.

B. Use of a Scandalous Mark Could Be Totally Prohibited if the Scandalous Clause Were Constitutional

The Government defends the Scandalous Clause on the grounds that it is not a complete prohibition of use. However, that ignores an important point. If the Scandalous Clause were constitutional, then what else could the Government lawfully prohibit? Certainly, it would follow that the Government could constitutionally refuse registration of copyright for scandalous works. State and local governments could effectively block unpopular organizations advancing controversial causes (*i.e.*, causes that are scandalous to at least a portion of the public) by refusing to grant building permits, charitable solicitation registrations, business licenses, or sales tax permits. This is no hypothetical concern. *See, e.g.*, *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981) (unconstitutional to require, as condition for grant of a building permit, that a restaurant change its name from SAMBO'S); *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998) (New York alcohol board's rejection of label with frog raising a middle finger is an unconstitutional restriction on commercial speech); *Kalman v. Cortes*, 723 F.Supp.2d 766 (E.D. Pa. 2010) (Pennsylvania's refusal to accept I CHOOSE HELL PRODUCTIONS, LLC as an entity name is

an unconstitutional viewpoint-based restriction on speech).

IV. The Scandalous Clause Is Viewpoint Regulation

A. The Scandalous Clause Cannot Be Reasonably Interpreted as Limited to Profanity, Excretory and Sexual References

Brunetti discusses the Government's proffered interpretation of the Scandalous Clause now, so the Government hopefully will address these arguments in its opening brief on the merits, if review is granted. In its Petition, the Government ignored these points.

The Government interprets the Scandalous Clause to be limited only to marks that contain profanity, excretory or sexual matter. Petition at 15. The Government contends that if so limited, the Clause is content-neutral. This is not true: the Scandalous Clause results in refusal of trademarks based upon viewpoint. Thus, the Clause is subject to strict scrutiny under *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227-2231 (2015), or heightened scrutiny under Justice Kennedy's opinion in *Tam* (if the latter is precedential).

This Court "may impose a limiting construction on a statute only if it is readily susceptible to such a construction." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 884 (1997) (citation and internal quotation marks omitted). However, this principle does not authorize a court to select an unreasonable

interpretation of a statute in order to avoid a constitutional question. Petition at 42a; *see also id.* at 885 ("This Court will not rewrite a . . . law to conform it to constitutional requirements.") (citation and internal quotation marks omitted). The Government asserts that "scandalous" and "immoral" can be interpreted as being limited to only profanity, excretory and sexual matter. Such interpretation would unreasonably ignore the language enacted by Congress.

No authorities support the Government's novel interpretation of the Scandalous Clause. The legislative history shows the Scandalous Clause was intended to apply more broadly: "[W]e would not want to have Abraham Lincoln gin"), quoted, *In re Tam*, 808 F.3d 1321, 1336 (Fed. Cir. 2015). *See, e.g.*, *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 U.S.P.Q. 268, 269 (C.C.P.A. 1938) (MADONNA for wine was scandalous). The Government's *Trademark Manual of Examining Procedure* ("TMEP"), Section 1203.01, interprets the Scandalous Clause to cover more than profanity, excretory or sexual content. In actual practice, the Patent & Trademark Office refuses marks under the Scandalous Clause for other reasons, including religion (KHORAN, S/N 77/072261); drugs (ACAPULCO GOLD on suntan lotion eventually allowed after determined not to refer to marijuana, *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1972)); current events (TALIBAN COOKIE COMPANY, S/N 85/074857); political (STOP THE ISLAMISATION OF AMERICA, S/N 77/940879; *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014) (held application properly refused)); puns (COFFEE NAZI, S/N

86/103763); and life-style (WIFE BEATER, Reg. No. 0836434). *See also*, examples listed in Appendix A to Brunetti's Brief below, Docket 70.[3]

Finally, if no examining guideline, decision or treatise suggested that the Scandalous Clause was limited to profanity, excretory and sexual references—at least prior to the re-argument of *Brunetti* in 2017—then such Clause does not give reasonable notice about what speech is affected and would be invalid due to vagueness.

B. All Profanity, Excretory or Sexual Refusals Are Based Upon Offensiveness

The Government claims it is just regulating content and not viewpoint because, it contends, it is only refusing to register profanity, excretory and sexual matter. However, that is not true, the Government refuses to register *some* profanity, excretory and sexual content, and allows *some*. The basis for deciding whether to allow registration is how offensive the profanity, excretory or sexual matter is. A mark is refused if "it would be considered offensive by a substantial portion of the public." TMEP §1203.01, quoting *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996).

In actual practice, the Government allows registration of some profanity, for example, "bitch," and

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[3] It is hard to imagine any mark that disparages an ethnic group would not also cause scandal, and therefore, should be refused under the Scandalous Clause, assuming it were constitutional. Yet, that would be plainly contrary to *Tam*.

"damn." The Government allows marks that use the word "fuck," provided it is misspelled or not spelled out (FCUK, Reg. No. 2920270; FWORD, S/N 75/590854; and WTF IS UP WITH MY LOVE LIFE?!, Reg. No. 4024774). As to excretory words, the Government allows "feces," "poop," "turd," (FAMOUS FECES, S/N 78/315509; POOP, Reg. No. 2956358; and TURD TOTER (BECAUSE NOBODY WANTS TO SEE YOUR TURD), Reg. No. 5397982), even though their meaning is identical to "shit," which the Government usually refuses. The Government also allows "piss" and "urine." (SATAN'S PISS, Reg. No. 5233724 and URINE OFF, Reg. No. 2553449). The Government allows some sexual terms, for example, "foreplay," "intercourse" (IRISH BY INTERCOURSE, Reg. No. 4136786), 69 (when referring to sexual activity as in MILE HIGH 69, S/N 87/718907 and LOOPY SEX GAME 18+ OH 69, Reg. No. 5583858) and PINK TACO (when referring to female genitalia, *e.g.*, PINK TACO FAN CLUB, S/N 77/402098, refused for other reasons).[4]

In short, the Scandalous Clause is not a content-neutral rule that rejects all profanity, excretory and sexual content. Instead, the Government is selectively approving or refusing profanity, excretory and sexual

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[4] The Government asserts that the Court of Appeals "erred in dismissing the government's legitimate justifications for denying the benefits of federal trademark registration to sexually explicit content." Petition at 22. Brunetti's mark is not obscene. The Government conflates scandalous with obscenity. Whether the Government can regulate obscenity is irrelevant to the facial invalidity of the Scandalous Clause as to purportedly scandalous marks.

content *based upon the level of perceived offensiveness*. *Tam* held unanimously that the Disparagement Clause was unconstitutional because it "offends a bedrock First Amendment principle: Speech may not be banned on the grounds that it expresses ideas that offend." *Tam*, 137 S. Ct. at 1750; *see also id.* at 1763 ("Giving offense is a viewpoint.") (Alito, J.).

C. Profanity Expresses Viewpoint

The Government argues that profanity does not express viewpoint, yet the Government continues to ignore the reasoning in *Cohen v. California*, 403 U.S. 15 (1971). Justice Harlan wrote:

> "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which, practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.*, at 26.

No one who hears George Carlin's *Filthy Words* (often referred to as *Seven Words You Can Never Say on Television*), the subject of *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), can doubt that profanity does

express viewpoint. The Court in *Pacifica* never questioned that Carlin's monologue was "'speech' within the meaning of the First Amendment," only whether time and place restrictions were appropriate. *Id.* at 744. Profanity does express viewpoint.[5]

D. All Scandalous Clause Refusals Are Based Upon Viewpoint

On an even broader level, Scandalous Clause refusals are always based upon the Government's opinion that the viewpoint expressed is offensive. Marks favorable to religion are allowed, but marks critical of religion or likely to cause religious controversy are prohibited. Marks that are cheerful and positive (*e.g.*, Smiley Face) are granted, while viewpoints that are negative or controversial (*e.g.*, middle finger-shaped bottle design) are refused. Marks about input into the digestive system are approved, while marks about

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[5] Justice Harlan wrote:

> "How is one to distinguish this ["fuck"] from any other offensive word? Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. Yet no readily ascertainable general principle exists for stopping short of that result were we to affirm the judgment below. For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen*, 403 U.S. at 26.

output are rejected. Polite humor is fine, raunchy humor is scandalous. Raising babies is sweet, making babies is disgusting. Kissing is fine, sex is dirty. Feminism is good, misogyny is bad. The word PENIS is allowed, an outline of a penis is not. Promotion of capitalism is okay, criticism of capitalism is scandalous (compare CORPORATE MASTURBATION, S/N 77/747036, denied, with MASTURBATION DIET, Reg. 5537456, granted). In all these situations, the Government is preferring certain viewpoints over other, disfavored viewpoints.

E. The Refusal in This Case Was Inextricably Intertwined With Brunetti's Core Speech Viewpoints

In this case, the Trademark Trial and Appeal Board (the "Board") affirmed the refusal of Brunetti's mark *because* of his viewpoint. The Board determined that Brunetti's FUCT mark was offensive because the Government concluded the mark meant "fucked." The Board found that Brunetti "objectifies women and offers degrading examples of extreme misogyny," "anti-social imagery," is "lacking in taste," and contains a theme "of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." Petition at 63a to 64a. While the Board grossly mischaracterized Brunetti's viewpoints, Brunetti's perceived views were

inextricably intertwined with the Board's decision as to whether his mark is scandalous.

V. The Government Advances Arguments that Were Explicitly or Implicitly Rejected in *Tam*

In its Petition, the Government raises several arguments in defense of the Scandalous Clause. Some brief comments may be useful to the Court at this stage.

A. Trademark Registration Is Not a Government Subsidy

In *Tam*, Justice Alito unequivocally rejected the argument that federal trademark registration is a subsidy. 137 S. Ct. at 1761 (Alito, J.). Justice Alito's opinion could be considered the precedential opinion of the Court because he decided the government-subsidy issue before reaching the constitutional question. It is noted that, although Justice Kennedy did not decide this issue, there is nothing in his opinion to suggest that he disagreed with Justice Alito's analysis. *See id.* at 1767 (Kennedy, J.). So even if Justice Alito's opinion is not precedential on this issue, the Court should adopt his well-reasoned analysis. *See also* Petition at 16a to 22a.

B. Spending Clause

The Government claims, "Congress legitimately determined that a federal agency should not use government funds to issue certificates 'in the name of the United States of America' conferring statutory benefits for use of vulgar words. . . ." Petition at 18 to 19. This appears to be a spending clause argument. Although not explicitly rejected in *Tam*, such argument is inconsistent with the judgment in *Tam*. In any event, as the Court of Appeals succinctly noted: "Trademark registration does not implicate Congress' power to spend funds." *See* Petition at 19a. Its analysis is correct.

C. Time and Place/Limited Public Forum

It is not clear what the Government is urging when it cites time and place regulation cases: *Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675 (1986); *Perry v. McDonald*, 280 F.3d 159 (2d Cir. 2001); and *General Media Comm'ns, Inc. v. Cohen*, 131 F.3d 273 (2d Cir. 1997), *cert. denied*, 524 U.S. 951 (1998). Those cases are not applicable because trademark registration is refused for all times and places, for all goods and services, and for all channels of trade (for example, not just on military bases, on public buses or billboards). What a government allows on its own property is much different than a refusal of registration for all times and places.

Although the Government's petition is less than clear, it seems to argue that the trademark register is a limited public forum. In *Tam*, Justice Alito expressed

doubt on whether trademark registration implicated a limited government forum, Part III-C (137 S. Ct. at 1763), but he did not expressly reject that contention, instead holding that the Disparagement Clause was viewpoint regulation. The Court of Appeals' analysis of this point is correct. Petition at 22a to 28a.

D. Government Speech

The Government asserts, "the government's registration of a scandalous term as a trademark, which results in publication of that mark on the Principal Register and allows the registrant to use the mark with the ® symbol, would convey to the public that the United States regards scandalous images and terms as appropriate source identifiers in commerce." Petition at 24 to 25. Yet the government speech contention was rejected by all eight justices in Part III-A of Justice Alito's opinion in *Tam*. Private speech cannot be converted into government speech "by simply affixing a government seal of approval." *Tam*, 137 S. Ct. at 1758.

E. Government Program

The Government cites *Davenport v. Washington Ed. Assn.*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Ed. Assn.*, 555 U.S. 353 (2009). Part III-C of Justice Alito's opinion in *Tam* correctly distinguished those cases. *Tam*, 137 S. Ct. at 1762. If that portion of his opinion is not precedential under *Marks*, it is well-reasoned and should be persuasive in this case.

VI. The Scandalous Clause Is Unconstitutionally Vague

The Scandalous Clause is unconstitutionally vague. *Tam*'s footnote 5 (in Part II, decided seven-to-one) suggests the Court was concerned about the Disparagement Clause's vagueness, but the Court did not reach that issue. The Scandalous Clause does not give fair notice of what marks are or are not prohibited. This is confirmed by the Government's inconsistent and contradictory decisions on trademark applications. *See* Appendix A to Brunetti's Brief below, Docket 70. The Scandalous Clause grants excessive discretion to government officials.[6] The PTO's use and misuse of evidence, and the lack of an objective standard, exacerbates this concern.[7] The Government should also grant certiorari on this Question Presented.

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[6] In this case, Brunetti's application *was approved* for publication by the examining attorney assigned to the application. It was only after the application was approved for publication that the Government exercised the extraordinarily unusual step of withdrawing the application from publication.

[7] Applications are refused based upon dubious evidence (for example, in this case, the *Urban Dictionary*, which is "written" by anonymous postings, Petition at 6a to 7a). The PTO assumes that some, never-articulated, percentage of the population, will think the mark is offensive. The PTO never obtains opinion survey (in contrast to other areas of trademark practice). The PTO disregards actual evidence that a mark as used in the marketplace is not offensive. Petition at 62a to 63a.

CONCLUSION

Brunetti does not dispute that review by this Court is appropriate. The Court should grant certiorari, and affirm the Court of Appeals. In so doing, the Court can establish an unambiguous bright-line test for the precedential effect of plurality opinions.

Respectfully submitted,

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No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

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In the Supreme Court of the United States

No. 18-302

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

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REPLY BRIEF FOR THE PETITIONER

The court of appeals held that the ban on registration of immoral or scandalous trademarks in 15 U.S.C. 1052(a), which has guided federal registration decisions for 113 years, is unconstitutional under the Free Speech Clause of the First Amendment to the Constitution. If uncorrected, that decision will effectively preclude the United States Patent and Trademark Office (USPTO) from enforcing Section 1052(a)'s scandalous-marks provision against any applicant for trademark registration. The court of appeals' facial invalidation of an Act of Congress warrants this Court's review.

Although respondent defends the court of appeals' judgment, he agrees that this Court should grant certiorari to review the court of appeals' First Amendment holding. Respondent proposes that the Court also con-

sider whether the ban on federal registration of scandalous marks is unconstitutionally vague under the First and Fifth Amendments. The court of appeals did not address that contention, and no court has endorsed it. The government agrees, however, that if the Court grants review on the question presented in the petition, it should also consider that related question so that the constitutional validity of the scandalous-marks provision can be definitively resolved.

A. The Court Should Review The Court Of Appeals' Decision Invalidating Section 1052(a)'s Scandalous-Marks Provision

The court of appeals held that the scandalous-marks provision in 15 U.S.C. 1052(a) is invalid in all of its applications. See Pet. App. 46a. Respondent agrees (Br. 1-3) that the Court should review that holding. The question presented is "of great importance to the [g]overnment, other trademark owners, the public, and to [respondent]," Resp. Br. 1, and the USPTO has suspended action on trademark-registration applications implicating Section 1052(a)'s scandalous-marks provision while the government seeks review in this Court, Pet. 25.

Respondent argues (Br. 5-16) that the scandalous-marks provision, like the trademark provision that this Court held invalid in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), constitutes impermissible viewpoint-based regulation of speech. As the petition for certiorari explains, however, Section 1052(a) is not a regulation of speech at all. The provision does not forbid or restrict respondent's use of any type of speech. Pet. 16-18; see *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) ("[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression

because it does not affect the applicant's right to use the mark in question."). Respondent may use any vulgar term he wishes to identify his goods in commerce, and he may seek to enforce his vulgar mark under the Lanham Act, 15 U.S.C. 1051 *et seq.*, against others he believes have misappropriated any goodwill associated with it. Respondent simply may not enjoy the additional benefits that federal registration confers with respect to the vulgar mark at issue in this case.

While the same was true of the trademark-registration applicant in *Tam*, both of the lead opinions in *Tam* relied at least in part on the conclusion that Section 1052(a)'s ban on registration of "disparag[ing]" trademarks discriminated on the basis of viewpoint. See *Tam*, 137 S. Ct. at 1763 (Alito, J.); *id.* at 1766 (Kennedy, J.). The court below did not find that the scandalous-marks provision imposes such viewpoint discrimination. See Pet. App. 14a. Contrary to respondent's suggestion (Br. 11-12), this Court in *Cohen* v. *California*, 403 U.S. 15 (1971), did not hold that differential treatment of vulgar or profane speech discriminates on the basis of viewpoint. Rather, the Court concluded only that the criminal conviction at issue in that case rested on the "content of individual expression." *Id.* at 24. Indeed, even in the passage on which respondent relies, the *Cohen* Court recognized that the vulgarity of the defendant's words was unconnected to any "idea[]" he might have wished to convey. *Id.* at 26.

B. If This Court Grants Certiorari On The Question Presented In The Petition, It Should Consider As Well Whether Section 1052(a)'s Scandalous-Marks Provision Is Unconstitutionally Vague

Respondent contends (Br. 17) that Section 1052(a)'s scandalous-marks provision is unconstitutionally vague,

and that the Court should consider that challenge in addition to the question presented in the petition for a writ of certiorari. Respondent's vagueness challenge lacks merit, and neither the court below nor any other court has endorsed it. The government agrees, however, that if the Court grants certiorari to review the court of appeals' First Amendment holding, it should also consider the vagueness question so that the constitutionality of the scandalous-marks provision can be definitively resolved.

1. The scandalous-marks provision is not unconstitutionally vague. Section 1052(a) does not prohibit speech or impose any civil or criminal penalties, but simply precludes the federal government from providing a specified form of assistance to marks that contain scandalous terms. See Pet. 16-18. When a statute neither prohibits nor penalizes speech, but simply confers benefits on speakers whose expression satisfies certain criteria, the vagueness standard is relaxed because there is less concern about chilling speech. See *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 588-589 (1998). Under that more lenient standard, the Court has upheld even criteria that are "undeniably opaque" because "in the context of selective subsidies," "the consequences of imprecision are not constitutionally severe." *Ibid.*; see *id.* at 599 (Scalia, J., concurring in the judgment) ("Insofar as it bears upon First Amendment concerns, the vagueness doctrine addresses the problems that arise from government *regulation* of expressive conduct, not government grant programs.") (citation omitted). The scandalous-marks provision raises no vagueness concerns under that standard.

Contrary to respondent's contention (Br. 17), the USPTO relies on an objective standard to determine whether registration of a particular mark is prohibited

by the scandalous-marks provision. The USPTO does not allow individual examiners to rely on their own subjective views, but rather directs them to consider whether record evidence establishes that a "'substantial composite of the general public' would find the mark scandalous." Pet. App. 3a (quoting *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012)). Although respondent asserts (Br. 17) that this standard is arbitrarily enforced, analysis of whether a mark is scandalous requires consideration of the mark's meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used. See *Fox*, 702 F.3d at 635. Any superficial similarities between marks for which registration was granted and those for which it was denied therefore do not establish that the USPTO has erred in treating different marks differently.

In any event, the USPTO examines more than 400,000 trademark-registration applications each year. If an individual USPTO employee erroneously allows a mark to be registered, or erroneously refuses registration, "such errors do not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). Congress has authorized administrative and judicial review to ensure that such errors may be corrected, see 15 U.S.C. 1070, 1071, and if they are not, Congress has authorized cancellation of erroneous registrations "[a]t any time," 15 U.S.C. 1064(3). Those provisions reflect Congress's recognition that registration errors occasionally occur. Thus, even if respondent could identify a clear inconsistency between particular registration decisions, there would be no sound basis for concluding

that the scandalous-marks provision is incapable of principled application.

2. Although respondent's vagueness challenge to the scandalous-marks provision lacks merit, the government agrees that the Court should consider that issue if it grants review on the question presented in the certiorari petition. The Federal Circuit has expressed "concerns about the [scandalous-marks] provision's vagueness." Pet. App. 40a n.6. And although this Court "is 'a court of review, not of first view,'" *Byrd* v. *United States*, 138 S. Ct. 1518, 1527 (2018) (citation omitted), the question whether the scandalous-marks provision is an unconstitutionally vague restriction on speech is closely related to the question whether the provision regulates speech at all. This Court's consideration of respondent's vagueness challenge would ensure that the constitutionality of Section 1052(a)'s scandalous-marks provision can be definitively resolved.*

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* Respondent also suggests (Br. 3-5) that this case would present an opportunity for this Court to consider more abstractly how the analysis of fractured decisions under *Marks* v. *United States*, 430 U.S. 188 (1977), should be conducted. When the Court has previously reviewed a dispute about the application of *Marks* to a fractured prior decision, however, it has simply revisited the underlying question addressed in that decision rather than "pursu[ing] the *Marks* inquiry to the utmost logical possibility." *Nichols* v. *United States*, 511 U.S. 738, 746 (1994); see, *e.g.*, *Hughes* v. *United States*, 138 S. Ct. 1765, 1772 (2018); *Grutter* v. *Bollinger*, 539 U.S. 306, 325 (2003). In any event, respondent does not suggest that the Court would need to add an additional question to engage in *Marks* analysis.

* * * * *

For the foregoing reasons and those stated in the petition for a writ of certiorari, the petition should be granted. In addition, if the Court grants review on the question presented in the petition, the Court should also grant review on the question whether Section 1052(a)'s ban on federal registration of scandalous trademarks is unconstitutionally vague.

Respectfully submitted.

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DECEMBER 2018

No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOINT APPENDIX

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Docket No. 15-1109

IN RE: ERIK BRUNETTI, APPELLANT

DOCKET ENTRIES

DATE	DOCKET NUMBER	PROCEEDINGS
10/28/14	1	Appeal docketed. Date received: 09/22/2014. [193163] Entry of Appearance due 11/12/2014. Docketing Statement due 12/01/2014. Appellant/Petitioner's brief is due 12/29/2014.
	* * * * *	
11/26/14	8	Docketing Statement for the Appellee Lee. Service: 11/26/2014 by email. [200312]
	* * * * *	
12/30/14	18	Corrected Certificate of Interest for the Appellant Erik Brunetti. Service: 12/30/2014 by email. [206741]
12/30/14	19	Corrected Docketing Statement for the Appellant Erik Brunetti. Service: 12/30/2014 by email. [206742]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
1/28/15	22	BRIEF FILED for Appellant Erik Brunetti [21]. Number of Pages: 28. Service: 01/28/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 02/03/2015. Appellee Michelle K. Lee, Deputy Director, U.S. Patent and Trademark Office brief is due 03/12/2015. [213507]
		* * * * *
5/11/15	31	BRIEF FILED for Appellee Lee [30]. Number of Pages: .23. Service: 05/11/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 05/18/2015. Appellant Erik Brunetti reply brief is due 05/29/2015. [239784]
		* * * * *
5/29/15	37	REPLY BRIEF FILED for Appellant Erik Brunetti [35].

DATE	DOCKET NUMBER	PROCEEDINGS
		Number of Pages: 12. Service: 05/29/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/08/2015. Appendix is due 06/08/2015. [245274]
		* * * * *
6/12/15	40	APPENDIX FILED for Erik Brunetti [38]. Number of Pages: 464. Service: 06/12/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/22/2015. [249250]
		* * * * *
11/6/15	50	Submitted after ORAL ARGUMENT by John R. Sommer for Erik Brunetti and Daniel Tenny for Lee. Panel: Judge: Dyk, Judge: Moore, Judge: Stoll. [287135]
12/22/15	51	ORDER filed setting briefing schedule. The parties are directed to simultaneously file

DATE	DOCKET NUMBER	PROCEEDINGS
		letter briefs limited to 20 double-spaced pages, due within 30 days of this order. Appellant/ Petitioner's brief is due 01/21/ 2016. Appellee Michelle K. Lee, Director, U.S. Patent and Trademark Office brief is due 01/21/2016. By: Clerk (Per Curiam). Service as of this date by Clerk of Court. [298046]
1/21/16	52	Letter from Appellee Lee Responding to Court Order of December 22, 2015. Service: 01/21/2016 by email. [305270]
1/21/16	53	Letter from Appellant Erik Brunetti Appellant Brunetti's Letter Brief responding to Court Order of December 22, 2015. Service: 01/21/2016 by email. [305324]
4/22/16	54	Citation of Supplemental Authority pursuant to Fed. R. App. P. 28(j) for Appellee Lee. Service: 04/22/2016 by email. [328735]
10/18/16	55	Letter from Appellant Erik Brunetti re Request for Decision. Service: 10/18/2016 by email. [375618]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
6/20/17	58	ORDER filed requesting Letter Briefs. The parties are instructed to file letter briefs limited to 20 double-spaced pages. By: Court (Per Curiam). Service as of this date by Clerk of Court. [440880]
		* * * * *
7/20/17	60	BRIEF FILED (LETTER) of Appellee Joseph Matal [59] Number of Pages: 20. Service: 07/20/2017 by email. The paper copies of the brief should be received by the court on or before 07/28/2017. [448357]
		* * * * *
8/9/17	70	BRIEF FILED (LETTER) of Appellant Erik Brunetti [69] Number of Pages: 14. Service: 08/09/2017 by email. The paper copies of the brief should be received by the court on or before 08/17/2017. [452879]
		* * * * *
8/29/17	73	Submitted after ORAL ARGUMENT by John R. Sommer for Erik Brunetti and Joshua Marc Salzman for Joseph Matal.

DATE	DOCKET NUMBER	PROCEEDINGS
		Panel: Judge: Dyk, Judge: Moore, Judge: Stoll. [457411]
12/15/17	74	OPINION and JUDGMENT filed. The judgment or decision is: Reversed. (Precedential Opinion). (For the Court: Dyk, Circuit Judge; Moore, Circuit Judge and Stoll, Circuit Judge). Concurring opinion filed by Circuit Judge Dyk. [482888]
		* * * * *
2/12/18	77	Petition for en banc rehearing filed by Appellee Iancu. Service: 02/12/2018 by email. *The paper copies of the petition must be filed within two business days (see Fed. Cir. R. 35(c)(4). The required paper copies should be received by the court on or before 02/14/2018* [497086]
		* * * * *
2/26/18	79	The court invites a response from Appellant Erik Brunetti to the petition for en banc rehearing filed by Appellee in 15-1109. [501020]
3/12/18	80	RESPONSE of Appellant Erik Brunetti to the petition for en banc rehearing [77] filed by

DATE	DOCKET NUMBER	PROCEEDINGS
		Appellee Iancu in 15-1109. Service: 03/12/2018 by email. [504409]
		* * * * *
4/12/18	82	ORDER filed denying [77] petition for en banc rehearing filed by Iancu. By: En Banc (Per Curiam). Service as of this date by the Clerk of Court. [512775]
4/19/18	83	Mandate issued to the United States Patent and Trademark Office. Service as of this date by the Clerk of Court. [515355]
		* * * * *
9/7/18	86	Petition for writ of Certiorari filed on 09/07/2018, and placed on the docket 09/07/2018, in the Supreme Court of the United States. Supreme Court #: 18-302, Andrei Iancu v. Erik Brunetti. [548629]

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85310960
Filing Date: 05/03/2011

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	fuct
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	fuct
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	David Gollup

Input Field	Entered
INTERNAL ADDRESS	4315 Farm Brook Dr.
*STREET	4315 Farm Brook Dr.
*CITY	Cary
*STATE (Required for U.S. applicants)	North Carolina
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	27518
PHONE	9196292657
EMAIL ADDRESS	mostextreme@gmail.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY INFORMATION	
*TYPE	JOINT VENTURE
*STATE/COUNTRY WHERE LEGALLY ORGANIZED	North Carolina
APPLICANT INFORMATION	
*OWNER OF MARK	Christopher Maclachlan
INTERNAL ADDRESS	Apartment 1C
*STREET	107 Arbor Way
CITY	Cary
*STATE (Required for U.S. applicants)	North Carolina
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	27513

Input Field	Entered
PHONE	919--349-1195
EMAIL ADDRESS	ezenuf@nc.rr.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY INFORMATION	
*TYPE	JOINT VENTURE
*STATE/COUNTRY WHERE LEGALLY ORGANIZED	North Carolina
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	025
IDENTIFICATION	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS)	

Input Field	Entered
(if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
CORRESPONDENCE INFORMATION	
*NAME	David Gollup
FIRM NAME	David Gollup
*STREET	4315 Farm Brook Dr.
*CITY	Cary
*STATE (Required for U.S. applicants)	North Carolina
*COUNTRY	United States
*ZIP/POSTAL CODE	27518
PHONE	9196292657
*EMAIL ADDRESS	mostextreme@gmail.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	275
*TOTAL FEE PAID	275
SIGNATURE INFORMATION	
*SIGNATURE	/David Gollup/
*SIGNATORY'S NAME	David Gollup
*SIGNATORY'S POSITION	partner
*DATE SIGNED	05/03/2011

Input Field	Entered
*SIGNATURE	/Chris Maclachlan/
*SIGNATORY'S NAME	Chris Maclachlan
*SIGNATORY'S POSITION	partner
*DATE SIGNED	05/03/2011

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85310960
Filing Date: 05/03/2011

To the Commissioner for Trademarks:

MARK: fuct (Standard Characters, see mark)

The literal element of the mark consists of fuct.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicants, David Gollup, a joint venture legally organized under the laws of North Carolina, having an address of

4315 Farm Brook Dr.,
4315 Farm Brook Dr.
Cary, North Carolina 27518
United States

Christopher Maclachlan, a joint venture legally organized under the laws of North Carolina, having an address of

Apartment 1C,
107 Arbor Way
Cary, North Carolina 27513
United States

request registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the

Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 025: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Correspondence Information:

David Gollup
David Gollup
4315 Farm Brook Dr.
Cary, North Carolina 27518
9196292657(phone)
mostextreme@gmail.com (authorized)

A fee payment in the amount of $275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly autho-

rized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /David Gollup/ Date Signed: 05/03/2011
Signatory's Name: David Gollup
Signatory's Position: partner

Signature: /Chris Maclachlan/ Date Signed: 05/03/2011
Signatory's Name: Chris Maclachlan
Signatory's Position: partner

RAM Sale Number: 914
RAM Accounting Date: 05/04/2011

Serial Number: 85310960
Internet Transmission Date: Tue May 03 14:41:55 EDT 2011
TEAS Stamp: USPTO/FTK-174.97.252.61-20110503144155970902-85310960-4806e3aff2198b7f751eb9a3df16792a3e9-CC-914-20110503134638164090

fuct

To:	BRUNETTI, ERIK (sommer@stussy.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85310960 - FUCT - N/A
Sent:	7/3/2012 7:38:07 AM
Sent As:	ECOM111@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85310960

MARK: FUCT

85310960

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

CORRESPONDENT ADDRESS:
John R. Sommer
John R. Sommer, Attorney-at-Law
17426 Daimler Street
Irvine CA 92614

APPLICANT: BRUNETTI, ERIK

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
sommer@stussy.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 7/3/2012

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. § 2.23(a)(2); TMEP §§ 819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. § 2.6(a)(1)(iv); TMEP § 819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

The referenced application has been further reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. § 1062(b); 37 C.F.R. §§ 2.62(a), 2.65(a);

TMEP §§ 711, 718.03. The application is unregistrable. The term FUCT is a novel spelling of a disparaging restricted vulgar term. There have been several attempts to register this term for several years but it has usually failed. **A good example is the dead application No. 78931017.** The examining attorney apologizes for not raising this issue in the previous office action. The term is obviously unregistrable as indicated below.

REFUSAL—MARK IS A VULGAR TERM

Registration is refused because the applied-for mark consists of or includes immoral or scandalous matter. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see* TMEP § 1203.01.

The words "immoral" and "scandalous" may have somewhat different connotations; however, immoral matter has been included in the same category as scandalous matter. TMEP § 1203.01; *see In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981) (Because of the court's holding that appellant's mark was scandalous, "it [was] unnecessary to consider whether appellant's mark [was] 'immoral.' [The court] note[d] the dearth of reported trademark decisions in which the term 'immoral' [had] been directly applied.").

To be considered "scandalous," the evidence must show that a mark would be considered shocking to the sense of decency or propriety, giving offense to the conscience or moral feelings, or calling out for condemnation. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996); *see* TMEP § 1203.01.

A mark is immoral or scandalous when the evidence shows that a substantial composite of the general public (although not necessarily a majority) would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *See In re The Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1148 (TTAB 2011); TMEP § 1203.01.

In this case, applicant seeks registration of FUCT for "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments." The attached evidence from Urban Dictionary shows this wording is the "past tense of the verb fuck. Also used to express a general state of incapability." Therefore, the word FUCT is scandalous because it is disparaging and a total vulgar. It is unregistrable.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. § 2.191; TMEP §§ 304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining

attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§ 705.02, 709.06.

/Zachary Bello/
Attorney Advisor
Law Office 111
USPTO
571-272-9376
zack.bello@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to his application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the

complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To:	BRUNETTI, ERIK (sommer@stussy.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85310960 - FUCT - fuct,25
Sent:	1/27/2013 11:15:31 AM
Sent As:	ECOM111@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6 Attachment - 7 Attachment - 8 Attachment - 9 Attachment - 10 Attachment - 11 Attachment - 12 Attachment - 13 Attachment - 14 Attachment - 15 Attachment - 16 Attachment - 17 Attachment - 18 Attachment - 19 Attachment - 20 Attachment - 21 Attachment - 22 Attachment - 23 Attachment - 24 Attachment - 25 Attachment - 26 Attachment - 27

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Attachment - 53

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85310960

MARK: FUCT

85310960

CLICK HERE TO RESPOND TO THIS LETTER

http://www.uspto.gov/trademarks/teas/response_forms.jsp

CORRESPONDENT ADDRESS:

JOHN R. SOMMER
JOHN R. SOMMER, ATTORNEY-AT-LAW
17426 DAIMLER STREET
IRVINE CA 92614

APPLICANT: BRUNETTI, ERIK

CORRESPONDENT'S REFERENCE/DOCKET NO:

fuct,25

CORRESPONDENT E-MAIL ADDRESS:
sommer@stussy.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/27/2013

THIS IS A FINAL ACTION.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. § 2.23(a)(2); TMEP §§ 819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. § 2.6(a)(1)(iv); TMEP § 819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

This Office action is in response to applicant's communication filed on 01/02/13.

FINAL REFUSAL—MARK IS A VULGAR TERM

Registration is refused because the applied-for mark consists of or includes immoral or scandalous matter. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see* TMEP § 1203.01. The term, which is the past tense of FUCK, is unregistrable because it is immoral and scandalous. Evidence included in the office action of 07/03/12.

The words "immoral" and "scandalous" may have somewhat different connotations; however, immoral matter has been included in the same category as scandalous

matter. TMEP § 1203.01; *see In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981) (Because of the court's holding that appellant's mark was scandalous, "it [was] unnecessary to consider whether appellant's mark [was] 'immoral.' [The court] note[d] the dearth of reported trademark decisions in which the term 'immoral' [had] been directly applied.").

To be considered "scandalous," the evidence must show that a mark would be considered shocking to the sense of decency or propriety, giving offense to the conscience or moral feelings, or calling out for condemnation. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996); *see* TMEP § 1203.01.

A mark is immoral or scandalous when the evidence shows that a substantial composite of the general public (although not necessarily a majority) would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *See In re The Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1148 (TTAB 2011); TMEP § 1203.01.

In this case, applicant seeks registration of FUCT for "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments." The attached evidence from Urban Dictionary shows this wording is the "past tense of the verb fuck. Also used to express a general state of incapability." Therefore, the word FUCT is scandalous because it is disparaging and a total vulgar. The

proposed mark is therefore, unregistrable under Section 2(a).

The applicant admits that the term is vulgar but argues it has an alternative meaning, i.e., SCREWED. The term SCREWED is also a vulgar according to many dictionaries. See attachments of the term. Also, applicant has used the term FUCT in a vulgar manner as indicated on applicant websites. See attachments labeled BEST 1-17. Where a word or phrase has multiple relevant meanings, at least one of which is arguably scandalous and at least one not, specimen use or a design element that reinforces the scandalous meaning(s) is persuasive evidence that a substantial composite of the general public will consider the term or phrase scandalous. *In re Wilcher Corp.*, 40 USPQ2d 1929, 1933-34 (TTAB 1996) (holding application for DICK HEADS with accompanying design scandalous where the design portion comprised "a graphic, readily recognizable representation of male genitalia," and thus "the vulgar significance of applicant's mark . . . plays a very dominant role in the commercial impression created by the mark"); *see* TMEP § 1203.01; *cf. In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988) (holding BIG PECKER not scandalous where specimens of record showed use of the mark in connection with a picture of a bird, thus reinforcing the non-scandalous meaning of PECKER as a bird). In the instant case, the applicant's indiscriminate vulgar use supports examiner's assertion.

Further, dictionary definitions alone may be sufficient to show that a term is vulgar if multiple dictionaries, including at least one standard dictionary, uniformly

indicate that the term's meaning is vulgar, and the applicant's use of the term is clearly limited to that vulgar meaning. *See In re The Boulevard Entm't, Inc.*, 334 F.3d at 1341, 67 USPQ2d at 1478 (holding 1-800-JACK-OFF and JACK-OFF scandalous where all dictionary definitions of "jack-off" were considered vulgar); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1588 (TTAB 2008) (holding SEX ROD in stylized form scandalous where multiple dictionary definitions of "rod" characterized that term vulgar, such that when preceded by the word "sex" denoted only one meaning); TMEP § 1203.01. Here, evidence from Urban Dictionary previously submitted is sufficient to conclude that the mark is unregistrable under Section 2(a). Accordingly, refusal to register under Section 2(a) is maintained and made FINAL.

OPTIONS AFTER A FINAL REFUSAL OR REQUIREMENT

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.65(a). Applicant may respond by providing one or both of the following:

(1) A response that fully satisfies all outstanding requirements;

(2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of $100 per class.

37 C.F.R. § 2.64(a); TMEP § 714.04; *see* 37 C.F.R. § 2.6(a)(18); TBMP ch. 1200.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. § 2.191; TMEP §§ 304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§ 705.02, 709.06.

/Zachary Bello/
Attorney Advisor
Law Office 111
USPTO
571-272-9376
zack.bello@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

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Trademark Snap Shot Publication & Issue Review Stylesheet (Table presents the data on Publication & Issue Review Complete)			
OVERVIEW			
SERIAL NUMBER	85310960	FILING DATE	05/03/2011
REG NUMBER	0000000	REG DATE	N/A
REGISTER	PRINCIPAL	MARK TYPE	TRADE-MARK
INTL REG #	N/A	INTL REG DATE	N/A
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STATUS DATE	06/11/2012		
LITERAL MARK ELEMENT	FUCT		
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SECTION 8	NO	SECTION 8 IN PART	NO
SECTION 15	NO	REPUB 12C	N/A

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DATE AMEND REG	N/A		

FILING BASIS					
FILED BASIS		CURRENT BASIS		AMENDED BASIS	
1 (a)	NO	1 (a)	YES	1 (a)	NO
1 (b)	YES	1 (b)	NO	1 (b)	NO
44D	NO	44D	NO	44D	NO
44E	NO	44E	NO	44E	NO
66A	NO	66A	NO		
NO BASIS	NO	NO BASIS	NO		

MARK DATA	
STANDARD CHARACTER MARK	YES
LITERAL MARK ELEMENT	FUCT
MARK DRAWING CODE	4-STANDARD CHARACTER MARK
COLOR DRAWING FLAG	NO

CURRENT OWNER INFORMATION	
PARTY TYPE	11-SUBSEQUENT OWNER BEFORE PUBLICATION
NAME	BRUNETTI, ERIK
ADDRESS	8033 SUNSET BLVD. SUITE 146 LOS ANGELES, CA 90046
ENTITY	01-INDIVIDUAL

CITIZENSHIP	United States of America

GOODS AND SERVICES	
INTERNATIONAL CLASS	025
DESCRIPTION TEXT	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments

GOODS AND SERVICES CLASSIFICATION							
INTERNATIONAL CLASS	025	FIRST USE DATE	12/31/1991	FIRST USE IN COMMERCE DATE	12/31/1991	CLASS STATUS	6-ACTIVE

MISCELLANEOUS INFORMATION/STATEMENTS	
CHANGE IN REGISTRATION	NO

PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM
06/11/2012	PREV	O	LAW OFFICE PUBLICATION REVIEW COMPLETED	027
06/06/2012	ALIE	A	ASSIGNED TO LIE	026
06/06/2012	ALIE	A	ASSIGNED TO LIE	025
05/22/2012	AAUA	E	NOTICE OF ACCEPTANCE OF	024

			AMENDMENT TO ALLEGE USE E-MAILED	
05/20/2012	CNSA	O	APPROVED FOR PUB-PRINCIPAL REGISTER	023
05/20/2012	IUAA	P	USE AMENDMENT ACCEPTED	022
05/19/2012	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	021
05/18/2012	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	020
05/18/2012	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	019
05/19/2012	AAUD	F	AMENDMENT OF ALLEGED USE DISAPPROVED	018
05/19/2012	AUPC	I	AMENDMENT TO USE PROCESSING COMPLETE	017
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05/16/2012	TCCA	I	TEAS CHANGE OF CORRESPONDENCE RECEIVED	014
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12/22/2011	GNRN	O	NOTIFICATION OF NON-FINAL ACTION E-MAILED	012
12/22/2011	GNRT	O	NON-FINAL ACTION E-MAILED	011

12/22/2011	CNRT	R	NON-FINAL ACTION WRITTEN	010
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08/16/2011	GNRT	F	NON-FINAL ACTION E-MAILED	005
08/16/2011	CNRT	R	NON-FINAL ACTION WRITTEN	004
08/15/2011	DOCK	D	ASSIGNED TO EXAMINER	003
05/9/2011	NWOS	I	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	002
05/6/2011	NWAP	I	NEW APPLICATION ENTERED IN TRAM	001

CURRENT CORRESPONDENCE INFORMATION	
ATTORNEY	NONE
CORRESPONDENCE ADDRESS	John R. Sommer John R. Sommer, Attorney-at-Law 17426 Daimler Street Irvine CA 92614
DOMESTIC REPRESENTATIVE	NONE

PRIOR OWNER INFORMATION	
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ENTITY	01-INDIVIDUAL
CITIZENSHIP	United States of America
PARTY TYPE	10-ORIGINAL APPLICANT
NAME	Christopher Maclachlan
ADDRESS	Apartment 1C 107 Arbor Way Cary, NC 27513
ENTITY	05-JOINT VENTURE
CITIZENSHIP	North Carolina

DECLARATION OF ERIK BRUNETTI

I, Erik Brunetti, declare and say:

1. I make this declaration in connection with my trademark application for FUCT. My background is street culture. I was invited to create the piece "Lost" as part the 2011 Los Angeles Museum of Contemporary Art ("MOCA") "Art In The Streets" exhibition.

2. I am the founder, owner and creator of the FUCT street fashion brand. I have been its head designer from the inception of the brand until the present.

3. The brand was founded in 1990 as a street fashion brand, part of a movement that created edger clothing, such as Stussy and Hysteric Glamour.

4. The name of the FUCT brand is an arbitrary made up word. However, to the extent I am asked for a meaning I refer to FRIENDS U CAN'T TRUST. See, Exhibit "4."

5. The FUCT brand does not refer to "fuck" or the act of sexual intercourse.

6. In the 22 years since its creation, the FUCT brand has been sold throughout the United States and worldwide. The brand has been sold in a variety of retailers, from small skate and street fashion shops up to the worldwide retailer Urban Outfitters (see Exhibit 1 for background about Urban Outfitters) and the worldwide webstore KarmaLoop.Com (for background on KarmaLoop.Com see Exhibit 2).

7. FUCT's products do not show anything that refers to sexual intercourse. Nor does its blog. Exhibit "3."

In fact, there is very little in FUCT's products that could even be considered in bad taste.

8. In the 22 years of the brand's existence, it has received only one complaint about the brand being vulgar. That complaint was in the early 1990's. The absence of other complaints over 22 years, shows that FUCT is not viewed as vulgar or obscene or scandalous. None of the retailers that carry FUCT have told me that they have received complaints.

9. Other brands have done collaborations with FUCT, for example SSDD and Ebbetts Field Flannels. Exhibit "3" and Exhibit "5." Other brands that have done collaborations with FUCT are The Hundreds, David Mann, Larry Clark and Medicom.

10. They would not have done so had so had FUCT been vulgar or scandalous or obscene.

11. Even if FUCT is considered equivalent to FUCKED or FUCKED UP, those uses are not vulgar. Exhibit "6."

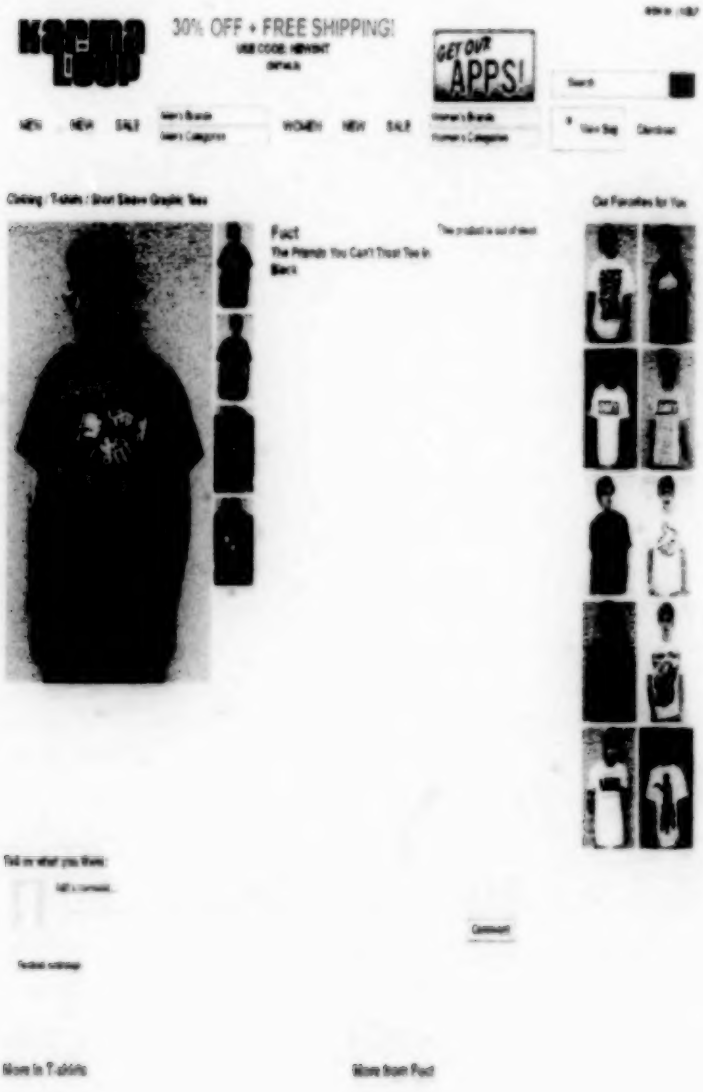
12. The word "fucked" means "to be cheated" or the same meaning as "screwed" or "everything is messed up." I am informed that the U.S. Patent & Trademark Office does not consider "screwed" to be vulgar since it has approved a number of registrations. Exhibit "7." So my brand should not be discriminated against.

13. The failure to allow FUCT to be registered makes it more difficult to protect the FUCT brand in the USA and worldwide.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

/s/ ERIK BRUNETTI
ERIK BRUNETTI

Exhibit 4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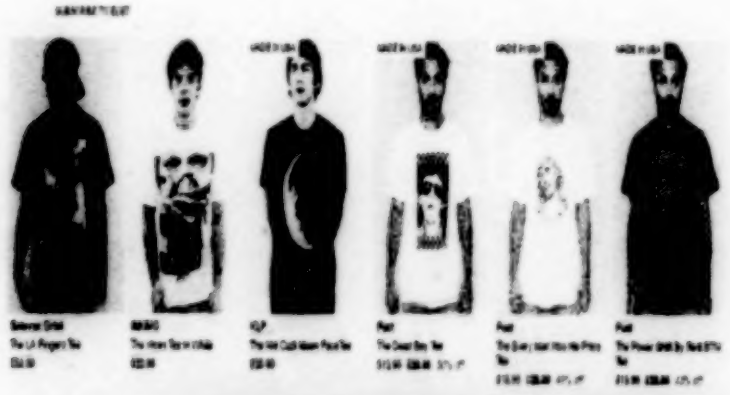

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Hrvatski
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中文

Fuck

From Wikipedia, the free encyclopedia
Redirected from Fuck (word)

This article is about the profanity. For other uses, see Fuck (disambiguation).

Fuck in its literal meaning refers to the act of sexual intercourse. It is an English word that is almost universally considered vulgar. It is often used as a profanity, either to denote disdain or as an interjection.

The origin of the word is obscure. It is usually considered to be first attested to around 1475, but it may be considerably older. In modern usage, *fuck* and its derivatives (such as *fucker* and *fucking*) can be used in the position of a noun, a verb, an adjective or an adverb. There are many common phrases which make use of the word, as well as a number of compounds incorporating it, such as *motherfucker*.

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Offensiveness

The word's use is considered obscene in social contexts, but may be common in informal and domestic situations. It is unclear whether the word has always been considered vulgar, and if not, when it first came to be used to describe (often in an extremely angry, hostile or belligerent manner) unpleasant circumstances or people in an intentionally offensive way, such as in the term *motherfucker*, one of its most

derogatory manner), unpleasant circumstances or people in an intensionally offensive way, much as in any such combination, and as in many common usages in some parts of the English-speaking world. In the modern English-speaking world, the word *fuck* is often considered highly offensive when English-speaking countries censor it on television and radio. A study of the attitudes of the British public found that *fuck* was considered the third most severe profanity and its derivative *motherfucker* second. *Cunt* was considered the most severe (Hargrave, 2008). Some have argued that the prolific usage of the word *fuck* has de-sexualized it, an example of the "dysphemism treadmill." Despite its offensive nature, the word is common in popular usage.

The term remains a taboo word to many people in English-speaking countries. The word also carries a sacrilegious connotation to some. [*citation needed*] Many religious people oppose the use of profane, vulgar, and "curse" words which they see as offensive to a deity. It is considered highly offensive to utter the word in the presence of children.

The Canadian Press now considers the word to be commonplace and has added usage advice to the *Canadian Press Caps and Spelling guide*.[1]

Etymology

The *Oxford English Dictionary* states that the ultimate etymology is uncertain, but that the word is "probably cognate" with a number of native Germanic words with meanings: *penetrate, striking, rubbing,* and *having sex*.[2]

"Fren, flyys and frenis"

The usually accepted first known occurrence is in code in a poem in a mixture of Latin and English composed some time before 1630. The poem, which satirizes the Carmelite friars of Cambridge, England, takes its title, "Fren flyys", from the first words of its opening line: *Fren flyys, and frere lyn* ("Friars flies, and friars lie"). The line that contains *fuck* reads *Non sunt in coreL, qoau gaskBoue wnuuf pg rfnck*. Removing the substitution cipher (here, replacing each letter by the next letter in alphabetical order, as the English alphabet was then) on the phrase "*gaskBoue wnuuf pg rfnck*" yields *non sunt in coreL, qoau fecerunt vmyor ad feck*, which translated means, "They are not in heaven because they fuck wives at Eely".[3] The phrase was coded likely because it accused some Church personnel of misbehaving; it is uncertain to what extent the word *fuck* was considered acceptable at the time. (The stem of *fecerunt* is an English word used as Latin. English-medieval Latin has many examples of writers using English words when they did not know the Latin word; "wodewrannes" is an example.) In the Middle English of this poem, the term *wife* was still used generically for "woman."

Older etymology

Via Germanic

The word has probable cognates in other Germanic languages, such as German *ficken* (to fuck), Dutch *fokken* (to breed, to strike, to beget), dialectal Norwegian *fukka* (to copulate), and dialectal Swedish *fokka* (to strike, to copulate) and *fock* (penis).[4] This points to a possible etymology where Common Germanic *fuk-* comes from an Indo-European root meaning "to strike" cognates with non-Germanic words such as Latin *pugnus* "fist".[5] By reverse application of Grimm's law, this hypothetical root has the form **pug-*. In early Proto-Germanic the word was likely used at first as a slang or euphemistic replacement for an older word for "intercourse," and then became the usual word for "intercourse."[*citation needed*]

Yet another possible etymology is from the Old High German word *skiuhan* meaning "to plow, as in a field." This is supported in part by a book by Carl Jung, *Psychology of the Unconscious: A Study of the Transformations and Symbolisms of the Libido*, in which he discusses the "primitive play of words" and the phallic representation of the plough, including its appearance on a vase found in an archaeological dig near Florence, Italy, which depicts six erect penises men carrying a plow.

The original Indo-European root for to copulate is likely to be "*h*$_3$*eyH*^{1}– or "*h*$_3$*ewH*^{1}–, which is attested in Sanskrit *inóti* (*enóti*), Russian *ebat'* (*ebat'*), Polish *jebać*, and Serbian *jebem* (*jebem*), among others; compare the Greek verb *oipu* (*oipō*) = "I have sex with", and the Greek noun *Ζέφυρος* (*Zéphyros*) (which references a Greek belief that the west wind *Zephyros* caused pregnancy).

Via Latin or Greek

- Other possible connections are to Latin *futuere* (almost exactly the same meaning as the English verb "to fuck"), but it would have to be

- [illegible] explained how the word reached Scandinavia from Roman contact, and how the *f* became /k/.[citation needed] From Kilwa came French *foutre*, Catalan *fotre*, Italian *fottere*, Romanian *fotere*, vulgar peninsular Spanish *follar* and *joder*, and Portuguese *foder*. However, there is considerable doubt and no clear lineage for these derivations. These roots, even if cognates, are not the original Indo-European word for to copulate, but Weyland Young (who agrees that these words are related) argues that they derive from the Indo-European "*bʰ*ŏ-" or "*bʰ*ŏ-" ("fist", "hammer"), or as causative "create" (see Young, 1964). A possible intermediate might be a Latin 4th declension verbal noun **fŭtus*, with possible meanings including "act of (penis) rutting".
- Greek *χύω* (*khýo*) has various meanings, including (of a man) "to beget", or (of a woman), "to give birth to".[4] Its perfect passive (*mipuxa*) can be likened[citation needed] to "fuck" and its equivalents in other Germanic languages.[4]

False etymologies

One reason that the word fuck is so hard to trace etymologically is that it was used far more extensively in common speech than in easily traceable written forms. There are several urban legend false etymologies postulating an acronymic origin for the word. None of these acronyms was ever recorded before the 1960s, according to the authoritative lexicographical work *The F Word*, and thus are backronyms. In any event, the word fuck has been in use for too long for some of these supposed origins to be possible. Some of these urban legends are that the word fuck came from Irish law. If a couple were caught committing adultery, they would be punished "For Unlawful Carnal Knowledge in the Nude," with "FUCKN" written on the stocks above them to denote the crime. A similar variant on this theory involves the recording by church clerks of the crime of "Forbidden Use of Carnal Knowledge." Another theory is that of a royal permission. During the Black Death in the Middle Ages, towns were trying to control populations and their interactions. Since uncontaminated residences were scarce, many towns required permission to have children. Hence, the legend goes, that couples that were having children were required to first obtain royal permission (usually from a local magistrate or lord), and then place a sign somewhere visible from the road in their home that said "Fornicating Under Consent of King," which was later shortened to "FUCK." This story is hard to document, but was persistent in oral and literary traditions for many years; however, it has been disreputated to be an urban legend.[5]

Early usage

Its first known use as a verb meaning to have sexual intercourse is in "Flen flyys," written around 1475.

William Dunbar's 1503 poem "Ballad of Wyllyng" includes the lines "Yit be he lattis me walk haue fulfill, / Yit lemk my hair, my tarry arss" (ll. 13–14).

John Florio's 1598 Italian-English dictionary, *A Worlde of Wordes*, included this term, along with several now archaic, but then vulgar synonyms, in this definition:

- Fottere. *To jape, to sport, to fucke, to swive, to occupy.*

Of these, "occupy" and "jape" still survive as verbs, though with less virulent meanings, while "swive" was a descendant of the Anglo-Saxon verb *swefan* (or *swebban*, <ON *sveifa*), to copulate, and "swive" had derived from *svifan*, to revolve i.e. to swivel (compare modern-day "screw").

While Shakespeare never used the term explicitly, he hinted at it in comic scenes in a few plays. *The Merry Wives of Windsor* (IV.i) contains the expression *Acome* cade (see vocative case). In *Henry V* (V.iv), Pistol threatens to *frit* (strike) a soldier, a euphemism for *fuck*.

Rise of modern usage

Though it appeared in John Ash's 1775 *A New and Complete Dictionary*, listed as "low" and "vulgar," and appearing with several definitions,[6] fuck did not appear in any widely consulted dictionary of the English language from 1755 to 1900, its first appearance in the Oxford English Dictionary (along with the word cunt) was in 1972. There is anecdotal evidence of its use during the American Civil War.[citation needed]

Modern usage

[illegible] to look at its linguistic life. It is also used as a non-gendered equivalent of the idea. Some instances of the word can be taken at face value, such as "Let's fuck," "I would fuck this/her," or "favorite fucks." Other uses are [illegible]. The sexual connotation usually remains as a reminder, in the case of "go fuck yourself" or "go fuck yourself in the ear", or implied, as more additional examples, in [illegible] usage or outrage. For example, "Fuck that!" "Fuck off!" or "Fuck you!" By itself, fuck usually used as an exclamation indicating surprise, pain, fear, disgust, disappointment, anger, or a sense of extreme egoism. In this usage, there is no [illegible] to the sexual meaning of the word implied, and is used purely for its "strength" as a vulgarity. Additionally, other uses are similarly required. Such [illegible] such as the fuck or "fucking" could be removed and retain a sentence of identical syntactical meaning. For example, my cousin, then used the word fucking as an emphatic adjective ("I'm the fucking tour") for the word's emphatic [illegible].

[illegible] of the most [illegible] used as an example for displaying the [illegible] of an English-language word. This is the use of fuck as more specifically fucking as an "-ing" or [illegible] gerund (i.e. existing, existing). For example, the word [illegible] [illegible] source as acceptable to the English ear, and is in fairly common use, while [illegible] [illegible] would very clearly. Though depending on the context, this might be perceived as a humorous representation of the word. Also, fucking today and motherfucking are also [illegible] uses of fuck as an -ing. While neither [illegible] nor connected to the sexual connotations of the word, even the exclusive usage of [illegible] [illegible] and [illegible], and [illegible] in some models, for example, "Name of you, fucking superstar" or "Shut the fuck up!" A common usage is "Get fucked", which in a non-[illegible] context would translate as "get stuffed." The word is one of the few that has legitimate [illegible] usage as a verb, adverb, adjective, [illegible], [illegible], [illegible], [illegible], noun and pronoun.

In another usage, the word fucker is used as a term of endearment rather than derogatory. This usage is not uncommon, to say "you're one great fucker" is often a term of affection. However, because of its ambiguity and vulgarity, the word fucker in reference to another person can easily be misinterpreted. Though fucker can serve as a noun, the fucker form is used in a context that refers to an [illegible]. Normally in these cases, it took a word instead of fucker, the sentence refers to the sexual ability of the subject (for example, "He's a great fucker"). Although confusingly in a romantic, of succession, the word "fuck" can hold exactly the same meaning as fucker (e.g. when preceded by an adjective, "You're a really great fuck.")

Finally, to fucker is the most multifaceted. Sometimes used as an adjective itself—an accusation of more—this form is also [illegible] and its [illegible] [illegible] use. For example, "He's a [illegible] motherfucker" does not mean "He's abusive. Why are [illegible] with his mother," but "He's someone to be afraid of." In this context, some gang members might even describe themselves as "motherfuckers." The word fuck is used in many forms of music, with motherfucker being used as a rhythmic filler in hip hop, urban music and some rock genres' examples include "The Orchid Mistress's song "Name of the Game" and Futureglo's "Don't Say Motherfucker Motherfucker" [illegible] motherfucker's mysterious [illegible] is due to its [illegible], [illegible] in making it a staple in the popular music that is written in 64 meters. Also contributing to its use in aggressive, high-energy music is the fact that it includes a hard "k" sound in its first syllable, making it easy to scream, particularly when pronounced as "motha fucka". Despite these rhythmic qualities, motherfucker has not become as accepted in English usage as its root fuck.

A more succinct example of the flexibility of the word in its use in idiomic ways went in a sentence. In his book, Wartime: Understanding and Behavior in the Second World War, Paul Fussell, literary historian and [illegible] emeritus of English [illegible] at the University of [illegible], recounted:

> Once, on a misty Scottish parade, an airman was changing the insignia on the epaulet of a Washington barrister. Suddenly his enemy slipped and he flung it on the ground and shouted, "Fuck! The fucking farmer's backed." The bystanders were all quiet and solemn. Had he had dropped a bird and shouted his true thing?[1]

The phrase "fuck you, you fucking fuck" is a memorable gem from the more [illegible] novel Fight Club, and a cult-[illegible] song in itself is Snapping Young Lad's "You Suck" from their 2006 album The New Black. Another example is "Fuck the Fucking Fuckers" because of its vulgar status. The word fuck is usually restricted in music [illegible] and banned from [illegible] in the United States. In 2002, when the [illegible] from the Stone Roses (2002) was released in the U.S., its title was changed to Fools Like, rather than the band Fuck Me, though the lyrics were [illegible] to reflect. Similarly, the Swedish film Fucking Åmål was retitled Show Me Love.

Other forums are public, such may cancel the word by use of [illegible]. For example, Fox Cable censors the word fuck with [illegible]. There [illegible] the word are especially [illegible] in cases of [illegible] [illegible] artists. To avoid these filters, many artists will use

http://en.wikipedia.org/w/index.php?title=... 12/26/2011 8:xx:xx AM

Others include the word with asterisks ("f**k"), partially or with other substitutions, usually when quoting what was said by others. This particular alteration is a common usage at the Massachusetts Institute of Technology, where students use it in reference to the machine on MIT's neoclassical buildings, in which the letter *C* is replaced by *X*. A typical usage in this vein would be "I'm locked by the macine." Other less common spellings to cheat a censor are "fuck" and "phuck". Another way to bypass a word filter is to use text, both the letters F[_]CK or FU_CK, for example.

The word *fuck* is a component of many acronyms, some of which—like *SNAFU* and *FUBAR*—date as far back as World War II. Many more recent usages, such as the shortened "WTF" for "what the fuck", "STFU" for "shut the fuck up," or "FML" for "fuck my life," have also widely existed on the Internet, and may count as examples of memes. Many acronyms will also have an "f" or "fk" added to increase emphasis, for example, "OMG" ("oh my God") becomes "OMFG" ("oh my fucking God"). Abbreviated versions of this word tend not to be considered as offensive. Despite the prevalence and ubiquity of the word, several comedians rely on *fuck* for comedic purposes. George Carlin created several literary works based upon the word. Other comedians who use or used the word consistently in their routines include Billy Connolly, Doris Kapy, Jean Black, Andrew Dice Clay, Chris Rock, Richard Pryor, Eddie Murphy, and Sam Kinison.

Examples of more recent usage

In 1991, D. H. Lawrence's novel *Lady Chatterley's Lover* gained notoriety for its frequent use of the words *fuck*, *fucked*, and *fucking* (which censored).

Perhaps the earliest usage of the word in sound movie was the 1938 Early Autumn release of the Louis Armstrong song "Ol' Man Mose" (movie version).

The liberal usage of the word (and other vulgarisms) by certain artists (such as James Joyce, Henry Miller, Lenny Bruce, Peter Cook and Jonathan Miller, in their various and often overlapping spheres of influence) led to the banning of their works and criminal charges of obscenity.[citation needed]

The Catcher in the Rye by J. D. Salinger featured the use of *fuck you* in print. First published in the United States in 1951, the novel remains controversial to this day due to its use of the word, standing at number 13 for the most banned books from 1990–2000 according to the American Library Association.[5]

The first documented use of the word *fuck* on the British television (and probably on any television system) has been attributed to theatre critic Kenneth Tynan in 1965. Controversy also ensued in 1976 when Today host Bill Grundy interviewed the Sex Pistols, after guitarist Steve Jones called Grundy a "dirty bastard" and a "fucking rotter".[6] (see EMI and the Grundy incident)

Use in politics

Profanity is not widely used in politics, and any use by notable politicians tends to produce controversy. Some events of the nature include:

- In 1965, U.S. President Lyndon B. Johnson said to the Greek ambassador Alexandros Matsas when he objected to American policy in Cyprus, "Fuck your parliament and your constitution. America is an elephant, Cyprus is a flea. Greece is a flea. If these two fleas continue itching the elephant, they may just be attacked by the elephant's trunk, whatever goes."[7][8][9]
- During the 1968 Democratic National Convention, Chicago mayor Richard Daley became so enraged by a speech from Abraham A. Ribicoff that he shouted "Fuck you!"[7][10] Daley would also cover that he was shouting "You Jew, you" and calling Ribicoff a "Jew".[11] On the last night of the same convention, which was President Johnson's birthday, a huge crowd of thousands of yippies, hippies and anti-Vietnam war protesters was formed. Whilst on live simultaneously making "Fuck you, Lyndon Johnson!"[7][8][12][13]
- During debate in February 1977 in the Canadian House of Commons, Canadian Prime Minister Pierre Trudeau mouthed the words "fuck off" under his breath (perhaps almost identify) at Conservative MP John Lundrigan, while Lundrigan made some comments about unemployment. Afterward, when asked by a television reporter what he had been thinking, Trudeau famously replied "What is the nature of your thoughts, gentlemen, when you say 'fuddle duddle' or something like that?" "Fuddle duddle" consequently became a catchphrase in Canadian media associated with Trudeau.[14]
- The first accepted modern use in the British House of Commons came in 1982 when Reg Race, Labour MP for Wood Green, referred to actions allegedly made by constituents which read "There there and fuck them." However, the full extent of remarks, termed "f**** them", had been thus euphemism was deprecated by the Speaker, George Thomas.[15]
- Shortly after Tony Blair was elected Leader of the Labour Party, he then MP Labour MP George Galloway told a public meeting "I don't give a fuck what Tony Blair thinks" when questioned about his party's move to the right.[16]

- In late 2002, US presidential candidate Senator John Kerry used the word fuck in an interview with Rolling Stone following his vote in favor of the resolution authorizing President George W. Bush to use military force in Iraq. Senator John Kerry stated, "I voted for what I thought was best for the country. Did I expect Howard Dean to go all to the left and say, 'I'm against everything?' Sure. Did I expect George Bush to fuck it up as badly as he did? I don't think anybody did."[20]
- In June 2004, during a heated exchange on the U.S. Senate floor about Haliburton's role in the reconstruction of Iraq, Vice President Dick Cheney told Democratic senator Patrick Leahy, "Go fuck yourself." Coincidentally, Cheney's outburst occurred on the same day that the Defense of Decency Act was passed in the Senate.[21]
- In February 2006 (Australia), New South Wales Premier Morris Iemma, while awaiting the start of a Council of Australian Governments media conference in Canberra, was chatting to Victorian Premier Steve Bracks. Not realising cameras were operating he was recorded as saying "Today? The fuckwit who's the new CEO of the Cross City Tunnel has ... been saying what controversy! There is no controversy."[22] The exchange referred to the newly appointed CEO of a recently opened toll road within Sydney.
- On January 31, 2007, New York Governor Eliot Spitzer angrily reacted to Assembly Minority Leader James Tedisco, "Listen, I'm a fucking steamroller, and I'll roll over you and anybody else." According to The New York Post, Spitzer confirmed the exchange the following day.[23]
- In 2007, U.S. Senator John Cornyn objected to John McCain's perceived intrusion upon a Senate meeting on immigration, saying, "What a shocker here. I've been sitting in here for all of these negotiations and you just parachute in here on the last day. You're out of line." McCain, known for his short temper,[24] replied, "Fuck you! I know more about this than anyone else in the room."[25][26]
- In April 2007, New Zealand Education Minister Steve Maharey said "fuck you" to a fellow MP during parliamentary question time.[27] He apologized shortly afterwards.
- In December 2008, an audio telephone conversation revealed Illinois Governor Rod Blagojevich trying to "sell" an appointment to the Senate seat that Barack Obama resigned after being elected President. In the phone conversation, Blagojevich said in reference to his power to appoint a new senator, "I've got this thing and it's fucking golden and I'm not just giving it up for fucking nothing." In the recorded conversations, Blagojevich also referred to Obama as a "motherfucker" and repeatedly said "fuck him." When questioning of the Obama administration's request that Valerie Jarrett be appointed as Obama's replacement, Blagojevich complained, "They're not willing to give me anything except appreciation. Fuck them." Blagojevich also said Tribune Company ownership should be told to "Tell those fuckers" in reference to Chicago Tribune editorial criticism of him.[28]
- In December 2009 in Dáil Éireann, Paul Gogarty responded to heckles from Eamon Ó Cuív with the outburst, "With all due respect, in the most unparliamentary language, fuck you, Deputy Ó Cuív. Fuck you."[29][30] Gogarty immediately withdrew the remarks and also made a personal statement of apology.[29] Proceedings of the outburst quickly spread by media and the Internet.[30] A subcommittee of the Dáil's standing committee on procedures and privileges produced a 26-page report on the incident.[29]
- On March 23, 2010, U.S. vice president Joe Biden whispered into President Barack Obama's ear, "This is a big fucking deal" while referring to the U.S. health care reform bill. His words were picked up by microphones and video.[31]
- On May 3, 2010, Canadian senator Nancy Ruth advised representatives of women's groups to "shut the fuck up" on access to abortion in the run-up to the 40th G8 summit.[32]

Use in marketing

In April 1997, clothing retailer French Connection began branding their clothes "fcuk" (usually written in lowercase). Though they received a slew of complaints for French Connection United Kingdom, its similarity to the word "fuck" caused controversy.[33] French Connection fully capitalized this and produced an extremely popular range of t-shirts with messages such as "fcuk this", "not as fcuk", "who's fcuk", "fcuk me", "fcuk her", "too busy to fcuk", "fcuk festival", "fcuk fascism", "fcuk fear", "fcuk on the lawn", "the joy of fcuk", etc.

In 2009, the European Union's OHIM trade marks agency disallowed a German brewery to market a beer called "Fucking Hell". They went and on 25 March 2019 got permission to market the beer. They claim that it is actually named after the Austrian village Fucking and the German word for light beer, Hell.[34]

Band names

The word "fuck" has been used in a number of band names, generally based on common compounds. Although most of these bands are in the mainstream, some have obscure names of years and more, others fall into the categories of more accessible forms of electronic rock and

the expression, over many centuries, of pure and moral. Others felt that the obligations of many acquaintances were of a superficial nature and [illegible]

Holy fuck

"Holy fuck" is a widely used example of "blasphemous profanity" used interjectionally to express anger, contempt, disgust, or amazement. Usually vulgar,[39] Neutral in acceptance,[39][40] and used in literature,[39][40][41] deriving its power from a combination of the sacred, holy, and the profane, fuck. An exclamation, similar to "holy shit", but more offensive, also used informally for sex within a religious context. [citation needed]

Machine mistranslation

The word took occurs sometimes in Chinese/English bilingual public notices in China as a machine translation of the Simplified Chinese character 干 (Gān) or Traditional Chinese character 乾 (Qián) which can also mean "dry" and "do," e.g., "spread to fuck the fruit" for "cross chest fruit," "fuck to adjust the area" for "dry seasonings section," and "fuck the certain piece of ground" for "dry fronts prior country". The fault occurred in some versions of commonly-used Chinese to English machine translators, for example Jinshan (金山 = "Gold Mountain") by Kingsoft.[42]

F-bomb

The term "F-bomb" surfaced in newspapers more than 20 years ago[when?] and in 2012 was cited, for the first time, in the mainstream Merriam-Webster's Collegiate Dictionary.[44]

Censorship

The films *Ulysses* and *I'll Never Forget What's'isname* (both 1967) are contenders for being the first film to use the word fuck, although the word "fuckbag" is clearly mouthed silently in the film *Sons We Remarked* (1940), and the title character says it in the cartoon *Boosters Picture Show* (1933). Since the U.S. adoption of the MPAA film rating system, use of the word has been accepted in R-rated movies, and under the strictest rules, use of the word in a sexual way would automatically cause the film to be given an R rating. Later changes eased advice for a maximum of three non-sexual and sparingly exclamatory uses of the word in a PG-13 movie.[45][clarification needed]

On August 19, 1968 the word rock band Jefferson Airplane played their song *We Can Be Together* uncensored on *The Dick Cavett Show*, including the 60's counterculture slogan "Up against the wall, motherfucker" (which was also the name of an anarchist group at that time). This was the first appearance of the word on U.S. television.[47]

In 1970, John Lennon successfully got the word past the censors on his song "Working Class Hero" with the lines "They hate you if you're clever and they despise a fool, till you're so fucking crazy you can't follow their rules" and "You think you're so clever and classless and free, but you're still fucking peasants as far as I can see."

Since the 1970s, the use of the word "fuck" in R-rated movies has become so commonplace in mainstream American movies that it is rarely noticed by most audiences. Nonetheless, a few movies have made exceptional use of the word, to the point where such films as *Fuck: Good Will Hunting*, *Casino*, *The Last Detail*, *Menace II Society*, *The Big Lebowski*, *The Departed*, *Scarface* (1983), *Pulp Fiction*, *Blue Velvet*, *South Park: Bigger, Longer & Uncut* and *Goodfellas* as well as the HBO TV series *The Sopranos* are known for its excessive use. In the movie *Meet the Parents*, and its sequels *Meet the Fockers* and *Little Fockers*, the main characters last name of "Focker" is a running joke. In the popular comedy *Four Weddings and a Funeral*, it is the chief word, repeatedly uttered, during the opening few minutes. In HBO's TV series *The Wire*, Season 1, Episode 4, entitled "Old Cases," there is a long segment in which two homicide detectives, working a crime scene, communicate using only variations of the word "fuck". To many, one of the most humorous tirades demonstrating various usages of the word appears in the comedy *Planes, Trains & Automobiles* (1987), where Steve Martin expresses his dissatisfaction in his treatment by a rental car agency. The movie *Stranger Than Fiction* inserted a scene in the middle of the film to explain to audiences that viewers with an R rating are more popular than those carrying a PG rating, which the movie could easily have had. He ends his address with "the producers of this motion picture have asked me to take this opportunity to say 'Fuck you'", at which time the MPAA R-rating banner appeared.

In cinema PG-rated movies, however, the word is used, mainly because at the time there was no PG-13 rating and the MPAA did not want

[illegible] to give the [illegible] R ratings, for instance, *All the President's Men* (1976) where it is used seven times, *The Rose And Knight* (1972), where it is used twice, and *The Right Stuff* (1983) where it is used five times. *Spaceballs* (1987) is one of at least four examples of that it was rated PG after the 1984 introduction of the PG-13 rating, yet it includes Dark Helmet's line, "Out of order?! Fuckin' Einer in the future nothing works!" The second is *Big* (1988) which has the character of Billy (actress Tom Hanks's character, "Who the fuck do you think you are?" The third is *Beetlejuice* (1988) which has the character Betelgeuse kick over a table three and scream, "more fucking movies!"[45] The fourth is 1998's *Cradle Will Rock* where Randy Quaid's character shouts out he is going to smash down a door with a "fucking baseball bat."

In the 1993 film "Sidney Sheldon," Sidney Malone's character Danie DeMarco is edited from the line "Well, fuck that" to "Well, screw that!" The change was made to avoid a PG-13 rating, and the original line is obvious when reading her lips.

Films edited for broadcast use euphemisms so that lip synching will not be thrown off. One televised version of *Quentin Tarantino's Jackie Brown*, for instance, had the actors dub in the words "fricken," and another former for "fuck," "nigger," and "motherfucker," respectively. In similarly dubbed versions of *Die Hard* and *Die Hard 2*, Bruce Willis' catchphrase "Yippee-ki-yay, motherfucker" is replaced by "Yippee-ki-yay, Mister Falcon" or "Yippee-ki-yay, Hermo Sailor." Similarly, the TV broadcast edit of *Shadow on a Plane* has Samuel L. Jackson saying "I have had it with these monkey-fucking snakes on this Monday-to-Friday plane," preventing two occurrences of motherfuckers.[47] In the film *The Big Lebowski*, John Goodman's character repeatedly yells, "This is what happens when you fuck a stranger in the ass!" while brandishing a car. It was ridiculously censored on television as "This is what happens when you find a stranger in the Alps."[48] The character also repeatedly says to Steve Buscemi's character "Shut the fuck up, Donny!" or "Donny, shut the fuck up!" in the television version, fuck is censored with *hell*.

Many stand-up comedians who perform for adult audiences do make liberal use of the word fuck. While George Carlin's use of the word was an important part of his stage persona, other comedians (such as Andrew Dice Clay) have been accused of substituting vulgarity and obscenity for genuine creativity through overuse of the word. Billy Connolly and Lenny Bruce were pioneers of the use of the word in their shows to general audiences.

Recently, the hip-hop group Black Eyed Peas' hit song "Don't Phunk With My Heart" was only played as many radio stations in an edited version. "Don't Mess With My Heart." Jessica Biel's first major song, *You're Beautiful*, featured the line "she could see from my face that I was fucking high" – this was censored to "flying high" for broadcasting purposes.

Freedom of expression

In 1971 the U.S. Supreme Court decided that the mere public display of fuck is protected under the First and Fourteenth Amendments and cannot be made a criminal offense. In 1968, Paul Robert Cohen had been convicted of "disturbing the peace" for wearing a jacket with "FUCK THE DRAFT" on it, in reference to conscription in the Vietnam War. The conviction was upheld by the Court of Appeals and overturned by the Supreme Court. *Cohen v. California*, 403 U.S. 15 (1971).

In 1983, pornographer Larry Flynt, representing himself before the U.S. Supreme Court in a libel case, shouted, "Fuck this court!" during the proceedings, and then called the panel of nine justices (referring to Justices Warren E. Burger, William J. Brennan, Jr., Byron White, Thurgood Marshall, Harry Blackmun, Lewis F. Powell, Jr., William Rehnquist, and John Paul Stevens) and a token cunt (referring to Justice Sandra Day O'Connor). Chief Justice Warren E. Burger had him arrested for contempt of court, but the charge was later dismissed on a technicality.[49]

Common alternatives

Main article: Minced oath

A conversation or writing, reference to or use of the word fuck may be replaced by any of many alternative words or phrases, including "the f-word" or "the F-bomb" (a play on "A-bomb" and "H-bomb"), or simply, *eff* (as in "What the *eff*" or "You effing fool!"). Also, there are many commonly used substitutes, such as flipping, frigging, fricking, freaking, feck, fudge or any of a number of similar sounding consonant words. In print, there are alternatives such as, "f***", "f---k", etc., or a string of non-alphanumeric characters, for example, "@&%#!$" and similar (especially banned in comic books).[citation needed]

A common replacement word used mainly on the Internet is "fuck", coined from the name of the Unix file system checking utility [50], a

Ruffhouse Corrections the Smallest and Farm Tracks' Appeal Tribunal in the mid-nineties 2000 were also used as a substitute for fuck. The word is sometimes jokingly used as a curse by fans, but its use in mainstream media is censored.[51] Similarly, the word "frell" is used as a substitute on the TV show Farscape, and Dr. Elliot Reid (played by Sarah Chalke) has frequently used the substitute "feck" on the TV show Scrubs.

The phrase fetch is a common substitute for fuck in Ireland, where it is considered to be less rude. Though still not acceptable in many contexts, it has come into occasional use across the UK in the last 15 years as a result of its frequent use in the Father Ted comedy series. Although the word is considered to be equally as rude as "fuck", its appearance in Father Ted and in a Magician's Order advert suggest the opposite.

The word firetruck is also used as an alternative, starting with "F" and ending with "uck".

Using the phonetic alphabet, "foxtrot uniform charlie kilo" is sometimes used.[citation needed]

See also

- Bleep censor
- Censorship
- Euphemism
- List of films that most frequently use the word "fuck"
- Fuck, a brand of clothing
- Finger (gesture), a related hand gesture
- Four-letter word
- *The Unbeatable Carnal Knowledge*, 1991 album by American rock band Van Halen
- Fucking, Austria (name of a village)
- Raincoat impression
- Jane the Fucker
- Museums on Fuck: Show with Guest Lieutenant
- Profanity
  - Profanity by language
  - Profanity in American Sign Language
  - Profanity in English language
  - Profanity in science fiction
- Seven dirty words
- Sound diving

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External links

- Re: the Clarey-Lester incident: Usenet Legend discusses how American newspapers decide whether or not to print fuck
- "Etymonline Etymology Dictionary" A Some etymological research on the word fuck
- Fuck – academic paper exploring the legal implications of the word, by Christopher M. Fairman, Ohio State University – Michael E. Moritz College of Law March 2006. Ohio State Public Law Working Paper No. 59.
- Archive.org – Jack Krueger, "The Word Fuck"

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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK APPLICATION—PRINCIPAL REGISTER

Serial No.: 85/310960

IN RE APPLICATION OF ERIK BRUNETTI

Application Date: May 3, 2011

DECLARATION OF CHRIS GIBBS

I, Chris Gibbs, declare and say:

1. I am the owner of the UNION store in Los Angeles, at 110 South LaBrea Ave., Los Angeles, CA 90036. I know the following facts to be true of my own personal knowledge. If called as a witness I could and would testify competently thereto.

2. My background is that I have been the owner and manager of the UNION store for 15 years. I have been actively involved in the street fashion or youth fashion industry for 15 years. I attend many of the trade shows, read most of the magazines and blogs that deal with youth culture in the United States, and spend much time talking to customers and others in the clothing industry (including store employees of my store and others, store managers, brand managers and owners of dozens of brands) about trends and brands. I feel that I can give useful opinions based upon my knowledge and experience.

3. To provide perspective on my store and the area where it is located I want to provide some background.

This portion of LaBrea is an important shopping district for youth fashion as, in addition to UNION, it includes the STUSSY, UNDEFEATED, AMERICAN RAG and the LA BREA BAKERY. The Los Angeles Times says "For more than two decades, a roughly 1.5-mile stretch of La Brea between Melrose Avenue and Wilshire Boulevard arguably has been the city's most diverse and densely packed district for Old World antiques, vintage furniture, contemporary décor and urban fashion." November 21, 2012. The August 30, 2011 issue of Cooling Hunting says: "From Japanese selvage denim to modern bohemian tunics, La Brea is quickly becoming one of the most creative shopping destinations in Los Angeles." Frommers.com says "La Brea Avenue (north of Wilshire Blvd.)—This is L.A.'s artiest shopping strip."

4. The UNION store is widely recognized as a leading retail outlet in the youth or street fashion industry. It has been in existence for 25 years. We carry dozens of brands, one of which is FUCT.

5. I do not view FUCT as immoral, obscene, scandalous, vulgar or otherwise offensive.

6. In the approximately three years that the UNION store has carried FUCT not once has a customer complained about the FUCT brand. Significantly, even though many mothers come in with their teenage children, not once has a mother complained to me about the FUCT brand. So I do not think customers would view the FUCT brand as obscene, scandalous, immoral, vulgar or offensive.

7. In addition to the physical UNION store at 110 South LaBrea Ave., Los Angeles, it has an internet

store that serves customers throughout the United States. We have carried FUCT on the webstore for approximately 3 years. We have not received any complaint from any state or territory in the United States, or elsewhere, about FUCT being obscene, scandalous, immoral, vulgar or offensive.

8. Not once has anyone told me that he or she understood FUCT to be anything other than a brand of clothing.

9. Not once has anyone told me that he or she understood FUCT on clothing to refer to "fuck."

10. If the public understood FUCT on clothing to refer to "fuck," I believe I would have heard it.

11. In my opinion, the vast majority of persons who shop for or who see it worn, the primary significance of FUCT is the name of a brand.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct and this declaration is executed this 27th day of July 2013.

/s/ CHRIS GIBBS
CHRIS GIBBS

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK APPLICATION—PRINCIPAL REGISTER

Serial No.: 85/310960

IN RE APPLICATION OF ERIK BRUNETTI

Application Date: May 3, 2011

SUPPLEMENTAL DECLARATION OF ERIK BRUNETTI

I, Erik Brunetti, declare and say:

1. I am the founder of the FUCT brand. I know the following facts to be true of my own personal knowledge. If called as a witness I could and would testify competently thereto.

2. Since 1990, I have been actively involved in the street fashion or youth fashion industry. I have attended many trade shows, read many magazines and blogs that deal with youth culture in the United States, and spend much time talking to artists, designers, customers and others in the clothing industry. Based upon my experience I can opine about what is immoral, scandalous and vulgar. What is considered such has changed much over the last 23 years. Furthermore, I am a professional artist.

3. The FUCT brand does make comments about current political and societal issues, sometimes obvious, and sometimes subtly. But those comments are not scandalous, immoral or vulgar.

4. The use of FUCT by the brand clearly as a brand identifier, not as referring to "fuck." The exhibits below illustrate that.

5. Attached as Exhibit "7" are photographs of products sold under the FUCT brand.

6. Attached as Exhibit "8" are photographs of the printing on the neck (in lieu of a neck label) and labels.

7. The FUCT trademark is registered in other countries so that is why the ® symbol is used on products.

8. It is a significant problem for my business not to have a trademark registration in the home country for the FUCT brand. Among other problems, I cannot obtain an International Registration under the Madrid agreements.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct and this declaration is executed this 27th day of July 2013.

/s/ ERIK BRUNETTI
ERIK BRUNETTI

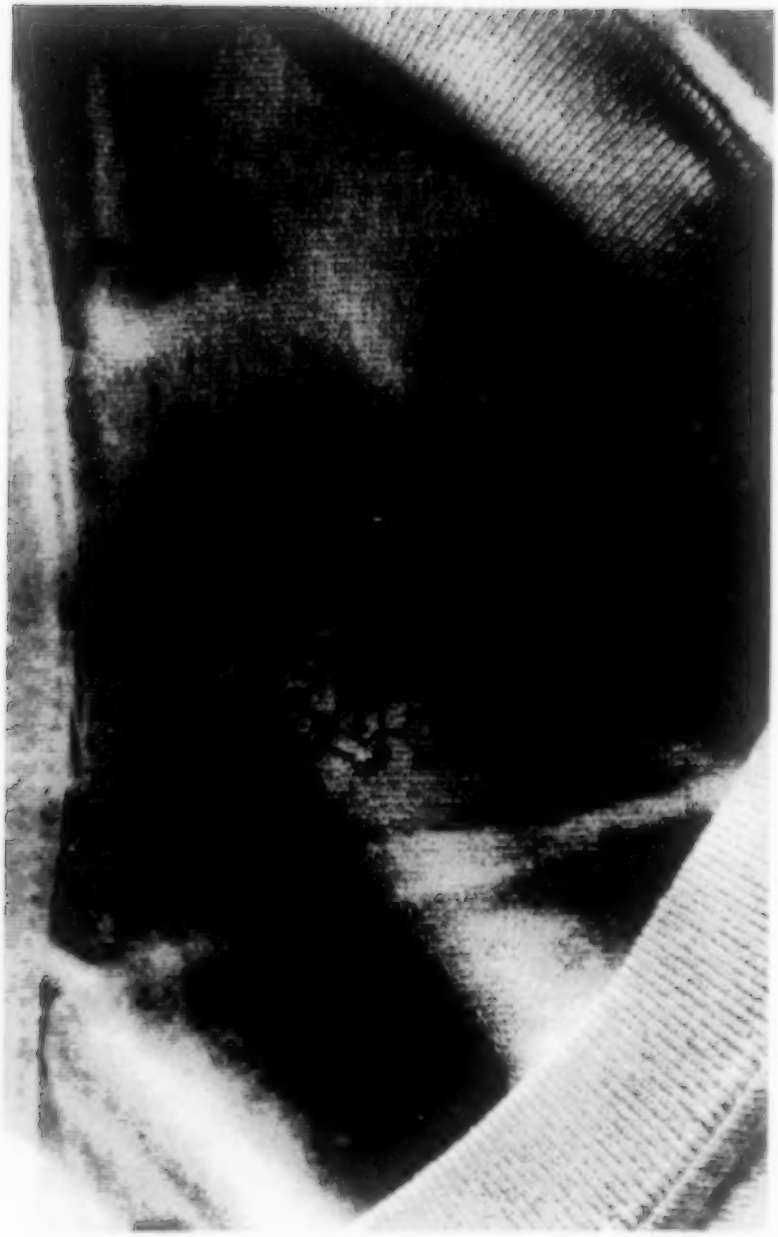
Applicant: Brunetti, Erik
Mark: FUCT
S/N: 85/310960

Exhibit 7

JUAREZ
FUCT
FUCT
fuct

Applicant: Brunetti, Erik
Mark: FUCT
S/N: 85/310960

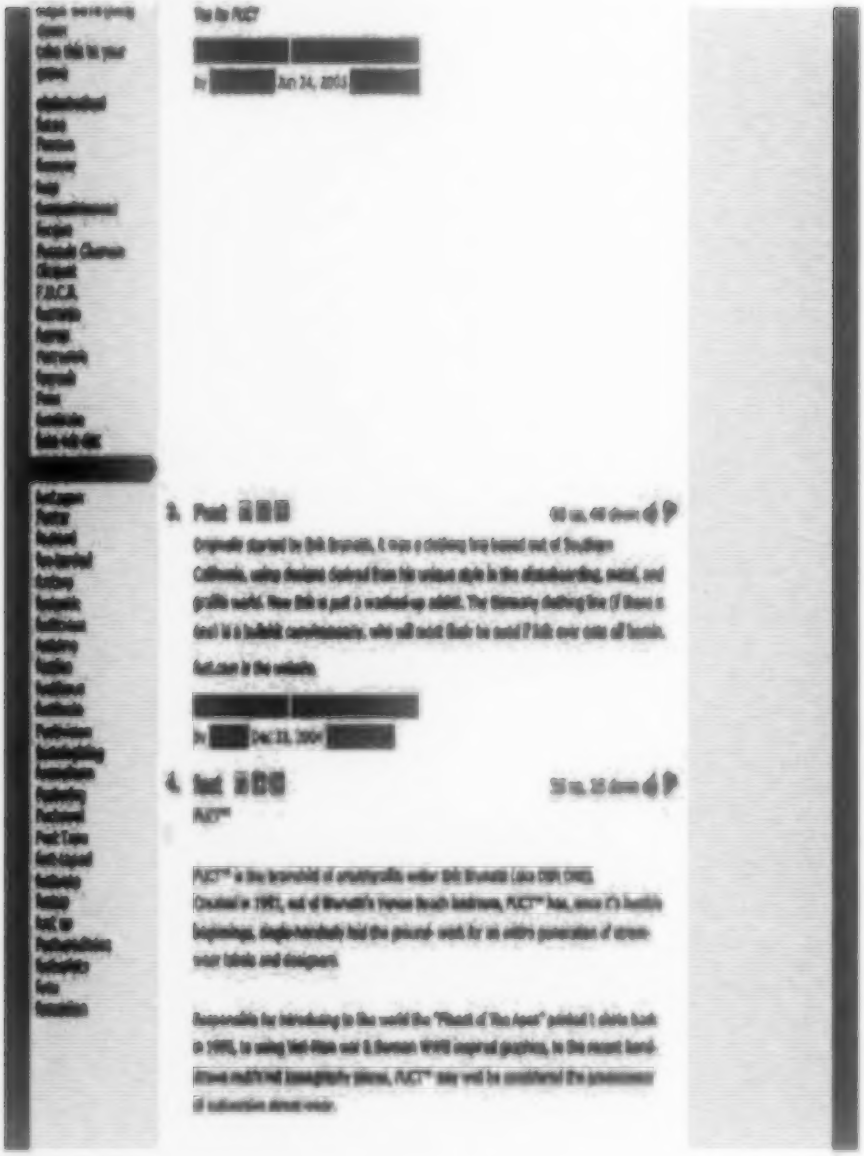
Exhibit 8

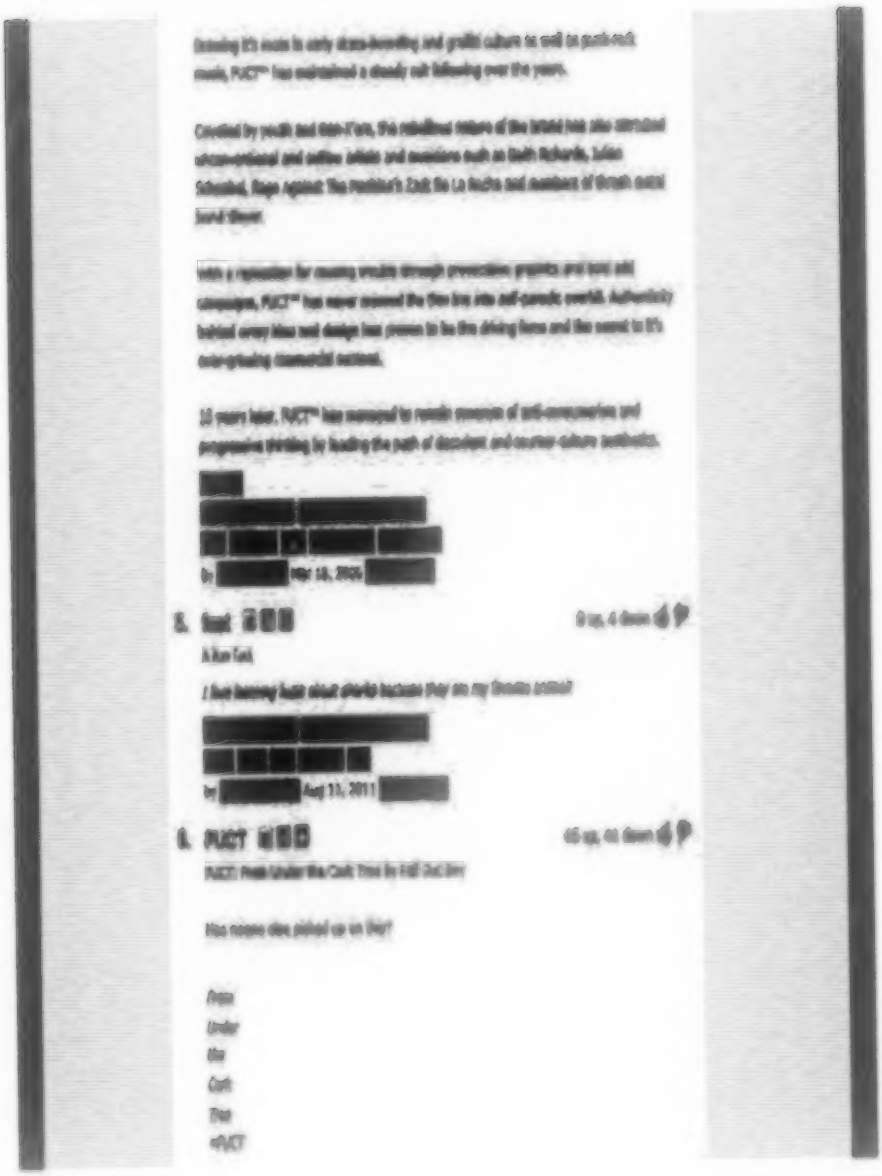


FUCT®
EST. 1991 // LOS ANGELES, CA
100% COTTON
MADE IN BANGLADESH

[redacted]

urban
fuct
search
1. fuct
73 up. 36 down
The past tense of the verb fuck. Also used to express a general state of incapability.
We are so fuct!
She fuct me like a dog in heat!
That's fuct up!
(Rural definition) Hey mum, I just fuct yer sent kind.
Random Word
2. fuct
56 up. 27 down
Technical word mean broken or beyond repair.
F.U.C.T
Failed
Under
Continuous
Twatting
Is they metric or broken?
advertise here
Yes its FUCT





[redacted]

by [redacted] Sep 24, 2006 [redacted]

7. fuct [redacted] 3 up, 1 down

fuct friends u can't trust

fuct for life bro

without a doubt brother

[redacted]

by [redacted] Mar 22, 2011 [redacted]

Chart

Offensiveness Refusals Under Section 2(a)

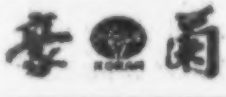
Examples of refusals clearly based upon viewpoint
Examples of the government selecting a "happy" or clean viewpoint
Examples of contradictory refusals

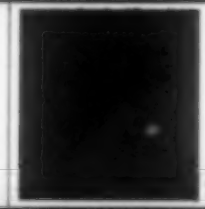
F'D UP (Stylized) (a search of the PTO database for "FUCKED" brings up this mark) (Reg. No. 4495813)	FUCT (appellant herein)
FCUK – approved 8 times FCUK AT HOME (Reg. No. 2910053)	FUCK
FWORD (SN 75/590854) F*WORD FRIDAY (Reg. No. 4025107) The F Word (Reg. No. 4642013)	F-WORD! (SN 78/455991)
FUBAR – registered 17 times	POTUS B. FUBAR (SN 86/901846)
MILF – approved at least 23 times MILF WEED (Reg. No. 4495963)	MILF – refused at least 20 times
N-WORD (No. 86281488) NIG (Reg. No. 2747415)	NIGGA (SN 76/423949)
PHUC (Reg. No. 4354653)	PHATPHUC (SN 85/023572)
S#*! THE BED (Reg. No. 5192367) S#*! MY DAD SAYS (Reg. No. 4142745)	Apo S#!+ (SN 85/611740) I DIDN'T VOTE FOR BU?! SH*#! (SN 78/166547) NO S#!+ (*In re Jonas*, 2013 TTAB LEXIS 615 (T.T.A.B. 2013) (not precedential)) NO-SHIT (SN 77/913273) S#!TS & GIGGLES ELK POOP ACCESSORIES (SN 85/542023)
WTF WORK? (Reg. No. 4332574)	

*includes registered and marks approved for publication.

 BAD FROG BEER, giving finger. *(In re Bad Frog Brewery, Inc.*, 1999 TTAB LEXIS 86 (T.T.A.B. 1999) (not precedential)). Violation of free speech for a state to refuse permission to use picture of frog giving the finger. *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998).	(SN 79/055664) *(In re Lazaria, s.r.o.*, 100 U.S.P.Q.2d 1146 (T.T.A.B. 2011))
ANAL – registered 17 times **ANAL FANTASY COLLECTION** (Reg. No. 4507635)	
ASS – registered over 200 times	**ASSHOLE; A-HOLE PATROL**
BADASS – registered over 65 times	
BEANER'S (Reg. No. 2308859)	**FLIPS AND BEANERS** (SN 85/701322)
CAMEL TOES (Reg. No. 1872570)	**CAMEL TOE SURF WAX** (SN 85/354253)
COCK; COCK 'N BULL; BUZZCOCK; COLD COCK	**COCK SUCKER; KING COCK** (SN 86/500922)
CUM TOGETHER (Reg. No. 2844606)	**CUM TOGETHER** (SN 86/587023)
CUMMERELLA (Reg. No. 4628952)	**YOU CUM LIKE A GIRL** (SN 78682282) *(In re Carlson*, 2007 TTAB LEXIS 651 (T.T.A.B. 2007) (not precedential))
EDIBLE CROTCHLESS GUMMY PANTIES (Reg. No. 2859081)	
FOREPLAY (in many forms) (Reg. No. 1185963); **69 FOREPLAY** (SN 85/092781)	**MASTURBATION-A-THON** (SN 76/553565)
I AM STRUNG OUT LIKE A CRACK WHORE IN SPANDEX (SN 85/334481)	
INTERCOURSE ROUTE 69 (SN 78/723240)	(SN 78/697135)
JACK OFF JILL (Reg. No. 2363770)	**1-800 JACK OFF** – *(In re Boulevard Entertainment, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003))
LAUGHING MY VAGINA OFF (4401056)	**TWATT** (SN 77/792532) **TASTY TWATS** (SN 77/384915)

MAKE YOUR OWN DILDO (Reg. Nos. 2801630 and 4055162)	
PARTY WITH SLUTS (Reg. No. 4388020)	
PINK TACO – registered 5 times	BUBBY TRAP (*In re Ronsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971))
PUSSIES (Reg No. 4254281)	PUSSYWEAR (SN 75/743995)
SEXBOBERSUCKS (SN 86/778519)	
SHANK THE BIT@H (Reg No. 4672035)	
SLUT – registered at least 68 times	
	T-WATT (SN 77/792532) TASTY TWATS (SN 77/384915)
VAGINA in many forms WONDROUS VULVA PUPPET (Reg. No. 5043896)	
WHORE – registered 40+ times WHORES FROM HELL (Reg. 4301873)	
WORD PROSTITUTE (Reg. No. 3186641)	THE CHRISTIAN PROSTITUTE (SN 85/951092)
[redacted]	
Marks showing input allowed: 	Marks showing output are refused: DOGSH!T (Also, see various "SHIT" marks)
CRAP – registered over 70 times FECES – registered multiple times POOP – (registered many times) but !HIT is refused	A-HOLE PATROL: THE COMPLETE A**HOLE'S GUIDE TO.... BULLSHIT; BUILDING WITHOUT THE BULLSHIT (SN 86/861578)
[redacted]	
ARYAN NATIONS SADISTIC SOULS MC (SN 87/161084)	
CRACKER, HONKY, WASP, WHITEY	NIGGA (SN 76/639548)
KKK – registered at least 5 times KU KLUX KLAM (Reg. No. 1158120)	
GRAMMAR NAZI (SN 87/350257) NAZI VICTIMS COMPENSATION	COFFEE NAZI (SN 86/103763) NAZI HUNTER (SN 76/100880)

TRUSTS (Reg. No. 2568614)	SURF NAZI (SN 77/758228)
[redacted]	
ALLAH MADE ME FUNNY – THE OFFICIAL MUSLIM COMEDY TOUR; CLUBALLAH – for Classes 14, 16, 25, 41	
ATHEISTS FOR ALLAH (SN 78/939811)	
BIKERS AGAINST RADICAL ISLAM (SN 87/185552) No action by PTO, even though application is over 10 months old.	
F*J*SERRA (Reg. No. 3687353)	
JEWS FOR JESUS – registered 5 times	
 – for "[illegible]"	KHOEAN – for "wine" (SN 77/072261)
MADONNA (Reg. 4645362 and 3306106)	MADONNA; MESSIAS; SENUSSI
SOCIAL NETWORKING FOR YOUR PENIS (Reg. No. 3512313)	GOD DOES NOT HAVE A PENIS (GDNHAP) (SN 77/212829)
[redacted]	
DAGO SWAGG (Reg. No. 4347624)	DAGO MARY'S (SN 78/954137)
SQUAW – at least 24 registrations SQUAW VALLEY (Reg. No. 0670261)	SQUAW (*In re Squaw Valley Dev. Co.*, 2006 WL 1546500 (TTAB 2006)) GLAMOUR SQUAW (SN 85/846518)
	STOP THE ISLAMISATION OF AMERICA – 2(a) disparaging refusal issued in 2010 (*In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014))
WILD INJUN (Reg. No. 1673489)	URBAN INJUN (SN 77/186637)
[redacted]	
BITCH – allowed over 150 times THE STAR BITCHES OF SPACE STATION *69* (SN 87/061852)	KICKABITCH (SN 77/735673)
DYKES ON BIKES (Reg. No. 332803) DYKE NIGHT (Reg. No. 4146588)	2 DYKES MINIMUM (SN 77/219520)
F•A•G FABULOUS AND GAY (2997761)	MARRIAGE IS FOR FAGS (77/477549)
(Reg. No. 4497191)	I'M COMFORTABLE WITH MY HOMOPHOBIA (SN 85/382063)
SLAVE, SEXY SLAVE (Reg No. 4727713)	
WIFE BEATER (Reg. 0836434)	

	WIFE BEATER (78/416303) **WIFE BEATER CLOTHING AND APPAREL** (SN 77/747597)
[redacted]	
(Reg. 4327579 and 4387402)	 (SN 86/577413)
[redacted]	
	CORPORATE MASTURBATION (SN 77/747036)
MUSLIM P.A.T.R.I.O.T. PROTECTING AMERICA THROUGH REAFFIRMING ISLAM'S OPPOSITION TO TERRORISM (SN 85/909943)	**STOP THE ISLAMISATION OF AMERICA** – 2(a) disparaging refusal issued in 2010, but seems also could have been considered scandalous (*In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014)) (SN 77/940881)

No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE PETITIONER

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter." The question presented is as follows:

Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

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BRIEF FOR THE PETITIONER

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-54a) is reported at 877 F.3d 1330. The opinion of the Trademark Trial and Appeal Board (Pet. App. 55a-67a) is available at 2014 WL 3976439.

JURISDICTION

The judgment of the court of appeals was entered on December 15, 2017. A petition for rehearing was denied on April 12, 2018 (Pet. App. 68a-69a). On July 5, 2018, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including August 10, 2018. On July 31, 2018, the Chief Justice further extended the time to and including September 7, 2018, and the petition was filed on that date. The petition for a

writ of certiorari was granted on January 4, 2019. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The First Amendment provides in pertinent part that "Congress shall make no law * * * abridging the freedom of speech." U.S. Const. Amend. I. Relevant statutory provisions are reprinted in an appendix to this brief. App., *infra*, 1a-38a.

STATEMENT

This case involves a facial First Amendment challenge to a century-old provision of federal trademark law that directs the United States Patent and Trademark Office (USPTO) to refuse registration of trademarks containing "scandalous" or "immoral" matter. 15 U.S.C. 1052(a). Respondent sought federal registration for the mark "FUCT" in connection with a clothing line including children's and infants' apparel. The USPTO refused registration under Section 1052(a) based on evidence that the mark would be perceived as equivalent to the vulgar word for which it is a homonym. Pet. App. 55a-67a. The court of appeals agreed that the mark is "scandalous" within the meaning of Section 1052(a), but the court struck down the provision denying federal registration of scandalous or immoral marks as facially invalid under the Free Speech Clause of the First Amendment. *Id.* at 1a-54a.

1. "The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); see *Wal-Mart Stores, Inc.* v. *Samara Bros.*, 529 U.S. 205, 212 (2000) (explaining that the "predominant function"

of a trademark is "source identification"). By preventing others from copying such marks, trademark law "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). Trademark law likewise "'reduces the customer's costs of shopping and making purchasing decisions,'" by "assur[ing] a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past." *Id.* at 163-164 (brackets and citation omitted); see *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U.S. 203, 205 (1942) (describing a trademark as a "merchandising short-cut").

"Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country." *Matal* v. *Tam*, 137 S. Ct. 1744, 1751 (2017); see *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). At common law, "[o]ne who first uses a distinct mark in commerce * * * acquires rights to that mark." *B & B Hardware*, 135 S. Ct. at 1299; see 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 3.02[2][a] (2014) (*Gilson*). Those rights allow the owner of the mark "to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his." *Prestonettes, Inc.* v. *Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.). The owner can enforce those rights "under state common law, or if [the mark] has been registered in a State, under that State's registration system." *Tam*, 137 S. Ct. at 1753.

"Though federal law does not create trademarks, Congress has long played a role in protecting them." *B & B Hardware*, 135 S. Ct. at 1299 (citation omitted);

see, *e.g.*, Act of Feb. 20, 1905 (1905 Act), ch. 592, 33 Stat. 724; Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 210-212. In 1946, Congress enacted the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), "the current federal trademark scheme," *B & B Hardware*, 135 S. Ct. at 1299. Under the Lanham Act, the owner of a mark used in interstate or foreign commerce, whether registered or not, may sue for trademark infringement "in federal court if another is using a mark that too closely resembles the plaintiff's." *Id.* at 1301; see 15 U.S.C. 1114(1)(a) (federally registered marks); 15 U.S.C. 1125(a) (federally unregistered marks); see also *Tam*, 137 S. Ct. at 1752 (explaining that, "even if a trademark is not federally registered, it may still be enforceable under [Section 1125(a)]"). Certain federal remedies for dilution and unfair competition are likewise available to owners of marks used in commerce, regardless of whether the mark is registered. See 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(c) (remedy for dilution of famous marks); 15 U.S.C. 1125(d) (remedy for cybersquatting).

The Lanham Act confers additional benefits on owners who federally register their marks. See *Tam*, 137 S. Ct. at 1753; 3 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 19:9 (5th ed. 2018). For example, registration serves as nationwide "constructive notice of the registrant's claim of ownership" of the mark, 15 U.S.C. 1072, which forecloses certain defenses in infringement actions, see 1 *Gilson* § 4.02. It also is "prima facie evidence of the validity of the registered mark * * * and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration." 15 U.S.C. 1115(a); see 15 U.S.C. 1057(b). In addition, after five years of registration, the owner's right to use

a trademark can become "incontestable," so that it may be challenged only on limited grounds. 15 U.S.C. 1065, 1115(b); see, *e.g.*, *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 205 (1985) (holding that, after the owner's right to use the mark becomes incontestable, the mark cannot be challenged on the ground that it is "merely descriptive").

To obtain the benefits of registration, an "owner of a trademark used in commerce" applies to the USPTO to record the mark on the agency's "principal register." 15 U.S.C. 1051(a)(1); see 35 U.S.C. 2(a)(1). The application must include a description of "the goods in connection with which the mark is used." 15 U.S.C. 1051(a)(2). If the USPTO grants the application, it issues the owner of the trademark a certificate of registration "in the name of the United States of America," 15 U.S.C. 1057(a), and the owner "may give notice that his mark is registered by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®," 15 U.S.C. 1111.

Only marks that satisfy the statutory criteria can be registered. Congress has directed the USPTO to "refuse[] registration" of, among others, marks that are deceptive, 15 U.S.C. 1052(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks that include a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e)(1); and marks that are functional, 15 U.S.C. 1052(e)(5).

This case concerns a Lanham Act provision that directs the USPTO to refuse registration of marks consisting of or comprising "immoral" or "scandalous" matter. 15 U.S.C. 1052(a). Such a provision has been a feature of federal trademark-registration programs since 1905. See 1905 Act § 5, 33 Stat. 725. Although the Lanham Act precludes registration of "scandalous" and "immoral" marks, the USPTO has long treated the two terms as composing a single category, and we accordingly refer to the prohibitions collectively as the "scandalous-marks" provision. See *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981) ("not[ing] the dearth of reported trademark decisions in which the term 'immoral' has been directly applied").

To determine whether the scandalous-marks provision applies to a particular mark, the USPTO asks whether a "'substantial composite of the general public' would find the mark scandalous." Pet. App. 3a (citation omitted). The agency generally defines "scandalous" as "'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation.'" *Ibid.* (citation omitted). The agency understands, and the Federal Circuit has held, that the term includes "[v]ulgar" marks, *i.e.*, those "'lacking in taste, indelicate, [and] morally crude.'" *Ibid.* (citation omitted; second set of brackets in original). Over the years, the USPTO has invoked this provision as a basis for refusing to register a variety of vulgar and lewd marks. See Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017) (providing a sample of particularly vulgar marks, including depictions of individuals engaged in sexual activity, for which the USPTO has refused registration).

2. This case arises from the USPTO's refusal of respondent Erik Brunetti's application to register the mark "FUCT" for a clothing line that includes children's and infants' apparel. Pet. App. 55a. Respondent has used the mark in connection with his clothing line since 1991. C.A. App. A52. In 2011, the USPTO received an application for federal registration of the mark. Pet. App. 4a. A USPTO examining attorney refused registration under Section 1052(a) based on evidence that the mark consisted of "scandalous" matter. See J.A. 19, 26.

The USPTO's Trademark Trial and Appeal Board (Board) affirmed. Pet. App. 55a-67a. The Board observed that "the term 'fuct' is recognized as a slang and literal equivalent" of the word for which it is a homonym, *id.* at 61a, and that respondent used the mark in connection with apparel and promotional material displaying "strong, and often explicit, sexual imagery," *id.* at 63a. Based on that evidence, the Board found that the mark as used by respondent would "be perceived by his targeted market segment" as the profane word for which it is a homonym. *Id.* at 64a. The Board concluded on that basis that the mark was vulgar and therefore unregistrable under 15 U.S.C. 1052(a). Pet. App. 67a. Although respondent argued that the scandalous-marks provision violated the First Amendment, the Board found the resolution of that constitutional question to be beyond its statutory authority. *Ibid.*

3. a. Respondent sought review of the Board's decision in the Federal Circuit. While the case was pending in the court of appeals, this Court issued its decision in *Matal* v. *Tam*, *supra*, concerning the constitutionality of Section 1052(a)'s separate ban on federal registration of "disparag[ing]" trademarks, 15 U.S.C. 1052(a). All

eight Justices who participated in *Tam* agreed that the disparagement provision discriminated based on the speaker's viewpoint, and that the provision was facially invalid under the First Amendment. See 137 S. Ct. at 1763, 1765 (Alito, J.); *id.* at 1766-1769 (Kennedy, J.).

b. After supplemental briefing and reargument in light of *Tam*, the court of appeals reversed the Board's decision in this case. Pet. App. 1a-46a. The court first upheld the Board's determination that respondent's mark is "scandalous" under Section 1052(a). *Id.* at 6a-10a. The court held that substantial evidence supported the Board's findings that respondent's mark is a "'phonetic twin'" of a vulgar term, and that a "'substantial composite' of the American public would find the mark vulgar." *Id.* at 6a-7a, 9a (citation omitted). The court further held that, given those findings, federal registration of the mark was barred by Section 1052(a)'s scandalous-marks provision. *Id.* at 9a-10a.

The court of appeals concluded, however, that Section 1052(a)'s scandalous-marks provision is facially invalid under the First Amendment. Pet. App. 11a-46a. While assuming *arguendo* that the provision is viewpoint-neutral, the court held that "the provision impermissibly discriminates based on content in violation of the First Amendment." *Id.* at 14a. In reaching that conclusion, the court began from the premise that content discrimination of any kind is subject to strict scrutiny unless some alternative First Amendment framework applies. *Id.* at 15a. The court then rejected each of the government's arguments that the statutory criteria for obtaining the benefits of federal trademark registration should not receive the same First Amendment scrutiny that applies to a content-based restriction on speech.

The court of appeals rejected the government's argument that the trademark-registration program should be analyzed as a government subsidy for marks that the government wishes to promote, rather than as a restriction on speech. Pet. App. 16a-22a. The court distinguished prior decisions recognizing Congress's broad authority to define the scope of government programs, *e.g.*, *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983), on the ground that "[t]rademark registration does not implicate Congress' power to spend funds." Pet. App. 19a. The court concluded that the constitutional principles applicable to government subsidies apply only to Spending Clause legislation, and that the trademark-registration program is not a Spending Clause program. *Id.* at 21a-22a. The court also distinguished precedents related to limited public (or nonpublic) forums, *id.* at 22a-28a, concluding that limited-public-forum principles apply only when the government excludes speech from its own property, *id.* at 25a.

Having rejected the subsidy and limited-public-forum frameworks, the court of appeals analyzed the scandalous-marks provision as a direct restriction on speech. The court concluded that the ban on registering scandalous marks regulates speech based on its expressive (and not just commercial) content; that it is not related to the trademark-registration program's commercial purpose of facilitating source identification; and that it is therefore subject to strict scrutiny. Pet. App. 29a-31a. Noting that the government had not suggested that the provision could survive strict scrutiny, the court concluded that the scandalous-marks provision is facially invalid. *Id.* at 31a.

In the alternative, the court of appeals held that the scandalous-marks provision could not survive scrutiny under the First Amendment standards that apply to regulation of commercial speech. Pet. App. 31a-42a; see *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 566 (1980) (explaining that First Amendment analysis of restrictions on commercial speech turns on whether (1) the speech being regulated concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) the regulation is "more extensive than is necessary to serve that interest"). The court concluded that the government has no legitimate substantial interest in declining to encourage graphic sexual images as source identifiers in commerce, because registration does not associate the government with those marks and because speech cannot be suppressed merely because it will be off-putting to others. Pet. App. 32a-38a. The court further held that, even if the government interest in "protecting the public" from such marks were viewed as legitimate, refusing to register those marks would not "directly advance" the government's interest because it would not "directly prevent applicants from using their marks." *Id.* at 38a. The court further found that the refusal to register scandalous marks under Section 1052(a) is not sufficiently tailored to the government's interest because, in the court's view, there is no clear standard for determining which marks are "scandalous" and the USPTO has applied the provision inconsistently in the past. *Id.* at 39a-41a.

c. Judge Dyk concurred in the judgment. Pet. App. 47a-54a. He "agree[d] with the majority" that this

Court's decision in *Tam* "does not dictate the facial invalidity of the immoral-scandalous provision." *Id.* at 47a. Rather than resolve the "serious First Amendment questions" left open in *Tam*, however, Judge Dyk would have avoided those issues by construing the scandalous-marks provision to reach only obscene material that is unprotected by the First Amendment. *Id.* at 48a. Judge Dyk concluded that respondent would prevail under that construction "[b]ecause there is no suggestion that [respondent's] mark is obscene." *Id.* at 54a.

4. The court of appeals denied the government's petition for rehearing en banc without noted dissent. Pet. App. 68a-69a.

SUMMARY OF ARGUMENT

The scandalous-marks provision in 15 U.S.C. 1052(a) is facially constitutional under the Free Speech Clause of the First Amendment.

A. This case presents an issue that the Court's decision in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), did not address. In *Tam*, the Court struck down, as a violation of the Free Speech Clause, a provision of Section 1052(a) that directed the USPTO to refuse to register "disparag[ing]" marks. 15 U.S.C. 1052(a). Although most of the Court's First Amendment analysis was split between two opinions, neither of which secured a majority, all eight Justices who participated in *Tam* agreed that the disparagement provision discriminated on the basis of viewpoint. That unanimous agreement made it unnecessary to address in detail the First Amendment analysis that should apply to federal-registration criteria that are viewpoint-neutral. Because the scandalous-marks provision at issue here is viewpoint-neutral, the decision in *Tam* sheds little light on the question presented in this case.

B. In declaring the scandalous-marks provision facially unconstitutional, the court of appeals subjected the provision to strict scrutiny. Strict scrutiny, however, is unwarranted here for three related reasons.

First, the scandalous-marks provision is not a restriction on speech. Rather, it is a condition on the availability of government benefits—namely, the benefits of federal trademark registration. This Court has recognized that the justification for strict scrutiny is generally absent when, as here, the government "does not restrict" speech, "but rather declines to promote" it. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009). *Second*, although the scandalous-marks provision turns on the content of the mark for which registration is sought, such content-based distinctions are an "inherent and inescapable" part of the federal trademark-registration program. *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 49 (1983). Application of strict scrutiny to such criteria would fundamentally disrupt the operation of that program. *Third*, the scandalous-marks provision is viewpoint-neutral. It bars registration of scandalous marks not because such marks are thought to convey offensive *ideas*, but because they reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.* v. *City of St. Paul*, 505 U.S. 377, 393 (1992).

C. As in other contexts where the government "does not restrict" speech "but rather declines to promote" it, *Ysursa*, 555 U.S. at 355, the Court should examine whether the statute is "reasonabl[y]" related to a legitimate government interest, *ibid.*, and whether it imposes an "unconstitutional condition" on the exercise of free speech, *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 214 (2013).

The scandalous-marks provision is a longstanding and reasonable means of vindicating a number of legitimate government interests. By creating a practical disincentive to the use of marks that contain sexually explicit or profane material, the provision advances the government's interest in encouraging the use of marks that are appropriate for all audiences, including children. By discouraging the use of marks that a substantial segment of the public would find shocking, the provision advances the government's interest in the orderly flow of commerce. And by withholding government benefits from such marks, the provision advances the government's interest in avoiding any appearance of government approval of them. The commercial character of trademark protection highlights the government's broader authority in the commercial sphere, and reinforces the conclusion that the scandalous-marks provision is constitutional.

The scandalous-marks provision also does not run afoul of this Court's unconstitutional-conditions doctrine. The USPTO's registrability analysis focuses solely on the trademark the applicant seeks to register, and a refusal to register the mark does not impose any adverse legal consequences outside the trademark-registration program.

D. In declaring the scandalous-marks provision facially unconstitutional, the court of appeals committed at least four important errors. *First*, the court erred in treating the provision as a restriction on speech rather than as a condition on the availability of government benefits. *Second*, the court erred in treating as irrelevant this Court's decisions involving government-established subsidies and forums. Those cases concerned similar limits on access to government support.

Third, the court of appeals erred in suggesting that the First Amendment analysis would necessarily be the same for a hypothetical statute that imposed content-based conditions on copyright registration. That suggestion overlooks fundamental differences between trademarks and copyrights and the legal regimes that protect them. *Fourth*, the court erred in relying on a concern that the scandalous-marks provision has been applied inconsistently. Any alleged inconsistencies in prior USPTO decisions provide no sound basis to conclude that the provision is incapable of principled application or facially invalid.

ARGUMENT

THE SCANDALOUS-MARKS PROVISION IN 15 U.S.C. 1052(a) IS FACIALLY CONSTITUTIONAL UNDER THE FIRST AMENDMENT

The court of appeals erred in applying strict scrutiny to Section 1052(a)'s scandalous-marks provision, and in holding that the statutory ban on federal registration of scandalous trademarks violates the First Amendment. The scandalous-marks provision does not prohibit any speech, proscribe any conduct, or restrict the use of any trademark. Rather, it simply directs the USPTO to refuse, on a viewpoint-neutral basis, to provide the benefits of federal registration to scandalous marks. In a variety of contexts, this Court has recognized that Congress has substantial latitude to treat the content of speech as a criterion for government-conferred benefits.

The court of appeals' application of strict scrutiny was particularly misguided given the nature of the Lanham Act's trademark-registration program. In determining whether particular marks are eligible for registration, the USPTO necessarily must consider the content of the marks. Section 1052(a)'s scandalous-marks

provision is simply one of many content-based registration bans—on merely descriptive marks, and functional marks, and marks that contain a national symbol, and so on—which generally have not been thought to raise constitutional concerns. Application of strict scrutiny to laws that ban federal registration of particular types of marks would fundamentally disrupt the registration program.

This Court's decision in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), does not support the court of appeals' approach. The Court in *Tam* held that Section 1052(a)'s ban on registration of "disparag[ing]" marks violates the First Amendment. *Id.* at 1751 (quoting 15 U.S.C. 1052(a)). The only rationale on which a majority of the Court agreed, however, was that the "disparage[ment]" provision discriminated on the basis of *viewpoint*. That determination largely resolved the case, since the government's authority to engage in viewpoint discrimination is highly circumscribed, even in programs that the government itself has created. The *Tam* Court's invalidation of a viewpoint-*discriminatory* trademark-registration ban sheds little light on the proper First Amendment analysis of a viewpoint-*neutral* registration criterion like the one at issue here.

A. This Court's Decision In *Tam* Is Limited To Trademark-Registration Criteria That Discriminate Based On Viewpoint

In *Tam*, this Court declared unconstitutional Section 1052(a)'s directive that the USPTO refuse registration of "disparag[ing]" marks. 137 S. Ct. at 1751 (quoting 15 U.S.C. 1052(a)). The statutory language at issue in *Tam* prohibits the USPTO from registering a trademark that contains "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national

symbols, or bring them into contempt, or disrepute." 15 U.S.C. 1052(a). The Court in *Tam* held that the disparagement provision violates the Free Speech Clause of the First Amendment. 137 S. Ct. at 1751. The only rationale that commanded a majority of the Court, however, was that the disparagement provision discriminated on the basis of viewpoint. Because the scandalous-marks provision at issue here is viewpoint-neutral (see pp. 26-30, *infra*), the decision in *Tam* sheds little light on its First Amendment status.

1. Writing for all eight Justices who participated in *Tam*, Justice Alito concluded that the trademark-registration program is not government speech. 137 S. Ct. at 1757-1760. The rest of Justice Alito's First Amendment analysis, however, did not garner a majority of the Court. Writing for four Justices, Justice Alito rejected the government's argument that "th[e] case [wa]s governed by cases in which this Court has upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint." *Id.* at 1760; see *id.* at 1760-1761. He further concluded that the disparagement provision discriminates based on viewpoint and therefore could not be sustained as a permissible limitation on a government program or limited public forum. *Id.* at 1762-1763. Finally, Justice Alito assumed without deciding that such a viewpoint-based condition on trademark registration should be analyzed under the standard applicable to restrictions on commercial speech, and he concluded that the disparagement provision could not be sustained because it was not sufficiently tailored to a substantial government interest. *Id.* at 1763-1765.[1]

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[1] Although Justice Thomas joined Justice Alito's First Amendment analysis in full, he also filed a short concurrence expressing

2. Writing on behalf of the four remaining Justices, Justice Kennedy concurred on narrower grounds. See *Tam*, 137 S. Ct. at 1765. Those Justices agreed that the disparagement provision "constitutes viewpoint discrimination." *Ibid.* Unlike their colleagues, however, they did not address the government's arguments that the disparagement provision should be analyzed as a limitation on a government program or subsidy. See *ibid.* Rather, they explained that "the Court's precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf." *Id.* at 1768. They concluded that, because the disparagement provision does not fall within that narrow exception, *id.* at 1768-1789, "the viewpoint discrimination rationale render[ed] unnecessary any extended treatment of other questions raised by the parties," *id.* at 1765, such as "whether trademark registration should be considered a federal subsidy," *id.* at 1767.

3. All eight Justices who participated in *Tam* thus agreed on the viewpoint-discriminatory character of the disparagement provision. 137 S. Ct. at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). This Court has described viewpoint discrimination as "an egregious form of content discrimination," *Rosenberger* v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995), that is subject to particularly stringent First Amendment constraints. The Court's limited-public-forum decisions, for example, establish a "framework forbidding the State to exercise viewpoint discrimination, even when the limited

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the view that the disparagement provision should be subject to strict scrutiny even if trademarks are commercial speech. *Tam*, 137 S. Ct. at 1769.

public forum is one of its own creation." *Ibid.*; cf. *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 587 (1998) ("[E]ven in the provision of subsidies, the Government may not 'aim at the suppression of dangerous ideas.'") (brackets and citation omitted).

The *Tam* Justices' unanimous agreement that the disparagement provision discriminated based on viewpoint made it unnecessary to delineate in detail the First Amendment analysis that should apply to Lanham Act provisions that do not share that vice. And while the two principal opinions differed in other respects, they both reserved judgment on the appropriate framework for evaluating the constitutionality of viewpoint-neutral criteria for federal trademark registration. See *Tam*, 137 S. Ct. at 1763 & n.16 (Alito, J.) ("leav[ing] open" the question whether viewpoint-neutral criteria could be "saved" by analyzing federal registration as a "type of government program in which some content- and speaker-based restrictions are permitted"); *id.* at 1768 (Kennedy, J.) (leaving open "the question of how other provisions of the Lanham Act should be analyzed under the First Amendment").

As we explain below (see pp. 26-30, *infra*), Section 1052(a)'s ban on registration of scandalous marks is a viewpoint-neutral provision. This case therefore squarely presents the question that the Court in *Tam* left unresolved. Because the scandalous-marks provision establishes a reasonable condition for participation in a federal program that inherently requires content-based distinctions, it is consistent with the First Amendment.

B. Because The Scandalous-Marks Provision Is A Viewpoint-Neutral Condition On A Government Benefit Whose Availability Necessarily Turns On The Content Of An Applicant's Speech, The Court Of Appeals Erred In Subjecting That Provision To Strict Scrutiny

As a general matter, when the government *restricts* speech on the basis of content, such regulation "may be justified only if the government proves that [it is] narrowly tailored to serve compelling state interests." *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015). This Court, however, has "identified numerous situations" involving "'content discrimination'" in which "strict scrutiny is unwarranted"—including situations in which "the government is acting in a capacity other than as regulator." *Davenport* v. *Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007). In this case, the USPTO's determination that respondent's mark was "scandalous" and therefore unregistrable undoubtedly turned on the content of the mark. For three related reasons, however, strict scrutiny is unwarranted here.

First, Section 1052(a)'s scandalous-marks provision is not a restriction on speech. That provision does not limit respondent's ability to use "FUCT," whether as a mark or otherwise, on his clothing line, in advertisements, or anywhere else. Rather, the sole effect of Section 1052(a)'s scandalous-marks provision is to deny respondent the benefits of federal trademark registration. *Second*, consideration of a mark's content is an inherent and essential feature of the Lanham Act's (or, indeed, any) trademark-registration program, and the scandalous-marks provision is only one of a number of registrability criteria that turn on the content of an applicant's mark. To treat the denial of registration as the

constitutional equivalent of a ban on speech, and to apply strict scrutiny to content-based criteria for trademark registration under the Lanham Act, would fundamentally disrupt the statutory scheme. *Third*, "scandalous" marks are ineligible for registration not because they are thought to convey offensive *ideas*, but because such marks reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.* v. *City of St. Paul*, 505 U.S. 377, 393 (1992). The scandalous-marks provision thus differs from the disparagement provision struck down in *Tam*, which the Court viewed as targeting the underlying "ideas" expressed. 137 S. Ct. at 1751 (Alito, J.); see *id.* at 1766 (Kennedy, J.).

1. The scandalous-marks provision does not restrict speech, but simply imposes a condition on the availability of a government benefit

a. Since 1905, Congress has promoted commerce and consumer welfare through a voluntary nationwide trademark-registration system. See *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."). In recognition of the important commercial functions that trademarks serve, Congress committed the resources of the federal government to examining, registering, and publishing—and thereby furthering the protection of—marks that meet specified criteria.

Trademark rights arise through use of the mark to identify goods and services in commerce, without regard to federal law. See *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015) (explaining

that "federal law does not create trademarks"; rather, a person who "first uses a distinct mark in commerce * * * acquires rights to that mark"); see also *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Rather than modify or displace common-law trademark rights, the Lanham Act supplements those rights by creating statutory rights and remedies that are available to all trademark owners. See 15 U.S.C. 1116-1118, 1125(a)-(d). It also provides additional benefits to the owners of federally registered marks. Those additional benefits are directly traceable to resources devoted by the federal government to the examination and publication of qualifying marks.

For example, because registered marks have withstood examination by the USPTO, registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with certain goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). Federal examination likewise provides an objective basis for U.S. Customs and Border Protection officers to take unilateral steps to exclude counterfeit goods from importation—an exclusion that is itself accomplished through a separate use of federal resources. 15 U.S.C. 1124. And because the USPTO publishes registered marks on its principal register, registration provides nationwide constructive notice of the registrant's claim of ownership of the mark, which creates a disincentive for others to use the mark even in areas in the United States that are geographically remote from the one where the mark has already been used. 15 U.S.C. 1072. This constructive notice also provides the justification for making the owner's right to use a federally registered mark largely "incontestable" after a period of time, 15 U.S.C. 1065, 1115(b), thereby allowing owners

to "quiet title" in their marks, *Park 'N Fly*, 469 U.S. at 198.

b. As an eligibility criterion for the commercial advantages described above, the scandalous-marks provision is fundamentally different from a restriction on speech. In a variety of contexts, the government uses content-based criteria not to determine whether particular private speech should be *prohibited*, but to allocate various government *benefits*. See *Christian Legal Soc'y Chapter of the Univ. of Cal., Hastings Coll. of the Law* v. *Martinez*, 561 U.S. 661, 687 n.17 (2010) (emphasizing the "distinction between state *prohibition* and state *support*"); *Maher* v. *Roe*, 432 U.S. 464, 475 (1977) ("There is a basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy.").

The demanding standard of review that applies to *restrictions* on speech is often inappropriate in these contexts. That conclusion follows from the First Amendment's text, which "prohibits government from 'abridging the freedom of speech'" but "does not confer an affirmative right" to government assistance in speaking. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009) (quoting U.S. Const. Amend. I). It also reflects the recognition that "[t]he risk that content-based distinctions will impermissibly interfere with the marketplace of ideas is sometimes attenuated when the government is acting in a capacity other than as regulator." *Davenport*, 551 U.S. at 188. When the government "does not restrict" speech, "but rather declines to promote" it, *Ysursa*, 555 U.S. at 355, the justification for strict scrutiny is generally absent, see *id.* at 359, and the Court has instead applied a "less restrictive level of scrutiny," *Christian Legal Soc'y*, 561 U.S. at 680; see,

e.g., *Ysursa*, 555 U.S. at 359; *Cornelius* v. *NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 799-800 (1985); *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546-551 (1983).

For example, "it is well established that the government can make content-based distinctions when it subsidizes speech." *Davenport*, 551 U.S. at 188-189. The government thus can select what speech it wishes to facilitate and encourage by imposing content-based conditions on the receipt of federal funding. *Regan*, 461 U.S. at 548. Rejecting the "suggest[ion] that strict scrutiny applies whenever Congress subsidizes some speech, but not all speech," *ibid.*, the Court has instead required that funding conditions be reasonable, see *Rust* v. *Sullivan*, 500 U.S. 173, 197 (1991); *Regan*, 461 U.S. at 550-551; *Ysursa*, 555 U.S. at 359-360, and that they not "reach outside" the federal program, *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 217 (2013).

c. The scandalous-marks provision does not restrict speech. "[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question." *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). On the contrary, the owner may continue using its mark—and any other vulgar term or image it wishes—to identify its goods in commerce. See *Tam*, 137 S. Ct. at 1752 ("Without federal registration, a valid trademark may still be used in commerce."). Respondent has been using the mark "FUCT" since 1991, see C.A. App. A52, and the USPTO's refusal to register the mark does not disturb that status quo.

The USPTO's refusal to register a mark likewise does not prevent a mark owner from enforcing its mark

against others. The federal registration program presupposes the existence of a protectable trademark interest, see, *e.g.*, 15 U.S.C. 1051(a)(1) (providing that "[t]he owner of a trademark used in commerce may request registration of its trademark on the principal register"), and the owner of an unregistered mark may still assert whatever common-law or state-law rights he may have, see *Tam*, 137 S. Ct. at 1753. The owner may also invoke the Lanham Act's federal cause of action against misappropriation and consumer confusion, 15 U.S.C. 1125(a)(1), as well as other federal statutory protections and remedies, see 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(c) (remedy for dilution of famous marks even in the absence of likelihood of confusion); 15 U.S.C. 1125(d) (remedy for cybersquatting); 15 U.S.C. 1117(a) (disgorgement of profits, damages (with potential trebling), and attorney's fees (in exceptional cases) for infringement, cybersquatting, and willful dilution of marks).

The only consequence of a USPTO determination that a particular mark is "scandalous" is the unavailability of additional benefits associated with federal registration. To be sure, the prospect of obtaining those benefits may, as a practical matter, result in "indirect pressure" to use an alternative mark that is not vulgar or otherwise ineligible for registration. *Christian Legal Soc'y*, 561 U.S. at 682. But this Court has declined to equate such pressure with "direct restrictions on expression" warranting strict scrutiny. *Ysursa*, 555 U.S. at 360 n.2; see *ibid.* ("A decision not to assist fundraising that may, as a practical matter, result in fewer contributions is simply not the same as directly limiting expression."); *Christian Legal Soc'y*, 561 U.S. at 683 (distinguishing "dangling the carrot of subsidy" from "wielding the stick of prohibition"); *Rust*, 500 U.S. at

193 ("A refusal to fund protected activity, without more, cannot be equated with the imposition of a 'penalty' on that activity.") (citation omitted).

2. Administration of the federal trademark-registration program inherently and necessarily requires the government to draw distinctions based on the content of applicants' marks

Strict scrutiny is particularly unjustified in this context because content-based distinctions are an "inherent and inescapable" part of the Lanham Act's trademark-registration program. *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 49 (1983). The scandalous-marks provision is only one of a number of Lanham Act registration criteria that turn on the content of the mark for which registration is sought. Section 1052 directs the USPTO to "refuse[] registration" of, *inter alia*, marks that are deceptive, 15 U.S.C. 1052(a); marks that contain a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks that include a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e)(1); and marks that are functional, 15 U.S.C. 1052(e)(5). The federal trademark-registration program has included those types of content-based criteria for more than one hundred years. See 1905 Act § 5, 33 Stat. 725-726.

Although those prerequisites to trademark registration are content-based, they have not historically been viewed as raising meaningful First Amendment concerns. See *Tam*, 137 S. Ct. at 1768 (Kennedy, J.) ("It is well settled, for instance, that to the extent a trademark

is confusing or misleading the law can protect consumers and trademark owners."). Indeed, the determination whether a proposed mark adequately serves the purpose of identifying goods or services in commerce, and is not otherwise deceptive or misleading, necessarily turns at least in part on the mark's content. Application of strict scrutiny to those provisions would fundamentally disrupt the operation of the federal registration program.

To be sure, other Lanham Act criteria on trademark registrability may serve public and government interests that differ in some respects from those that the scandalous-marks provision is intended to vindicate. Because an appropriate First Amendment analysis requires consideration both of the government and public interests that a particular registration criterion serves, and of the burdens on the mark owner that the provision entails, those various criteria will not necessarily stand or fall together. There is no sound reason, however, that the Lanham Act's different content-based but viewpoint-neutral criteria on registrability should be subjected to different levels of First Amendment scrutiny.

3. The scandalous-marks provision is viewpoint-neutral

a. The scandalous-marks provision directs the USPTO to refuse to register trademarks containing "immoral * * * or scandalous matter." 15 U.S.C. 1052(a). Although "what constitutes 'immoral . . . or scandalous matter' has evolved over time," "[t]he formal legal framework * * * has remained consistent." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (citation omitted). Courts have long construed "scandalous" to mean, among other things, "shocking to the sense of propriety." *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938); see *In re McGinley*, 660 F.2d 481, 485-486 (C.C.P.A. 1981). And

in applying that definition, the USPTO has long refused to register marks that would be considered "[v]ulgar." *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971); see *Boulevard Entm't*, 334 F.3d at 1340 ("A showing that a mark is vulgar is sufficient to establish that it 'consists of or comprises immoral . . . or scandalous matter' within the meaning of section 1052(a).").

The quintessential vulgar mark is one that contains sexually explicit or profane material. See, *e.g.*, *Fox*, 702 F.3d at 637 n.1 (refusal to register a slang reference to a sexual organ and activity); *Boulevard Entm't*, 334 F.3d at 1338 (refusal to register a "reference to masturbation"); *McGinley*, 660 F.2d at 482 (refusal to register a "photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia"). A sample of such "highly offensive, even shocking, images and words for which individuals have sought trademark registration" appears in the addendum to the government's supplemental brief in the court of appeals. Pet. App. 45a; see Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017).

When the USPTO refuses to register such marks under the scandalous-marks provision, it does so not because "their content communicates any particular idea," but because those marks reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.*, 505 U.S. at 393. In this case, for instance, the USPTO refused to register the term "FUCT" because that term is the "phonetic twin" of a "vulgar" and "extremely offensive" word. Pet. App. 65a. The applicability of the scandalous-marks provision did not turn on what (if any) message respondent sought to convey by using that term. The agency's refusal to register the mark was based not on the views expressed, but on

the "especially offensive mode of expression." *R. A. V.*, 505 U.S. at 393.

b. This Court's decisions support the conclusion that the scandalous-marks provision is viewpoint-neutral. This Court has long denied First Amendment protection to obscenity. See *Miller* v. *California*, 413 U.S. 15, 24 (1973). And while "the threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene,'" *McGinley*, 660 F.2d at 485 n.9, vulgar words and images "offend for the same reasons that obscenity offends," *FCC* v. *Pacifica Found.*, 438 U.S. 726, 746 (1978) (plurality opinion)—namely, "because their content is so offensive to contemporary moral standards," *id.* at 745; see *id.* at 746 n.23.

This Court has long regarded that rationale for speech-related regulation as viewpoint-neutral. In *Pacifica*, for example, the Court rejected a First Amendment challenge to the government's exercise of regulatory power to "restrict the public broadcast of indecent language." 438 U.S. at 744 (plurality opinion). The language at issue was that of a George Carlin monologue, which consisted of "patently offensive words dealing with sex and excretion," *id.* at 745. The plurality acknowledged that "it is a central tenet of the First Amendment that the government must remain neutral in the marketplace of ideas." *Id.* at 745-746. The plurality explained, however, that "[v]erbal or physical acts exposing [certain private bodily functions] are offensive irrespective of any message that may accompany the exposure." *Id.* at 746 n.23. The plurality therefore concluded that, in objecting to the monologue, the government had objected "not to [a] point of view, but to the way in which it [wa]s expressed." *Id.* at 746 n.22.

The Court reached a similar conclusion in *Bethel School District No. 403* v. *Fraser*, 478 U.S. 675 (1986). In that case, a school district had disciplined a student for giving an "offensively lewd and indecent speech" at a school assembly. *Id.* at 685. In rejecting a First Amendment challenge to the school district's decision, the Court found the sanctions imposed to be "unrelated to any political viewpoint." *Ibid.* The Court thus distinguished any such viewpoint from the student's "offensive form of expression," suggesting that regulation of the latter was viewpoint-neutral. *Id.* at 682.

Contrary to respondent's suggestion (Br. in Opp. 11-12), the Court did not reject such a distinction in *Cohen* v. *California*, 403 U.S. 15 (1971). The Court in that case concluded that the defendant's conviction rested on "the asserted offensiveness of the *words* [the defendant] used to convey his message to the public." *Id.* at 18. But the Court did not treat the differential treatment of those words as discrimination on the basis of viewpoint. Rather, it described the defendant's language as a "distasteful mode of expression." *Id.* at 21. While recognizing that the vulgarity of the defendant's expression might have contributed to the "emotive" force of the "ideas" he had conveyed, the Court distinguished that "emotive" element from the substance of the "ideas" themselves. *Id.* at 26; see *id.* at 19 (distinguishing regulation of the "manner" of speech from regulation of "the substantive message it conveys"); *Bethel*, 478 U.S. at 682 (distinguishing the defendant's "antidraft viewpoint" in *Cohen* from the "offensive form of expression" he used). The Court's reasoning in *Cohen* therefore supports the conclusion that the scandalous-marks provision is viewpoint-neutral. See *Perry* v. *McDonald*, 280 F.3d 159, 170 (2d Cir. 2001) (treating a prohibition

on the use of "scatological" terms as viewpoint-neutral); *PMG Int'l Div., L.L.C.* v. *Rumsfeld*, 303 F.3d 1163, 1171 (9th Cir. 2002) (treating a prohibition on "sexually explicit materials" as viewpoint-neutral); *General Media Commc'ns, Inc.* v. *Cohen*, 131 F.3d 273, 276 (2d Cir. 1997) (same), cert. denied, 524 U.S. 951 (1998).

c. A contrary conclusion would have potentially far-reaching implications. Governments commonly exclude sexually explicit images, lewd pictures, and profanity from limited public (or nonpublic) forums. A city government might decide, for instance, that graphic sexual imagery should not appear on advertisements on city buses and billboards. See, *e.g.*, *American Freedom Def. Initiative* v. *Washington Metro. Area Transit Auth.*, 901 F.3d 356, 364 (D.C. Cir. 2018) (treating advertising space on the Metro as a nonpublic forum), petition for cert. pending, No. 18-1000 (filed Jan. 28, 2019). Or the federal government might similarly exclude such expression from a military cemetery. See, *e.g.*, *Griffin* v. *Department of Veterans Affairs*, 274 F.3d 818, 820 (4th Cir. 2001), cert. denied, 537 U.S. 947 (2002).

Viewpoint discrimination, however, is impermissible even within a forum or other program that the government itself has created. See *Tam*, 137 S. Ct. at 1763 (Alito, J.); *id.* at 1768 (Kennedy, J.); *Rosenberger*, 515 U.S. at 830. Treating Section 1052(a)'s scandalous-marks provision as viewpoint-discriminatory therefore would have potential consequences extending well beyond the trademark-registration program. If targeting vulgar material were considered a form of viewpoint discrimination, the constitutionality of reasonable limits like those described above, and similar exclusions of lewd or vulgar speech from other government-sponsored activities, would be called into doubt.

C. The Scandalous-Marks Provision Is Reasonably Related To Legitimate Government Interests And Does Not Reach Outside The Federal Trademark-Registration Program

As in other contexts where the government "does not restrict" speech "but rather declines to promote" it, the appropriate First Amendment inquiry examines whether the statute is "reasonabl[y]" related to a legitimate government interest. *Ysursa*, 555 U.S. at 355; see *Rosenberger*, 515 U.S. at 829; *Regan*, 461 U.S. at 546-551. The appropriate First Amendment inquiry also examines whether the statute imposes an "unconstitutional condition" on the exercise of free speech—here, by asking whether the scandalous-marks provision seeks to "leverage" the benefits of registration "to regulate speech outside the contours of the [trademark-registration] program itself." *Agency for Int'l Dev.*, 570 U.S. at 214-215.[2]

Though less demanding than strict scrutiny, these inquiries are not toothless. See *Agency for Int'l Dev.*, 570 U.S. at 217 (finding that a condition on funding to combat HIV/AIDS fell "on the unconstitutional side of the line"). Rather, they ensure that "Congress cannot recast a condition on [benefits] as a mere definition of its program" and thereby "reduce[]" the First Amendment inquiry to "a simple semantic exercise." *Id.* at 215 (citation omitted). At the same time, they leave Congress broad discretion to "encourage certain activities

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[2] These are the relevant inquiries under the Free Speech Clause. Other constitutional provisions afford additional protection against, for example, refusing registration on the basis of a suspect classification, such as race or national origin, see *Regan*, 461 U.S. at 546-547, or on the basis of the mark owner's religious identity or beliefs, see *Trinity Lutheran Church of Columbia, Inc.* v. *Comer*, 137 S. Ct. 2012, 2019 (2017).

it believes to be in the public interest." *Rust*, 500 U.S. at 193.

1. A ban on registration of scandalous marks is a longstanding and reasonable means of vindicating legitimate government interests

A ban on registration of scandalous marks has been a feature of federal trademark law for more than a century. See 1905 Act § 5, 33 Stat. 725. Nearly every State has enacted a similar provision. See Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 Trademark Rep. 1476, 1477 & n.3 (2011) (citing state statutes). And international treaties to which the United States is a party authorize member nations to impose such limits. See General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(3), 46 Stat. 2914, T.S. No. 833 (authorizing refusal to register marks "[w]hich offend public morals or which may be contrary to public order"); Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 (U.S. accession effective May 30, 1887) (similar); see also Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172, 1178-1179 (2013) (giving Canada, the United Kingdom, and Australia as examples of other countries that refuse to register marks that are either scandalous or contrary to public policy or morality). As the long history and pedigree of such provisions indicate, the scandalous-marks provision is reasonably related to legitimate government interests.

a. The statutory ban on registration of scandalous marks is reasonably related to the government's legitimate interest in protecting the sensibilities of the public. "[T]rademarks appear everywhere: they are openly

displayed in stores, presented on billboards and road signs, delivered to the mailbox, embedded in movies and television, [and] advertised throughout the internet." Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. Davis L. Rev. 2331, 2362 (2018); see Pet. App. 27a (noting "the breadth of goods and services" associated with scandalous marks, including "clothing, books, websites, beverages, mechanical contraptions, and live entertainment"). Indeed, that is the point of a trademark—"to appear in a way that is noticeable." Snow 2362 n.117.

Given the pervasive presence of trademarks in public view, Congress has a legitimate interest in encouraging the use of trademarks that are appropriate for all audiences, including children. See *McGinley*, 660 F.2d at 486 (observing that a trademark "may be used in a prominent location for public viewing by persons of all ages"); Snow 2362 n.117 ("Anywhere a child might perceive a commercial product, a child can perceive a scandalous mark."). Just as Congress may reasonably seek to limit the exposure of children to sexually explicit or profane material over the airwaves or in public libraries, see *United States* v. *American Library Ass'n*, 539 U.S. 194, 211-212 (2003) (plurality opinion); *Pacifica*, 438 U.S. at 748-750, it may reasonably decline to promote the commercial use of marks that contain similar material. Although refusing to register vulgar marks does not impose any legal constraint on use of such marks in commerce, it creates a practical disincentive to their use by rendering certain government benefits unavailable.

b. The refusal to register scandalous marks is also reasonably related to the government's legitimate in-

terest in the orderly flow of commerce. The "predominant function" of a trademark is to identify and distinguish the source of goods or services in commerce. *Wal-Mart Stores, Inc.* v. *Samara Bros.*, 529 U.S. 205, 212 (2000). By "quickly and easily" performing that "source-identifying" function, the most effective trademarks "'reduce the customer's costs of shopping and making purchasing decisions.'" *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 163-164 (1995) (brackets and citation omitted).

By definition, scandalous marks contain material that a "substantial composite of the general public" would find "'shocking to the sense of . . . propriety.'" *McGinley*, 660 F.2d at 485 (citation omitted). For much of the populace, seeing a scandalous mark in the marketplace thus is disruptive. See Pet. App. 46a (describing many of the scandalous marks for which the USPTO had refused registration as "lewd, crass, or even disturbing"); Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017) (providing a sample of highly offensive marks for which registration has been sought and refused). Such disruption disserves the purposes of trademarks and trademark law by making commercial transactions less efficient. See *Qualitex*, 514 U.S. at 163-164.

c. The refusal to register scandalous marks is also reasonably related to the government's legitimate interest in avoiding any appearance that the government approves of such marks. To be sure, "[t]rademarks are private, not government, speech." *Tam*, 137 S. Ct. at 1760. But the government has a legitimate interest in avoiding not just the "reality," but also the "appearance," of government approval of vulgar speech. *Ysursa*, 555 U.S. at 359. This Court has held, for example, that "limitations on speech may be justified by [an] interest

in 'avoiding the appearance of political favoritism.'" *Id.* at 360 (quoting *Cornelius*, 473 U.S. at 809). A similar interest justifies the refusal to register scandalous marks.

The government's association with a registered mark is an unavoidable facet of the trademark-registration program. The USPTO publishes registered marks in official government publications and records them on the agency's official register. See 15 U.S.C. 1051(a)(1), 1057(a), 1062, 1091; USPTO, *Trademark Official Gazette*, https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog. It also issues certificates of registration to mark owners "in the name of the United States," 15 U.S.C. 1057(a), and those certificates are transmitted to other countries and to the World Intellectual Property Organization to facilitate registration and enforcement abroad, see Paris Convention for the Protection of Industrial Property, Art. 6^{quinquies}, July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333; see also 15 U.S.C. 1141b (Madrid Protocol). Mark owners themselves may "give notice" that their marks are registered "by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®." 15 U.S.C. 1111.

Although the government's association with a registered mark does not convert that mark into government speech, the public may still perceive that association as evidence of government approval—particularly when the ® symbol (or similar notation) appears next to the mark. And while Congress may be willing to tolerate that perception in most cases for the sake of maintaining a functional registration program, it may reasona-

bly draw the line at marks that contain material so offensive, irrespective of viewpoint, that a substantial segment of the population would find them shocking. See *McGinley*, 660 F.2d at 485; Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017). To avoid the appearance of government approval of such marks, the scandalous-marks provision sensibly prohibits their registration.

d. The commercial character of trademarks and trademark protection reinforces the conclusion that the scandalous-marks provision is constitutional. A trademark is inherently commercial in nature, since its "predominant function" is to identify a mark owner's company as the source of goods in commerce. *Wal-Mart Stores*, 529 U.S. at 212; see *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U.S. 203, 205 (1942) (describing a trademark as "a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants"). Even its "subsidiary functions"—to "invoke positive connotations in the consumer's mind," and to "attract an otherwise indifferent consumer's attention on a crowded store shelf," *Wal-Mart Stores*, 529 U.S. at 212—serve a commercial aim: "to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears," *Mishawaka Rubber*, 316 U.S. at 205; see *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (treating the use of the word "Olympic" as "commercial speech"); *Friedman* v. *Rogers*, 440 U.S. 1, 11 (1979) (treating the use of a trade name as "commercial speech" and observing that "the optometrist who uses a trade name 'does not wish to editorialize on any subject, cultural, philosophical, or political'") (citation omitted).

The benefits of trademark registration are likewise commercial. A trademark "does not confer a right to prohibit the use of [a] word or words" in all circumstances, but "only gives the right to prohibit the use of [them] so far as to protect the owner's good will against the sale of another's product as his." *Prestonettes, Inc.* v. *Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.). Federal registration gives mark owners certain advantages in obtaining redress against infringers and other unauthorized users of the mark. See pp. 4-5, *supra*. Denial of registration renders those *commercial* advantages unavailable, but it does not impair the mark owner's ability to *use* the mark for any purpose.

In challenging the USPTO's refusal to register his mark, respondent therefore asserts a First Amendment right to receive substantial government assistance in suppressing his competitors' speech for the benefit of respondent's own commercial interests. In cases involving actual restrictions on commercial speech, this Court has recognized "the commonsense distinction between speech proposing a commercial transaction, *which occurs in an area traditionally subject to government regulation*, and other varieties of speech." *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 562 (1980) (emphasis added; citations and internal quotation marks omitted). The First Amendment scrutiny that applies to restrictions on commercial speech therefore reflects this Court's recognition of the greater flexibility that federal and state legislatures have to regulate in the commercial sphere. In assessing the constitutionality of Congress's refusal to confer on scandalous marks the benefits of federal registration, the Court should likewise give weight to the inherently commercial character of trademark protection, and to

the government's broader authority to encourage certain activities by commercial entities.

2. The scandalous-marks provision does not subject respondent or similarly situated persons to any adverse legal consequences outside the trademark-registration program

The scandalous-marks provision also does not run afoul of this Court's unconstitutional-conditions doctrine. That doctrine distinguishes between "conditions that define the federal program and those that reach outside it." *Agency for Int'l Dev.*, 570 U.S. at 217. Conditions of the latter type "can result in an unconstitutional burden on First Amendment rights," even in circumstances where the government had no constitutional obligation to create the program in question. *Id.* at 214.

The program at issue here is the federal trademark-registration program. Under that program, the USPTO's registrability analysis focuses solely on the trademark the applicant seeks to register. An applicant is not required, as a condition of registering a mark, to promise never to use vulgar terms, or to endorse the view that vulgar terms are unacceptable. Cf. *Agency for Int'l Dev.*, 570 U.S. at 218 (holding unconstitutional a condition on federal funding that went "beyond defining the limits of the federally funded program" "[b]y requiring recipients to profess a specific belief"). Respondent's use of the term "FUCT" on clothing and advertisements does not affect his right to register any *other* trademark (for the same or different products) that satisfies the statutory criteria.

The Lanham Act's ban on *registration* of scandalous marks also does not deprive respondent of rights he

would otherwise possess under other Lanham Act provisions or under state or common law. The statute makes certain benefits available to holders of *all* marks, including marks that have not been registered or that are ineligible for registration. The Act establishes a broad federal cause of action against misappropriation and consumer confusion, which can be invoked even in the absence of a valid or registered mark. 15 U.S.C. 1125(a)(1); see *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (explaining that Section 1125(a) "protects qualifying unregistered trademarks"). Congress has also prohibited the importation of goods bearing confusing markings without regard to federal registration. 15 U.S.C. 1125(b). It has provided federal protections against dilution of famous unregistered marks and cybersquatting on unregistered marks. 15 U.S.C. 1125(c)-(d). And it has permitted awards of disgorgement of profits, damages (with potential trebling), and attorney's fees (in exceptional cases) for infringement, cybersquatting, and willful dilution of unregistered trademarks. 15 U.S.C. 1117(a).

Thus, even without federal registration, respondent may use vulgar terms or symbols to identify his goods in commerce, and he has done so without federal interference since 1991. C.A. App. A52. He may also seek to enforce his rights against others who he believes have used the term in a way that would be likely to confuse consumers. See *Tam*, 137 S. Ct. at 1752. And despite the fact that his products feature profanity and nudity, see Pet. App. 7a, he may obtain for those goods the supplemental benefits that flow from federal trademark registration simply by selecting a mark that satisfies the statutory criteria. The fact that respondent cannot register the term "FUCT" as a trademark leaves him in the

same position he would have occupied if the federal trademark-registration program did not exist. Because the scandalous-marks provision "define[s] the federal program" and does not "reach outside it," *Agency for Int'l Dev.*, 570 U.S. at 217, it does not place "an unconstitutional burden on First Amendment rights," *id.* at 214.

D. The Court Of Appeals' Contrary Reasoning Is Erroneous

In reaching a contrary conclusion, the court of appeals committed at least four important errors.

1. The court of appeals erred in treating the scandalous-marks provision as a restriction on speech

If the USPTO determines that a particular mark is "scandalous" within the meaning of Section 1052(a), the only consequence is that the mark is refused registration. 15 U.S.C. 1052(a). Without federal registration, the mark "may still be used in commerce," *Tam*, 137 S. Ct. at 1752, as respondent's longstanding use of the term "FUCT" shows, see J.A. 38. Neither Section 1052(a) itself, nor the USPTO's determination that respondent's "FUCT" mark is scandalous, restricts respondent's ability to use the mark on goods or in advertisements, or to engage in any other associated speech.

Citing this Court's decision in *United States* v. *Playboy Entertainment Group, Inc.*, 529 U.S. 803, 812 (2000), the court of appeals found that strict scrutiny presumptively applies to any content-based discrimination "whether a government statute bans or merely burdens protected speech." Pet. App. 15a. But the "burdens" at issue in *Playboy* were still restrictions on speech. Although the provision struck down in that case did not impose a "complete prohibition" on sexually explicit television programming, its practical effect was to compel a substantial number of cable operators to

"silence[]" such programming "for two-thirds of the day in every home in a cable service area." 529 U.S. at 812. Section 1052(a), by contrast, does not silence respondent or restrict his ability to express himself, through use of his mark or otherwise, at any time or in any place. Rather, it denies him only the benefits associated with federal trademark registration.

2. The court of appeals erred in treating as irrelevant this Court's decisions involving government-established subsidies and forums

The court of appeals distinguished on their facts, and ultimately dismissed as irrelevant, various decisions of this Court applying First Amendment principles to subsidies and forums established by the government. Pet. App. 16a-28a; see pp. 20-26, *supra*. Those decisions, however, stand for the principle that strict scrutiny is generally unwarranted when the government "does not restrict" speech, "but rather declines to promote" it. *Ysursa*, 555 U.S. at 355; see *Davenport*, 551 U.S. at 188-189. Contrary to the court of appeals' suggestion (Pet. App. 16a-28a), that principle is not limited to circumstances involving the direct provision of government money or control over physical property.

For example, in *Davenport*, this Court applied that principle to a state statute that required public-sector unions to obtain a nonmember's affirmative consent before using that nonmember's agency-shop fees for election-related activities. 551 U.S. at 182. The statute thus drew "a distinction based on the content of speech: Specific consent was required from nonunion members before agency fees could be used for election-related activities, but consent was not required with respect to agency fees used for other purposes." *Ysursa*, 555 U.S. at 360 (citing *Davenport*, 551 U.S. at 181-182). The

Court rejected the unions' argument that this "modest limitation" on a government-conferred "benefit"—namely, the "extraordinary power" "to levy fees on government employees who do not wish to join the union"—violated the unions' First Amendment rights. *Davenport*, 551 U.S. at 184. In upholding that limitation, the Court "recognized that the statute, rather than suppressing union speech, simply declined to assist that speech by granting the unions the right to charge agency fees for election activities." *Ysursa*, 555 U.S. at 360; see *Davenport*, 551 U.S. at 189-190. The Court therefore found strict scrutiny to be unwarranted and upheld the statute as a "reasonable, viewpoint-neutral limitation" on a "state-bestowed entitlement." *Davenport*, 551 U.S. at 189.[3]

The Court in *Ysursa* similarly declined to apply strict scrutiny to a state statute that authorized the deduction of "union fees from a public employee's wages with the employee's 'signed written authorization,'" but prohibited such payroll deductions for union political activities. 555 U.S. at 356. The Court rejected the unions' argument that this content-based "limitation" on the use of "government payroll mechanisms" violated their First Amendment rights. *Id.* at 355. The Court explained that the statute "does not restrict political speech, but rather declines to promote that speech by

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[3] In *Janus* v. *AFSCME*, 138 S. Ct. 2448 (2018), the Court held that the First Amendment rights of *nonmembers* are violated when agency fees are deducted from their wages without their affirmative consent. *Id.* at 2486. In overruling *Abood* v. *Detroit Board of Education*, 431 U.S. 209 (1977), however, the Court's decision in *Janus* did not disturb the principles underlying this Court's decisions in *Davenport* and *Ysursa* rejecting the First Amendment claims of *unions*.

allowing public employee checkoffs for political activities." *Ibid.* Observing that "the State is not constitutionally obligated to provide payroll deductions at all," *id.* at 359, the Court invoked the principle that "[a] legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny," *id.* at 358 (quoting *Regan*, 461 U.S. at 549). The Court therefore concluded that "the State need only demonstrate a rational basis to justify the ban on political payroll deductions." *Id.* at 359.

Although Justice Alito's opinion in *Tam* rejected the government's reliance on *Davenport* and *Ysursa* in the context of a viewpoint-discriminatory provision, 137 S. Ct. at 1762, that opinion did not command a majority on this point. And Justice Alito's summary of *Davenport* and *Ysursa* confirms that the court of appeals erred in treating precedents related to government programs as limited to Spending Clause legislation or physical property. As Justice Alito explained, the Court in *Davenport* and *Ysursa* recognized that lawmakers may choose "to confer a substantial non-cash benefit for the purpose of furthering activities that they particularly desired to promote but not to provide a similar benefit for the purpose of furthering other activities." *Id.* at 1762. That framework describes this case.

3. A decision sustaining the scandalous-marks provision against respondent's First Amendment challenge would have no necessary implications for the constitutionality of analogous limits on copyright registration

The court of appeals was also wrong in suggesting that there is no "principled basis to distinguish between the registration of trademarks and the registration of copyrights under the government program rationale."

Pet. App. 22a. If a hypothetical statute denied registration of copyrights in particular types of creative works, the First Amendment analysis would depend in part on the precise legal consequences of that denial and the justifications offered for it. To the extent that such a law presented a greater risk of interfering with the marketplace of ideas, or imposed a greater burden on expression, than does the denial of trademark registration—*e.g.*, because of differences between trademarks and copyrights, because of differences in the roles played by registration under the two regimes, or because of differences in the preemption, if any, of state law—the First Amendment inquiry would take account of that greater risk or burden.

The legal regimes that protect trademarks and copyrights respectively serve fundamentally different purposes. The "predominant function" of a trademark is "source identification," *Wal-Mart Stores*, 529 U.S. at 212, and "[f]ederal trademark law 'has no necessary relation to invention or discovery,'" *Dastar Corp.* v. *Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (citation omitted). By contrast, copyright protects expression itself, *i.e.*, "original works of authorship fixed in a[] tangible medium of expression." 17 U.S.C. 102(a). This Court has described copyright as "the engine of free expression," "suppl[ying] the economic incentive to create and disseminate ideas." *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (citation omitted); see *ibid.* ("[C]opyright's purpose is to *promote* the creation and publication of free expression.").

Because copyrighted creative works are *themselves* the goods that the author seeks to market, rather than simply source identifiers for such goods, content-based

limits on copyright registrability (or on copyright protection) likely would have much more significant effects on the creation and dissemination of protected expression than analogous limits on the registration of trademarks. That would be particularly true if copyright registration could be refused based on a portion of a much longer work, rather than on the work as a whole. Cf. *Miller*, 413 U.S. at 24 (explaining that whether a work is obscene depends on an analysis of the work "as a whole"). And while significant content-based conditions on registrability are a longstanding feature of trademark law, see pp. 25-26, *supra*, those provisions lack any meaningful analogue in past or present copyright statutes. See *Mitchell Bros. Film Grp.* v. *Cinema Adult Theater*, 604 F.2d 852, 855 (5th Cir. 1979) ("Congress has been hostile to content-based restrictions on copyrightability."), cert. denied, 445 U.S. 917 (1980); cf. *Rust*, 500 U.S. at 199-200 (discussing the significance of traditional practices in identifying exceptions to "the general rule that the Government may choose not to subsidize speech"). Nothing in the government's position here would prevent those differences from being taken into account in conducting First Amendment analysis of a (hypothetical) statute that denied registration of copyrights in scandalous works.

4. The court of appeals' concern that the scandalous-marks provision has been applied inconsistently provides no basis for invalidating that provision

The court of appeals also expressed concern that the scandalous-marks provision has been applied inconsistently. Pet. App. 39a-42a. But analysis of whether a mark is scandalous requires consideration of evidence of the mark's meaning in relation to the particular goods and services for which registration is sought and the

context in which the mark is used. See *Boulevard Entm't*, 334 F.3d at 1340. Like analysis of other registrability criteria, it also requires consideration of evidence of "contemporary attitudes," which naturally change over time. *Ibid.*; cf., *e.g.*, *De Walt, Inc.* v. *Magna Power Tool Corp.*, 289 F.2d 656, 660 (C.C.P.A. 1961) ("A word or group of words not descriptive today may, through usage, be descriptive tomorrow."). The fact that some marks bear superficial similarities to others therefore does not establish that the USPTO erred in treating them differently. See *In re St. Helena Hosp.*, 774 F.3d 747, 753 (Fed. Cir. 2014) ("[E]ach case must be decided on its own facts and the differences are often subtle ones.") (citation omitted).

Moreover, the USPTO examines more than 400,000 trademark applications each year. If an individual USPTO examining attorney improperly allows a mark to be registered or improperly refuses registration, that error "do[es] not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). An allegedly erroneous registration may be prevented through an adversarial opposition proceeding, see 15 U.S.C. 1063, 1067, or corrected through the process of administrative cancellation, see 15 U.S.C. 1064, 1067. The agency's decisions in both types of administrative proceedings are subject to judicial review. See 15 U.S.C. 1071. A disappointed applicant who wishes to challenge the examining attorney's refusal of registration may also seek administrative and judicial review. See 15 U.S.C. 1070, 1071. In establishing those mechanisms, Congress recognized that registration errors may occasion-

ally occur, while taking steps to facilitate their correction. Thus, even if respondent could identify clear inconsistencies between particular registration decisions, there would be no sound basis to conclude that the scandalous-marks provision is incapable of principled application.

In any event, concerns about outcomes in individual cases do not justify the "strong medicine" of facial invalidation. *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613 (1973); see *United States* v. *Stevens*, 559 U.S. 460, 473 (2010) (explaining that, "[i]n the First Amendment context," the Court recognizes a "'type of facial challenge,' whereby a law may be invalidated as overbroad if 'a substantial number of its applications are unconstitutional, judged in relation to the statute's plainly legitimate sweep'") (citation omitted). Any alleged inconsistencies reflected in prior USPTO decisions provide no valid basis for holding that the agency must register scandalous marks, including even those "whose offensiveness cannot be reasonably questioned." Pet. App. 41a; see Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017).

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted.

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APPENDIX

1. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall[1] specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

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[1] So in original. The word "shall" probably should not appear.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the

mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regu-

lations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person

resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

2. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States

during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe

conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

3. 15 U.S.C. 1053 provides:

Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

4. 15 U.S.C. 1057 provides:

Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed

thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Surrender, cancellation, or amendment by owner

Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the rec-

ords of the United States Patent and Trademark Office and upon the certificate of registration.

(f) Copies of United States Patent and Trademark Office records as evidence

Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of United States Patent and Trademark Office mistake

Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and

effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant's mistake

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

5. 15 U.S.C. 1062 provides:

Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: *Provided*, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.

6. 15 U.S.C. 1065 provides:

Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

(1) there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce,

and other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

7. 15 U.S.C. 1111 provides:

Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this

chapter unless the defendant had actual notice of the registration.

8. 15 U.S.C. 1114 provides in pertinent part:

Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to

be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

* * * * *

9. 15 U.S.C. 1115 provides:

Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership

of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however,* That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under

subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

10. 15 U.S.C. 1117 provides:

Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the

case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) for any violation of section 1114(1)(a) of this title or section 220506 of title 36, in a case involving use of a counterfeit mark or designation (as defined in section 1116(d) of this title), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee, if the violation consists of—

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services; or

(2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.

In such a case, the court may award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, beginning on the date of the service of the claimant's pleadings setting forth the claim for such entry of judgment and ending on the date such entry is made, or for such shorter time as the court considers appropriate.

(c) Statutory damages for use of counterfeit marks

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than $1,000 or more than $200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than $2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(d) Statutory damages for violation of section 1125(d)(1)

In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statu-

tory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.

(e) Rebuttable presumption of willful violation

In the case of a violation referred to in this section, it shall be a rebuttable presumption that the violation is willful for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name used in connection with the violation. Nothing in this subsection limits what may be considered a willful violation under this section.

11. 15 U.S.C. 1125 provides:

False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or

her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole,

is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action

against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

12. 15 U.S.C. 1127 provides in pertinent part:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * * * *

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

* * * * *

The term "mark" includes any trademark, service mark, collective mark, or certification mark.

* * * * *

The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3,

1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

* * * * *

No. 18-302

In The
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR RESPONDENT

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QUESTIONS PRESENTED

1. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

2. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is unconstitutionally vague under the First and Fifth Amendments.

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CONSTITUTIONAL PROVISIONS

"Congress shall make no law . . . abridging the freedom of speech. . . ." Constitution, First Amendment.

"No person shall be . . . deprived of life, liberty, or property, without due process of law;. . . ." Constitution, Fifth Amendment.

STATUTORY PROVISION

"No trademark . . . shall be refused registration . . . unless it—

(a) Consists of or comprises immoral . . . or scandalous matter;. . . ."

Lanham Act, Section 2(a), 15 U.S.C. § 1052(a).

STATEMENT

In a facial challenge, the facts in the specific case are often irrelevant. But here, Brunetti's application demonstrates the negative impact of the Immoral and Scandalous Clauses ("Clauses") on free speech.

1. Brunetti is an artist. J.A. 60. He founded the FUCT brand in 1990. J.A. 38. The name of the brand is pronounced as four letters, one after another.[1]

[1] It is not expected that it will be necessary to refer to vulgar terms during argument. If it should be necessary, the discussion

Brunetti's brand focuses on questioning authority: the assumptions of society, the government, and accepted wisdom. Pet. App. 57a. Brunetti's brand comments on current political and societal issues, sometimes obviously, and sometimes subtly. J.A. 60. To the extent FUCT has a meaning, it is FRIENDS U CAN'T TRUST. J.A. 38.

Since 1991, his products have been distributed throughout America. *Id.* His products have never been sold at general retailers such as Walmart or Target. During the pendency of this matter, Brunetti has stopped selling to brick-and-mortar stores and now sells only on the internet.

2. The application in question was filed in 2011. J.A. 8. The United States Patent and Trademark Office ("PTO") examining attorney reviewed the application and issued two separate office actions and considered the responses. An Amendment to Allege Use, after another office action was issued and responded, was accepted on May 20, 2012. J.A. 35. The examining attorney approved the mark for publication. The law office managing attorney did not raise the vulgarity of the FUCT mark. J.A. 34-36. Publication review was completed on June 11, 2012, without any immoral or scandalous objection. J.A. 32. It was only afterwards that some PTO official, whose name has been concealed from the record, decided to withdraw the

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will be purely clinical, analogous to when medical terms are discussed.

application from publication and return it to the examining attorney with instructions to refuse the application.

Thereafter the application was refused on the ground that FUCT is the phonetic equivalent of the word "fucked," the past tense form of the verb "fuck." J.A. 17-22; Pet. App. 56a. Ultimately, the application was finally refused. J.A. 25-31.

3. Brunetti appealed the refusal to the Trademark Trial and Appeal Board ("Board"). It issued its decision on August 1, 2014. The Board wrote:

> Erik Brunetti is an artist and entrepreneur whose graphics are infused with cultural strands from skateboarding, graffiti culture, punk rock music, and remnants of Situationist Ideal ideologies. He has been a trailblazer since the early nineties in popularizing "streetwear" having revolutionary themes, proudly subversive graphics and in-your-face imagery. His assaults on American culture critique capitalism, government, religion and pop culture. Brunetti's blog is directed to a cult following that he, his company, Fuct Manuf. Co., and Fuct's "Same Shit Different Day" line of clothing have developed since he allegedly first adopted this designation in 1991. Pet. App. 57a-58a.

The Board concluded that Brunetti's website and blog contained "anti-social imagery," was "lacking in taste," and contained a theme "of extreme nihilism." Pet. App. 63a-64a. "Applicant's cult following may well

represent a reliable niche market for its goods and ideology." Pet. App. 66a.

The Board discounted Brunetti's meaning of Friends U Can't Trust. The Board refused to give any weight to Brunetti's evidence that only one person in the history of the brand objected to his trademark. Pet. App. 66a.

The Board affirmed the refusal. Pet. App. 67a.

4. A timely appeal was filed to the Federal Circuit. While this case was pending, the Court of Appeals decided *In re Tam*, 808 F.3d 1321 (2015) (*en banc*), which overruled *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) and its progeny. (The Government's brief relies heavily on *McGinley* and its progeny, without mentioning that they have been overruled.) The Court of Appeals asked for further briefing on the impact of the *en banc* decision in *Tam*. The Government responded that "given the breadth of the Court's *Tam* decision and in view of the totality of the Court's reasoning," there was no reasonable basis for treating immoral or scandalous marks differently than disparaging marks. Gov't Letter Br. 2, *In re Brunetti*, No. 15-1109, Docket No. 52 (Fed. Cir. Jan. 21, 2016). The Government maintained, however, that if the Solicitor General sought Supreme Court review of the *en banc* decision in *Tam*, "the Government may argue that, under reasoning less sweeping than that adopted in *Tam*, the bar on registration of scandalous and immoral marks would survive even if the bar on registration of disparaging marks were held invalid." *Id.* at 4.

After this Court decided *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Court of Appeals requested further briefing on the impact of this Court's decision. Thereafter, this case was re-argued before the same panel. The Court of Appeals issued its decision on December 15, 2017. It held the Clauses facially unconstitutional because they targeted the expressive function of trademarks and therefore strict scrutiny applied. The Government conceded the Clauses did not survive strict scrutiny. Pet. App. 31a. The Court of Appeals held, alternatively, that even if the Clauses regulated purely commercial speech, they did not survive intermediate scrutiny because the Government had no substantial interest that was served by the Clauses. Pet. App. 41a-42a. Brunetti argues that the Court of Appeals' decision was correct and should be affirmed by this Court.

The Court of Appeals did not apply *Marks v. United States*, 430 U.S. 188 (1977) analysis to this Court's decision in *Tam*. Rather it relied on the unanimous portions of *Tam*, and on those principles which Justices Alito and Kennedy agreed. The Court of Appeals did not find it necessary to decide whether its *en banc* decision in *In re Tam* was binding because the Court of Appeals independently resolved such issues, relying on *Tam* and other Supreme Court decisions. Pet. App. 18a n.1.

5. In the Court of Appeals and in its Petition, the Government failed to discuss many of Brunetti's arguments (e.g., refusal of registration under the Clauses is always due to viewpoint, profanity expresses viewpoint, the PTO refuses only some profanity, and the

Clauses are not readily susceptible of being read in the manner the Government contends). Accordingly, in his Brief in Response to Petition, Brunetti wrote that "the Government hopefully will address these arguments in its opening brief on the merits. . . ." However, the Government mostly ignored these critical points.

SUMMARY OF ARGUMENT

The Court of Appeals should be affirmed.

The Immoral and Scandalous Clauses of Section 2(a) prohibit registration of trademarks involving politics, religion, social issues, ethnicity, the role of women, drugs, violence, humor, double entendres, slang, patriotism, profanity, and excretory and sexual references. Any mark that is likely to offend some part of the public is to be refused. The Government wisely chooses not to defend the plain language of the Clauses because such language is clearly unconstitutional.

Below, and in its petition, the Government focused on defending the Clauses as allegedly content-neutral so long as the Clauses are interpreted as applying only to profanity, excretory, and sexual matters (hereinafter "PES marks"). Brunetti pointed out that the Clauses are not readily susceptible of such interpretation. Additionally, the PTO allows some PES marks and refuses others, so it is not applying the Clauses in a content-neutral manner, but rather based upon the perceived offensiveness of the marks and the applicant's intended meaning. The Government also

assumes that profanity does not express a viewpoint. Profanity usually expresses a viewpoint: at minimum, of non-compliance with societal mores. But Brunetti's mark, as the Board found, was offensive *because* he "critique[d] capitalism, government, religion and pop culture." Pet. App. 57a.

In its merits brief, the Government further narrows its interpretation of the Clauses to apply only to sexual activity/imagery/organs, although it occasionally refers to profanity. The Clauses are not readily susceptible to that construction. The Government conflates obscenity, which can be refused, with vulgarity. The Government implicitly argues that it can prohibit speech relating to sexual matters without such speech actually being obscene.

There is no principled reason to reach a different result here than this Court reached as to the Disparagement Clause in *Matal v. Tam*, 137 S. Ct. 1744 (2017). Trademarks are refused because they are offensive.

In deciding this case, if the Court determines that marks refused under the Immoral/Scandalous Clauses do not express viewpoint, then the Court should confirm that the appropriate level of scrutiny for content regulation is strict scrutiny. The Government's reasons for a lesser level of or no scrutiny should be rejected. If trademark registration is not government association, forum, program, speech, or subsidy for disparaging trademarks, then trademark registration cannot be so for immoral or scandalous marks. Although some of

these contentions were not explicitly rejected in *Tam*, all lack merit.

And if even the Court does not reach the vagueness of the Clauses, such vagueness informs whether the Clauses are unconstitutionally overbroad.

In order to determine the extent to which *Tam* is a binding precedent, the Court must decide the many unanswered questions about how the *Marks* Rule applies. *Marks v. United States*, 430 U.S. 188, 194 (1977). Brunetti suggests the Court should return to the common law rule of Dual Majority: majority on the judgment and majority on the reasoning.

ARGUMENT

I. THE IMMORAL/SCANDALOUS CLAUSES ARE FACIALLY INVALID

The *Tam* Court was unanimous that giving offense is a viewpoint. Trademarks are refused under the Immoral/Scandalous Clauses solely due to offensiveness. Therefore, the Clauses discriminate on viewpoint and strict scrutiny applies.

The Government seeks to distinguish *Tam* by advancing a novel interpretation of the Clauses: that they are merely content-regulation (of either profanity, excretory and sexual matter) or of sexual activity/imagery/organs. That is not how the Clauses have been interpreted for seventy years. But even if the Clauses

were only content-regulation, this would still be subject to strict scrutiny under *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015).

Even if intermediate scrutiny under *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980), were appropriate, the Clauses do not survive such scrutiny.

The other position advanced by the Government is that the "mode of expression" (i.e., profanity) can be regulated. The Government's reliance on *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), is misplaced.

A. The Immoral/Scandalous Clauses Regulate Viewpoint.

The Court was unanimous that giving offense is a viewpoint.

> Giving offense is a viewpoint. We have said time and again that "the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers." *Tam*, 137 S. Ct. at 1763 (Alito, J., plurality).

Justice Kennedy cited to Justice Alito's opinion, quoted immediately above, and wrote:

> [T]he Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed. *Tam*, 137 S. Ct. at 1767.

Since the Government seems to question the applicability of *Tam*, it should be noted the Court's prior decisions, such as *Street v. New York*, 394 U.S. 576, 592 (1969), and *Texas v. Johnson*, 491 U.S. 397, 409-10 (1989), reach the same conclusion.

1. Brunetti's Mark Was Refused Because It Was Offensive.

The record is clear that Brunetti's mark was refused due to its offensiveness. The Board wrote:

> Whether one considers "fucked" as a sexual term, or finds that Applicant has used "fucked/fuct" in the context of extreme misogyny, nihilism or violence, we have no question but that these are still extremely offensive terms in the year 2014. Pet. App. 65a.
>
> We find that the Trademark Examining Attorney has shown by a preponderance of the evidence that a substantial composite of the general public would find this designation vulgar. Pet. App. 66a.

2. Refusals Under the Immoral/Scandalous Clauses Are Always Based Upon the Degree of Offensiveness.

a. The Test for Refusal Is Offensiveness.

A mark is refused if "it would be considered offensive by a substantial portion of the public." *Trademark Manual of Examining Procedure* ("TMEP") § 1203.01,

quoting *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996).

b. The Government Is Regulating Offensiveness.

The Government allows *some* profanity, excretory, and sexual content and refuses *some*. So it is not engaging in a content-neutral regulation of PES marks. Rather, the basis for deciding whether to approve an application is *degree of the perceived offensiveness* of the mark.

Actual practice shows that the Government allows registration of some profanity. For example, it always allows "damn." Sometimes it allows "ass," "cock," "dick," "pussy."[2] *See* Appendix. The Government even allows marks that are "fuck," provided they are misspelled or not spelled out (FCUK (Reg. 2920270); FWORD (75/590854); and WTF IS UP WITH MY LOVE LIFE?! (Reg. 4024774)).

As to excretory words, the Government allows "feces," "poop," "turd," (FAMOUS FECES, 78/315509); POOP (Reg. 2956358); and TURD TOTER (BECAUSE NOBODY WANTS TO SEE YOUR TURD) (Reg. 5397982), even though their meaning is identical to

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[2] The Government refused PUSSY RIOT (87/152598) pending the Court's decision here. Pussy Riot is a musical group fighting for freedom and human rights in Russia, and has been repeatedly mentioned on the American nightly news without causing a scandal. Yet the Government contents the mark is too offensive to be registered.

"shit." The Government also allows "piss" and "urine." (SATAN'S PISS (Reg. 5233724) and URINE OFF (Reg. 2553449)).

The Government approves some sexual terms, for example, "pink taco" (when referring to female genitalia, e.g., PINK TACO FAN CLUB, 77/402098, refused for other reasons), "foreplay," "intercourse" (as in IRISH BY INTERCOURSE (Reg. 4136786)), 69 (when referring to sexual activity as in MILE HIGH 69 (87/718907) and LOOPY SEX GAME 18+ OH 69 (Reg. 5583858)). Although the Government claims it has a content-neutral prohibition of profanity, excretory, and sexual marks, that clearly is not true.

3. Immoral/Scandalous Refusals Are Based Upon Viewpoint.

a. Profanity Expresses Viewpoint.

The Government argues that profanity does not express viewpoint. That is contrary to the unanimous holding of *Tam* that giving offense is viewpoint.

At minimum, use of profanity expresses nonconformance to conventional social mores.

Justice Harlan's reasoning in *Cohen v. California*, 403 U.S. 15 (1971), rejects the contention that profanity does not express viewpoint:

> "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached

> explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which, practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.* at 26.

The Government seeks to distinguish *Cohen* on the basis that the "conviction rested on 'the asserted offensiveness of the *words*.'" Govt. Br. 29. That is no distinction: in both *Cohen* and here, the Government is prohibiting a word (virtually the identical word). As *Cohen* held, words are protected speech. "Thus, we deal here with a conviction resting solely upon 'speech'. . . ." *Cohen*, 403 U.S. at 18.[3]

---

[3] Justice Harlan wrote:

> How is one to distinguish this ["fuck"] from any other offensive word? Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. Yet no readily ascertainable general principle exists for stopping short of that result were we to affirm the judgment below. For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen v. California*, 403 U.S. at 26.

No one who hears George Carlin's *Filthy Words* (often referred to as *Seven Words You Can Never Say on Television*), the subject of *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), can doubt that profanity does express viewpoint. "The words of the Carlin monologue are unquestionably 'speech' within the meaning of the First Amendment." 438 U.S. at 744, 746 (Stevens, J., plurality) (no justice expressed doubt that Carlin's monologue expressed viewpoint).

b. The PTO Inquires into the Applicant's Meaning When Deciding Whether a Mark Is Offensive.

The Government often explicitly considers the applicant's meaning. *See In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1341 (Fed. Cir. 2003) ("it is clear that the marks as used by Boulevard in connection with the services described in Boulevard's application refer to masturbation" and "the applicant's use of the word is clearly limited to the vulgar meaning of the word"); *see In re Hershey*, 6 U.S.P.Q.2d 1470, 1470 (TTAB 1988) (BIG PECKER BRAND not scandalous because of how used).

Compare refused marks: SPECIALIZING IN CELEBRITY HAND JOBS, for manicure services; pedicure services, (85/823860 (refused)), and HANDJOB (77/671044 (refused)) ("the applicant argues that the mark is not immoral or scandalous because it is a play on words suggestive of the services performed by the applicant. This argument, however, is not persuasive

because the term 'hand job' does not have a non-vulgar meaning").

With approved marks: HANDJOB NAILS AND SPA (Reg. 4944424), for day spa services, namely, nail care, manicures, pedicures; BUBBLES CAR WASH BETTER THAN A HAND JOB (86/683666), for car wash (refused only due to likelihood of confusion; examining attorney even referred to the double entendre).

And compare refused mark FAT COCK BEER (85/253332) with approved mark I BRAKE FOR COCK! (Reg. 5677097).

Because the PTO routinely inquires into the applicant's intended meaning before deciding whether a mark is immoral/scandalous, it is unambiguously regulating viewpoint.[4]

c. Immoral/Scandalous Clause Refusals Are Always Based Upon Viewpoint.

On an even broader level, Immoral/Scandalous Clause refusals are always based upon the Government's opinion that the expressed viewpoint is offensive. Marks favorable to religion are allowed, but

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[4] What would happen if a registered mark (such as I BRAKE FOR COCK) is transferred to a new owner who has a different meaning or the registrant had a different meaning)? Does the mark become vulgar? It would seem so. And if so, that means that the registrant's intended meaning is decisive, not the words by themselves. In short, not content-neutral.

marks critical of religion or likely to cause religious controversy are prohibited. Marks that are cheerful and positive (e.g., Smiley Face) are granted, while viewpoints that are negative or controversial (e.g., middle finger-shaped bottle design) are refused. Marks about input into the digestive system are approved, while marks about output are rejected. Polite humor is fine, raunchy humor is scandalous. Raising babies is sweet, making babies is disgusting. Kissing is fine, sex is dirty. Feminism is good, misogyny is bad. The word PENIS is allowed, an outline of a penis is not. Promotion of capitalism is okay, criticism of capitalism is scandalous. *See* marks listed in J.A. 71-75. In all these situations, the Government is preferring certain viewpoints over other, disfavored viewpoints.

B. There Is No "Mode of Expression" Exception to Viewpoint Regulation.

The Government asserts that the Free Speech Clause only protects ideas and not "mode" of expression. It argues that the Immoral/Scandalous Clauses are viewpoint-neutral because, it contends, it is only regulating the "mode of expressing whatever idea the speaker wishes to convey." Govt. Br. at 9, 20, and 27, citing *R.A.V. v. City of St. Paul*, 505 U.S. 377, 393 (1992). This illustrates the danger of an isolated quote. *R.A.V.* involved conduct (cross-burning), not words.

The Government's reliance on a quote from *Cohen* is equally misplaced. Justice Harlan did refer to Cohen's language as a "distasteful mode of expression."

Id. at 21. But the Court held such expression to be protected speech. The Government correctly notes Justice Harlan's distinction between the emotive force of the vulgarity of Cohen's expression from the cognitive force of Cohen's idea. However, contrary to the Government's contention that only the idea is protected, Justice Harlan concluded that both the idea and the mode of expression were protected.

Finally, the Government relies on the plurality (Parts IV-A and IV-B) of *Pacifica*. The Government reads *Pacifica* to say that the offensiveness of expression is grounds to deny Free Speech protection. Justice Stevens wrote in footnote 18 that a "requirement that indecent language be avoided will have its primary effect on the form, rather than the content, of serious communication. There are few, if any, thoughts that cannot be expressed by the use of less offensive language." However, only three justices joined that part of the opinion, and a majority of justices in *Pacifica* did not accept Justice Stevens' views. In any event, *Pacifica* is a time/place/manner case that did not prohibit Carlin's monologue at other times of the day, or in other settings. *Pacifica* is also unique due to the invasiveness of radio and the fact that the airwaves are public property. The Court emphasized the extreme narrowness of its decision.

The Government's reading of Justice Stevens' plurality is contrary to both Justices Alito's and Kennedy's conclusions in *Tam*, that giving offense is viewpoint, as discussed above.

Even under Justice Steven's reasoning, it is difficult to see how Carlin could critique society's views of profanity without using the bad words. A law professor could do that, but undoubtedly the audience would soon stop listening. Carlin's language was intertwined with his message. And if Stevens' view were correct, then Cohen's conviction would have been upheld because he had an alternative mode of expression: PHEWY ON THE DRAFT would have conveyed the same cognitive idea without the profanity. The PTO could also return to refusing disparaging marks because there are other "modes" for Tam to express his pride in his heritage, such as WE ARE PROUD ASIAN-AMERICANS. Brunetti will have to change FRIENDS U CAN'T TRUST to BSOO—BE SKEPTICAL OF OTHERS. In none of these situations is the message exactly the same, i.e., the viewpoint is altered. Nor is there the same force, of which shock and offense plays a role. Nothing in the Free Speech case law suggests that the Government is entitled to force speakers to use bland language. Rather, the Government is claiming the right to require the trademark owners to change their marks or forego the valuable benefits of registration. That violates the First Amendment's prohibition on "governmental control over the content of messages expressed by private individuals." *Turner Broadcasting Sys., Inc. v. FCC*, 512 U.S. 622, 641 (1994). Nor is there anything in the Lanham Act that gives the Government the right to edit trademarks.

The Government cites a law review article that says that trademarks cannot be viewpoint unless they

communicate an "opposable view." There is nothing in this Court's Free Speech jurisprudence that supports such contention and the Government cites none. To the contrary, *Cohen*, *supra*, *Papish v. Board of Curators, Univ. of Missouri*, 410 U.S. 667 (1973); *Hess v. Indiana*, 414 U.S. 105 (1973); and *Lewis v. City of New Orleans*, 415 U.S. 130 (1974), are examples of profanity being protected when it was just profanity.

Is it possible that a brand owner could use profanity as a trademark without any viewpoint? Given the *Tam* holding that giving offense is viewpoint, probably not. But in any event, the record in this case shows that Brunetti has a viewpoint.

C. The Government Conceded that the Clauses Regulate Content. Strict Scrutiny Accordingly Is Required.

Assuming the Clauses are readily susceptible of being limited to PES marks or sexual organs, and further assuming that such limitation were viewpoint neutral, the Government is still regulating content. The Government restricts speech based on content when "a law applies to particular speech because of the topic discussed or the idea or message expressed." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015). To be content neutral the regulation must be "applicable to all speech irrespective of content." *Consolidated Edison Co. v. Public Svc. Comm'n*, 447 U.S. 530, 536 (1980).

The Government acknowledges it is regulating content. Govt. Br. at 25 (claiming that "content-based

distinctions are an inherent and inescapable part of the Lanham Act"). Also, "[t]he government concedes that § 2(a)'s bar on registering immoral or scandalous marks is a content-based restriction on speech. Oral Arg. at 11:57-12:05." Pet. App. 15a.

It follows that, if the Clauses are content-regulation, strict scrutiny is still required by *Reed*, 135 S. Ct. at 2227. Accordingly, Brunetti urges the Court to apply strict scrutiny and hold the Immoral/Scandalous Clauses facially unconstitutional.

D. The Immoral/Scandalous Clauses Do Not Survive Any Level of Scrutiny.

Brunetti contends that *Reed* implicitly overruled or limited *Central Hudson* as to "content-based regulations of speech" because *Reed* applied strict scrutiny to such regulations. *Reed* stated:

> In light of this underinclusiveness, the Town has not met its burden to prove that its Sign Code is narrowly tailored to further a compelling government interest. Because a "law cannot be regarded as protecting an interest of the highest order, and thus as justifying a restriction on truthful speech, when it leaves appreciable damage to that supposedly vital interest unprohibited," the Sign Code fails strict scrutiny. *Reed*, 135 S. Ct. at 2232 (citation omitted).

At minimum, *Reed* implicitly limited *Central Hudson* to purely commercial transactions, such as offers to sell.

However, if the Court determines that intermediate scrutiny is the appropriate level, the Clauses are still unconstitutional.

> Under *Central Hudson*, a restriction of speech must serve "a substantial interest," and it must be "narrowly drawn." This means, among other things, that "[t]he regulatory technique may extend only as far as the interest it serves." *Tam*, 137 S. Ct. at 1764 (Alito, J.) (plurality) (citations omitted, quoting *Central Hudson* at 564-65).

The plurality in *Turner, supra,* required that, in the First Amendment context, Congress must draw reasonable inferences based on substantial evidence. "[W]hen trenching on first amendment interests, even incidentally, the government must be able to adduce either empirical support or at least sound reasoning on behalf of its measures." 512 U.S. at 666 (Kennedy, J., plurality) (citation omitted). Here, the Government advances neither empirical support nor sound reasoning.

Below, the Government struggled to find any substantial interest. The Government referred to "protecting public order and morality." Gov't Letter Br. 15 & n.6, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017). Now, the Government rephrases that as the "government's legitimate interest in protecting the sensibilities of the public." Govt. Br. 32. However,

> the government's general interest in protecting the public from marks it deems "offputting," whether to protect the general public or the government itself, is not a substantial interest justifying broad suppression of speech. "[T]he fact that society may find speech offensive is not a sufficient reason for suppressing it." *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983) ("At least where obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression.") Pet. App. 34a.

The Government does not have a substantial interest in promoting trademarks it "has deemed to be most suitable" (Pet. App. 33a), or "trademarks that are appropriate for all audiences, including children." (Govt. Br. 33). If it did have such interest, then the Government has spectacularly failed in the trademark context. *See Brief of* Amicus Curiae *Pro-Football, Inc.*, in *Tam*, and its appendix with 18 pages of offensive marks that the Government has registered. Even if offensive trademarks are registered, that will not turn the clock back to the days of *My Three Sons*.

The Government also refers to the orderly flow of commerce. Govt. Br. 33-34. The Government offers no support for its claim that the refused marks are less capable of source-identification or make commercial transactions less efficient. "[T]he government has failed to articulate how this interest is in any way advanced by the immoral or scandalous prohibition, or

how that provision is narrowly tailored to that interest." Pet. App. 32a n.4. Nor is there any factual basis: no FedEx pilots have refused to fly because Brunetti's products were on board, no mall has been closed because Brunetti's products were offered there. Customers are able to distinguish FUCT products from NIKE products.

Offense to UPTO examining attorneys is not a substantial government interest because the examiners have to view the trademarks in order to refuse or approve them.

Preventing government association (Govt. Br. 34) does not have a factual basis and is not a substantial government interest. *See* Part III-C. The Government's argument that trademarks are "inherently commercial in nature" (Govt. Br. 36) is not a government interest.

Even if there were some substantial governmental interest, the Immoral/Scandalous Clauses are not narrowly drawn. Nor are the Clauses likely to advance the alleged interest because, as the Government argues elsewhere, the trademark owners can use their trademarks in any event (it is just that such use is unconstitutionally burdened). Finally, less restrictive means exist, such as requiring a disclaimer on registration certificates, or imposing login and age verification to view offensive marks on the PTO website.

The Immoral/Scandalous Clauses cannot survive any applicable level of scrutiny.

II. THE IMMORAL/SCANDALOUS CLAUSES ARE NOT SUBJECT TO REDUCED SCRUTINY

The Government advances a number of argument leases why the Immoral/Scandalous Clauses are subject to lesser scrutiny under the Free Speech Clause. All of these were implicitly rejected by the Court in *Tam*, otherwise, the Court would not have invalidated the Disparagement Clause.

A. Trademark Registration Is a Registration System.

The PTO never asserted prior to *Tam* that trademark registration was government speech, government association, government program, government subsidy, or a government-created forum. The reason is that none of those concepts are applicable to federal trademark registrations.

Although it sounds like a tautology, trademark registration is a system of registration. It confers legal recognition and rights.

> [A] registered trademark redefines the nature of the markholder's rights as against the rights of other citizens, depriving others of their ability to use the mark. Like the programs in *Bullfrog* and *Texas Lottery Commission*, the system of trademark registration is a regulatory regime, not a government subsidy program. *In re Tam*, 808 F.3d 1321, 1353 (Fed. Cir. 2015).

The Principal and Supplemental Registers, created by the Lanham Act, are databases created to list the holders of rights.[5]

The Government has many other databases: non-profit organizations (Tax Exempt Organization Search, Internal Revenue Service), names of vessels (National Vessel Documentation Center, U.S. Coast Guard), motor carriers names (Unified Registration System, Federal Motor Carrier Safety Administration), names of drugs (Drugs@FDA Data Files, Food & Drug Administration), and names of businesses approved for Government contracts (System for Award Management, Department of Transportation).

It is preposterous to contend that government registration converts the name of every vessel, non-profit, drug, and contractor into something that the Government may prohibit with minimal constitutional scrutiny.

B. The Lanham Act Does Not Create a Forum.

The Government claims the Court of Appeals erred in failing to consider cases involving forums. Govt. Br. 41.

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[5] The Court of Appeals noted that "[a]part from its function as a database, the government has been unable to define exactly what the principal register is, or where it is located." Pet. App. 28a.

Forums are places "for expressive activity." *Perry Ed. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45 (1983). In contrast, the Principal and Supplemental Registers are not forums for discussion. Rather they are databases of trademarks that meet the statutory criteria and paid the required fee. Analogously, the records of the Copyright Office constitute a database, not a forum.

The Court of Appeals is correct:

> "The government fails to articulate a reason why the government's listing of registered trademarks in a database creates a limited public forum. And if it did then every government registration program including titles to land, registration of cars, registration of wills or estates, copyrights, even marriage licenses could similarly implicate a limited public forum. We thus conclude that government registration of trademarks does not create a limited public forum in which the government can more freely restrict speech." Pet. App. 28a.

C. Government Association Is Not a Basis for Lesser Scrutiny.

The Government claims it has a "legitimate interest in avoiding any appearance that the government approves such marks." Govt. Br. 34. It claims that "the public may still perceive that association [federal registration and specifically ®] as evidence of government approval. . . ." *Id.* at 35.

This is a weakened version of the government speech argument unanimously rejected in *Tam*. Private speech cannot be converted into government speech "by simply affixing a government seal of approval." *Tam*, 137 S. Ct. at 1758. "[T]here is no evidence that the public associates the contents of trademarks with the Federal Government." *Id.*

> The PTO has made it clear that registration does not constitute approval of a mark. "[I]ssuance of a trademark registration . . . is not a government imprimatur." And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means. "The purchasing public knows no more about trademark registrations than a man walking down the street in a strange city knows about legal title to the land and buildings he passes." *Tam*, 137 S. Ct. at 1759 (Alito, J.) (citations omitted).

If ® equates to government approval, then virtually the entire American economy is "approved" by the Government because most products (including books, magazines, newspapers, and movies) bear registered trademarks. And, if the Government were correct, all copyrighted works bearing © are perceived by the public as Government approved.

Furthermore, the Government could easily avoid the alleged association by including a disclaimer. Notably, after *Tam*, the Government did not bother to add a disclaimer to Tam's registration certificate.

D. Trademark Registration Is Not a Government Subsidy.

The Government contends that the Clauses are entitled to relaxed Free Speech scrutiny because it asserts that trademark registration is a government subsidy.

There is nothing in the legislative history of the Lanham Act suggesting that Congress intended the trademark registration system to subsidize trademarks. And, since 1991, the PTO has been self-supported by user fees. *In re Tam*, 808 F.3d at 1353.

Justice Alito explicitly rejected the subsidy argument, saying "no difficult question is presented here." *Tam*, 137 S. Ct. at 1761 (plurality). Trademark registration does not involve "cash subsidies or their equivalent." *Id.* The Government is not spending money at all, except possibly incidentally. *See also In re Tam*, 808 F.3d at 1351 ("the subsidy cases have all involved government funding or government property.").

The Government reads Justice Kennedy's opinion as limiting the rejection of the subsidy contention only to viewpoint discrimination. Although he prefaces his discussion with a reference to viewpoint discrimination, that is not relevant to whether registration is a government subsidy. Either the entire system of trademark registration is a subsidy for all marks (both those with viewpoint and those without) or it is not. Justice Kennedy wrote that the subsidy issue "may turn on whether certain commercial concerns for the protections of trademarks might, as a general rule, be the

basis for the regulation." *Tam*, 137 S. Ct. at 1767 (Kennedy, J.). If preventing consumer confusion and protecting brand owners are the purposes of the Lanham Act (which they clearly are), as distinguished from a statute whose purpose is to subsidize favored speech, then trademark registration is not a government subsidy.

Is *Tam* a binding precedent on this issue? Which is narrowest, not a subsidy (Alito, J.) or not reaching the issue at all (Kennedy, J.)? *Marks* provides no answer. Brunetti contends that logically the subsidy issue, as a preliminary question, has to be decided before the level of scrutiny, since the latter assumes that there is no subsidy. If so, then Justice Alito's opinion is narrowest and the binding precedent on the subsidy issue.

If *Tam* did not decide the issue, then this Court should follow Justice Alito's opinion as persuasive.[6]

E. No Government Program Exception Applies.

The Government claims it only "imposes a condition on the availability of a government benefit." Govt.

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[6] Even if trademark registration were a government subsidy, the Government is seeking to improperly "leverage its power to award subsidies on the basis of subjective criteria into a penalty on disfavored viewpoints." *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 585, 587 (1998). *See also Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech").

Br. 20. The Government argues that the Court of Appeals ignored *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009), and *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007). The Court of Appeals had discussed these cases in *Tam*, 808 F.3d at 1351. However, the Government chose not to cite these cases in this case until its petition for a rehearing *en banc*, which was denied without opinion. So there was no reason for the Court of Appeals to discuss these cases or the Government's theory.

Besides, those cases involve "the unique context of public-sector agency-shop arrangements," where the Government, as employer, "act[s] in a capacity other than as regulator." *Davenport*, 551 U.S. at 188, 190.

The Government quotes Justice Alito on the point that governments may "confer a substantial non-cash benefit." 137 S. Ct. at 1762, *cited in* Govt. Br. 43. However, the Government ignores Part III-C of Justice Alito's plurality opinion, which correctly rejects the Government's "government program" theory. He wrote that these cases are "far removed from the registration of trademarks." *Tam*, 137 S. Ct. at 1762. He concluded, "*Davenport* and *Ysursa* are no more relevant for present purposes than the subsidy case previously discussed." *Id.*

Is Justice Alito's opinion a binding precedent under *Marks*? The analysis is the same as discussed above. And if Justice Alito's opinion is not a binding precedent, then his analysis should be followed.

F. The Immoral/Scandalous Clauses Do More Than "Deny Benefits of Federal Trademark Registration"; They Unconstitutionally Burden Speech.

The Government asserts that "the sole effect" of the Clauses is "to deny respondent the benefits of federal trademark registration" and that they do not ban any speech. Govt. Br. 19. The Government correctly asserts that denial of registration does not prohibit Brunetti from using his mark. But that misses the point.

The *Tam* Court recognized that "[f]ederal registration, however, 'confers important legal rights and benefits on trademark owners who register their marks.'" 137 S. Ct. at 1753. Part I-B of *Tam* listed many of the vitally important benefits granted by federal registration. Other important consequences of the denial of registration include the reluctance of law enforcement to take action against counterfeiters and the difficulty of obtaining the cooperation of online shopping platforms to remove counterfeits. *See, e.g., Brief of* Amicus Curiae *San Francisco Dykes on Bikes* in *Tam* at 3. The lack of a registration significantly impacts the ability to sell a brand (because there is no proof of ownership of the mark) or to obtain financing (because federal recordal of a security interest is not possible).

G. Commercial Speech Is No Exception to the Free Speech Clause.

The Government asserts that a "trademark is inherently commercial in nature, since its 'predominant function' is to identify a mark owner's company as the source of goods in commerce." Govt. Br. 36. The Government implies that removes the Immoral/Scandalous Clauses from Free Speech analysis.

The Government confuses "used in commerce" with "commercial speech." To be federally registered, trademarks have to be used in commerce regulated by Congress (with exceptions not relevant here). Many trademarks are non-commercial, such as those used by advocacy groups, churches, non-profits, and political groups. The Government then makes the further incorrect assumption that trademarks do not convey messages. That may have been true two hundred years ago when silversmiths used simple marks. But that is no longer true. As stated in Part I-A of Justice Alito's opinion (joined by all eight members): "[T]rademarks often consisted of catchy phrases that convey a message." *Tam*, 137 S. Ct. at 1752.[7] Today, trademarks are used for more than just commercial goods. They are used for blogs, charitable fundraising, entertainment services,

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[7] Justice Alito declined to decide whether "all trademarks are commercial speech" or "many, if not all, trademarks have an expressive component." 137 S. Ct. at 1764. He stated that "[w]e need not resolve this debate between the parties because the disparagement clause cannot withstand even *Central Hudson* review." *Id.* However, there is little doubt that the Court agreed that trademarks are expression. *See, e.g.*, 137 S. Ct. at 1759 n.10-14.

information services, posters, promoting public awareness, social networking, websites featuring views, etc.

It cannot be disputed that many trademarks convey messages. Some marks involve core speech about politics, religion, and society: ABORTION MUST END NOW; AMBULANCE CHASERS SUCK; BLACK LIVES MATTER TO ME; DEMOCRATS ARE THE PARTY OF WE REPUBLICANS ARE THE PARTY OF ME; GOD DOES NOT HAVE A PENIS; GUN CONTROL MY ASS. . . . ; LEGALIZE ACID; MAKE AMERICA GREAT AGAIN; PETA CRUELTY FREE; RELIGIOUS COALITION FOR ABORTION RIGHTS; THANK YOU FOR POT SMOKING, and countless more.

But even if the Government's contention had merit, purely commercial speech (such as that which merely proposes a business transaction) is entitled to at least intermediate scrutiny.

III. THE IMMORAL/SCANDALOUS CLAUSES ARE UNCONSTITUTIONALLY VAGUE

The Due Process Clause "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). There are two reasons:

> [F]irst, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory

> way. . . . When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech. *Id.*

"Vague laws force potential speakers to steer far wider of the unlawful zone . . . than if the boundaries of the forbidden areas were clearly marked." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 807 (2011) (Alito, J., concurring) (citation and internal quotation marks omitted).

Vague speech restrictions do not just chill speech, they cause discriminatory enforcement because a "vague law impermissibly delegates basic policy matters" to low-level decision-makers "for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application." *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972).

A. This Court Has for Good Reason Expressed Concern About the Vagueness of Section 2(a).

The *Tam* Court's concern about the vagueness of the Disparagement Clause applies equally here.

The PTO has acknowledged that the guidelines "for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one." 137 S. Ct. at 1756-57.

The PTO has similarly observed that whether a mark is disparaging "is highly subjective and, thus, general rules are difficult to postulate." *Id.* at n.5 (citation omitted). *See also Tam*, 808 F.3d at 1341-44. Footnote 6 discusses the recognition of this problem even in the hearings on what became the Lanham Act. *See especially* Judge O'Malley's concurring opinion.

B. The Government Cannot Agree What the Immoral/Scandalous Clauses Cover.

Attorneys from both the Departments of Commerce and Justice are on the briefs in this Court. If Commerce and Justice cannot agree on what the Immoral and Scandalous Clauses cover, obviously the general public is not given fair notice of what is prohibited.

1. Department of Commerce Interpretation: Vulgar, Lacking in Taste

The Department of Commerce (i.e., the PTO) asserts that *seven* categories of marks are refused under the Scandalous Clause:

> "*inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. The statutory language "scandalous" has also been considered to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude." TMEP § 1203.01 (2018) (citations omitted).

The case law adds *four* additional phrases:

> To be considered "scandalous," a mark must be "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; . . . *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

Additionally, immoral marks are refused under the Immoral Clause, although no one seems to know how immoral differs from scandalous. "Although the words 'immoral' and 'scandalous' may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter." TMEP § 1203.01 (2018).

Rather than providing clarity, this flood of definitions amplifies the uncertainty about what is prohibited.

2. Department of Justice Interpretation: Profanity, Excretory, Sexual.

The Department of Justice has a completely different interpretation of what is covered by the Scandalous Clause. In the Court of Appeals, the Government claimed the Clause was only content regulation because, supposedly, the Clause only prohibited profanity, excretory and sexual matter. Govt. Ltr. Brief, July 20, 2017 (Docket 60) at 7, 14.

In its merits brief, the Government chooses not to define "scandalous" at all, implicitly abandoning its PES construction. Instead, it inconsistently refers to

sexual activity, explicit imagery and sexual organs. To be fair, the Government does occasionally mention profanity and vulgar marks, but they are not the primary focus of the Government's arguments.

Brunetti agrees that obscene marks can be refused registration because they are subject to minimal or no First Amendment protection. Nor could such marks be legally used in commerce regulated by Congress.[8]

3. The Clauses Are Not Readily Susceptible to the Department of Justice's Interpretation.

The Government's proffered re-interpretations of the Clauses should not be adopted by this Court. "As always, our inquiry into the meaning of the statute's text ceases when 'the statutory language is unambiguous and the statutory scheme is coherent and consistent.'" *Tam*, 137 S. Ct. at 1748, quoting *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002). A court "may impose a limiting construction on a statute only

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[8] Brunetti's mark is not obscene, i.e., hardcore pornography. His mark does not appeal to the prurient interest. It does not depict or describe in an offensive way sexual conduct or excretory functions as specifically defined by law. (The Clauses do not specifically define anything). Brunetti contends that his brand (of which his mark is inextricably intertwined) conveys serious political and social commentary. None of the elements required by *Miller v. California*, 413 U.S. 15 (1973) are present. The Government seems to argue that Brunetti's mark, although not obscene, can be regulated as if it were. That would undercut *Miller*. It is difficult to see how a trademark could be obscene unless it is either a photograph or an explicit drawing.

if it is readily susceptible to such a construction." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 884 (1997) (citation and internal quotation marks omitted). The first time the Government suggested the PES construction was in 2017, after this Court's ruling in *Tam*. Obviously, if no one in seventy years thought the statute was so limited, it is not readily susceptible of being construed as only applying to PES marks.

If the Clauses apply only to sexual activities/explicit imagery/organs, they are even further removed from the statutory language. And, in any event, such interpretation is irrelevant because Brunetti's mark is not sexual activities/explicit imagery/organs.

C. The Clauses Are Inconsistently Applied.

The chart submitted in the Court of Appeals shows the PTO's contradictory and arbitrary application of the Clauses. *See* Appendix A to Letter Brief (Docket 70), filed August 9, 2017 (J.A. 71-75). *See also* Appendix to this brief. These appendices prove unconstitutional vagueness of the Clauses.

The Government defends its inconsistencies as occasional mistakes by an overworked agency. First, when there is a danger of chilling speech, that is no excuse. A vague law that regulates speech on the basis of message "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno, supra*, 521 U.S. at 871-72.

Second, while the PTO may handle 400,000 applications per year, it appears that the number of applications refused due to the Clauses have been a few dozen per year. *See* Megan M. Carpenter and Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENTER. L.J. 321, 322 (found 232 trademark applications were refused based upon the Clauses from 2001 to 2011; because of the limitations on searching the PTO database the actual number could be higher.) Even if the actual number is an order of magnitude greater, one examining attorney could handle all such applications (most handle several dozen applications per week) and could ensure consistency if consistency were possible.

Third, consistency is not possible. These Clauses have been in effect for seventy years and there still is no method to ensure consistency. *In re Tam*, 808 F.3d at 1342 n.7 ("The PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency.")

Is there a method of ensuring consistency? For example, could there be a list of prohibited words? George Carlin was able to come up with a list, why not the Government? The Government cannot create such a list because many words would be in both the allowed and the prohibited columns. *See* Appendix to this brief, with Carlin's seven words and another list of profane words. Three words are always approved, seven are both approved and refused. Two are never approved. One was approved, then approval withdrawn. Inconsistency is far more common than consistency.

"Marks with salient terms ANAL, ASS, COCK, CUM, FAG, MILF, PENIS, SLUT and WHORE are other examples of marks that were both approved and rejected." *See also* Carpenter & Garner, at 358-59. Other examples of words that are inconsistently evaluated by the PTO include 420 (referring to marijuana), BALLS, BANGERS/Z, BLUEBALL(S), COCAINE, DAMN, DOUCHE, HAND JOB, MASTURBATION, MUFF, NAZI, NOOKIE, POON, SNATCH, and TAINT. In Anne Gilson LaLonde and Jerome Gilson, *Trademarks Laid Bare: Marks That May be Scandalous or Immoral*, 101 Trademark Rptr. 1476, 1478 (2011), they note the term MILF was approved twenty times, and was refused twenty times![9]

The *Brief of* Amicus Curiae *San Francisco Dykes on Bikes*, in *Tam*, at 4-5, describes how even after its mark was registered, the Government continued to refuse the same mark.

Of the thirty-four words mentioned in this Part and the Appendix, only three have been refused consistently. So the PTO's record is about 9% consistent refusal and over 90% always allowed or inconsistent. If the PTO were inconsistent 1% or 5% of the time, it might be able to say it makes an occasional mistake,

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[9] LaLonde and Gilson noted "one must admire the diligent examining attorney who did not raise a scandalousness refusal but instead required the applicant for MILF HUNTER to disclaim the word MILF because '[t]he applicant's adult entertainment will feature MILFs.'" *Id.* at 1482.

although it is still chilling speech. But when the PTO either allows the words or is inconsistent over 90% of the time, the facial invalidity is incontrovertible.

D. Immoral Is Not Capable of Being Defined Without the Government Taking Sides.

Although the Government avoids discussing the Immoral Clause, the Court should not. What is "immoral"? Many persons believe abortion is immoral, while others consider the denial of free access to abortion to be immoral. But there are many registrations on both sides. Alcoholic beverages and smoking are immoral for some. Prostitution is widely regarded as immoral. Yet registrations for all are allowed. WORLD FAMOUS BROTHEL (Reg. 3238218). Some people believe it is immoral to use the Lord's name for commercial purposes. Yet JESUS JAM THE FRUIT OF LIFE for jams (Reg. 328207) and JESUS PEN for pens (Reg. 2509259) were registered. ATHEIST, ATHEISM, DEVIL, and WICCAN are all registered even though anathema to many Christians. Does the PTO decide which religious sects are offensive because other sects consider them to be heretical? What about JEWS FOR JESUS (Reg. 3226872) or JESUS DARWIN (S/N 77/090538)? Those are clearly offensive to some people. GOD DOES NOT HAVE A PENIS for series of books in the field of spirituality was refused. Implicitly the PTO has decided this theological question by refusing the application. The Immoral/Scandalous Clauses not

only infringe Free Speech, but raise other troublesome First Amendment issues.

E. Excessive Discretion Given to Government Employees.

The excessive discretion given to government employees is illustrated by this case. The examining attorney reviewed Brunetti's application multiple times before approving it. The law office manager approved the application. Even publication review was completed without a refusal. It was only afterwards that some unnamed PTO official decided to withdraw the application from publication and return it to the examining attorney with instructions to refuse the application.

Anne Gilson LaLonde and Jerome Gilson noted that PTO determinations are made by "dozens of different individuals of varying political, religious, geographic and family backgrounds." LaLonde and Gilson, *supra*, 1477.

As noted in *Cohen*, "it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." 403 U.S. at 25.

F. The Scandalous Clause Is Over-Inclusive.

The PTO states that: "[T]here is no requirement in Section 2(a) that a mark's vulgar meaning must be the only relevant meaning, or even the most relevant

meaning." TMEP § 1203.01. Humor is no defense: "[W]hether some people would actually find it to be humorous, is immaterial." A "double entendre falls within the proscription of the Scandalous Clause." *Id.* Even if the goods or services are for adults, the mark is refused. *In re Boulevard Entm't, Inc.*, 334 F.3d 1136, 1340 (Fed. Cir. 2003) (1-800-JACK-OFF refused for adult services). Assuming that "public morals," "taste" or shielding children are governmental interests, such interests cannot be advanced in this context.

The Clause is not narrowly drawn.

G. The Lack of a Definition of the Offended Population Compounds the Vagueness.

To counsel's knowledge, *never* has the PTO or any court said what percent of the public must be offended. It is "not necessarily a majority." TMEP § 1203.01. "[W]e recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints. . . ." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

From the case law, it is clear that even a very small percentage of the population is sufficient to refuse registration. *In re Reemstsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (refused registration of SENUSSI as being scandalous to the Senussi order of Islam in Libya and Sudan). The Muslim population of the United States in 1960 was 0.13% of the total population. Houssain Kettani, *Muslim*

Population in the Americas, 1950-2020, 1 INTL. J. ENVIR. SCI. DEV. 20 (2010). Sufism is one of the smaller branches of Islam. And the Senussi order is only one of the dozen orders of Sufism. Whatever the American population of Senussis was in 1959, it was extremely small, likely far less than 0.001%. Yet, possible offense to that small number was enough to refuse registration.

In any event, to give such a minority a veto cannot be consistent with free speech. It is the "heckler's veto."

H. The PTO's Lack of a Clear Evidentiary Standard Adds to Vagueness.

Somehow, the PTO "knows" that a mark is scandalous. In other areas of trademark law, such as proving likelihood of confusion, surveys are frequently used. "Of course, the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under Sec. 1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public." *Mavety*, 33 F.3d at 1374. Despite this explicit invitation, to Brunetti's knowledge, the PTO has *never* relied on any survey as to the offensiveness of a mark.

The PTO is positively hostile to any actual evidence, as this case illustrates. It disregarded Brunetti's evidence of lack of offense (that only one person in more than two decades complained). Instead the PTO mostly relies on dictionaries. And the PTO also relies on information that cannot be dignified with the term

"evidence," such as the *Urban Dictionary*, which is the "dictionary you write." J.A. 67-70. Anonymous persons can post definitions. If the *Urban Dictionary* is valid evidence, then any disgruntled employee could "define" his employer's brand as profane and that trademark would be refused registration. Yet, the *Urban Dictionary* was an important part of the evidence against Brunetti's mark. Pet. App. 7a.

The PTO's policy of relying on unreliable evidence, its lack of any evidence of actual consumer perception, while ignoring the more probative evidence, contributes to the chilling environment created by the PTO's irrational and inconsistent application of the Immoral/Scandalous Clauses.

IV. IMPLICATIONS OF THE COURT'S RULING ON THE IMMORAL/SCANDALOUS CLAUSES

A. Implications if the Clauses Are Held Unconstitutional.

None of the effects imagined by the Government justify ignoring the facial unconstitutionality of the Immoral/Scandalous Clauses.

The Government's focus on "sexually explicit" material misses the point. Obscene marks may be refused registration. Brunetti's mark is not obscene.

Registration of marks does not require that any store carry such products or that anyone purchase such products. The marketplace will not be flooded

with vulgar marks. Retailers will still decide what products are appropriate for their customers.

This case will not affect time/place/manner regulation. Trademark registration is refused for all times/places/manners, for all goods and services, and for all channels of trade.

As discussed in Part III-E, the trademark registration system is not a forum so the decision here will not affect the jurisprudence about forums. For example, cemeteries and buses are still non-public or limited forums.

The Free Speech Clause should not be constrained by the possible embarrassment of the Government or by foreign sensibilities. In any event, Madrid Protocol applications can be based upon U.S. applications (not registrations) and the PTO transmits the Madrid applications long before the Government examines the U.S. application. That foreign governments may refuse similar marks under various treaties, and in fact do so, has no relevance to the Free Speech Clause in this country. Other countries clearly have different understandings of free speech (for example, fascist symbols are prohibited in several European countries even though they constitute protected expression in the United States).

The Court should decline the Government's invitation to speculate about the constitutionality of other Lanham Act provisions, which are not involved here, nor briefed. In any event, this case does not broaden the holding in *Tam* but merely applies it.

B. Implications if the Immoral/Scandalous Clauses Were Constitutional.

If the Clauses are not facially invalid, then the Federal Circuit will have to hear as-applied challenges since the Board refuses to consider them. *Trademark Trial and Appeal Board Manual of Procedure* § 102.01 n.4 (2018) ("no authority to rule on the constitutionality of the Trademark Act on its face or as applied").

Holding the Immoral/Scandalous Clauses constitutional would effectively negate the invalidation of the Disparagement Clause in *Tam*. In the present day, any ethnic slur causes scandal. Any mark now allowed due to the invalidation of the Disparagement Clause would still have to be refused as scandalous if the Immoral/Scandalous Clauses are constitutional.

It also follows that the Government could constitutionally refuse registration of copyright for immoral and scandalous works. Although the constitutional bases for copyright and trademark are different, there are many similarities. Registration for both is optional, although a precondition for effective enforcement by the rights owner. Copyrights range from the purely commercial (advertisements, the 0's and 1's of software) to core speech. Likewise, trademarks range from purely commercial (e.g., EXXON) to core speech such as STOP THE ISLAMISATION OF AMERICA.

The Government offers the distinction that, in copyright, the creative works are the goods, while trademarks are a source identifier. That is a meaningless distinction. The issue is whether speech is being

restricted. It should not matter how speech is restricted: by restricting the goods or restricting the trademark which in turn restricts the goods. It would follow that the Government could constitutionally refuse to register a copyrighted work if the title were offensive.

What else could the Government lawfully prohibit if the Clauses were constitutional? The Government could refuse to register names of vessels, and refuse to recognize names for non-profits or political organizations (it is easy to see that some organization names would be immoral or scandalous to portions of the public). State and local governments could refuse to register names for businesses or organizations, advocating unpopular goals.

Another consequence if the Clauses were constitutional is that state and local governments could refuse to grant building permits, charitable solicitation registrations, business licenses, or sales tax permits on similar grounds. They could effectively prevent unpopular organizations from advancing controversial causes (if the names were scandalous to some portion of the public). It is easy to foresee that some localities will seek to suppress Planned Parenthood, while others may seek to impair the activities of pro-life groups or the Second Amendment Foundation.[10]

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[10] If the Clauses are constitutional, could local governments ban the sale of Brunetti's products or REDSKINS merchandise on the grounds they are scandalous? What about products that are themselves scandalous?

This is no hypothetical concern. *See, e.g.*, *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981) (unconstitutional to require, as condition for grant of a building permit, that a restaurant change its name from SAMBO'S); *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998) (New York alcohol board's rejection of label with frog raising a middle finger held to be an unconstitutional restriction on commercial speech); *Kalman v. Cortes*, 723 F.Supp.2d 766 (E.D. Pa. 2010) (Pennsylvania's refusal to accept I CHOOSE HELL PRODUCTIONS, LLC as an entity name was an unconstitutional viewpoint-based restriction on speech).

Finally, the Immoral/Scandalous Clauses undermine trademark owners' established rights. Under Section 15, 15 U.S.C. § 1065, allegedly immoral or scandalous marks are *always subject* to cancellation. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005) (laches applies, but can be avoided by selecting a petitioner who just turned 18). *See also Brief of* Amicus Curiae *Pro-Football, Inc.* in *Tam* at 29-35.[11]

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[11] What happens if a mark is registered but becomes scandalous because of changing attitudes about, for example, the Confederacy and its leaders, or preferred ethnic names? *E.g.*, ESKIMO PIE (Reg. 4973104); JEFFERSON DAVIS INN (Reg. 4482318), RUNNIN' REBELS (Reg. 1731224) (https://en.wikipedia.org/wiki/Hey_Reb!, last accessed March 15, 2019); SONS OF CONFEDERATE VETERANS 1896 (with Confederate flag) (Reg. 2764268); or WASHINGTON & LEE UNIVERSITY (Reg. 2020928). Even if the registrations themselves cannot be invalidated, the brand owner cannot obtain registrations for new types

V. THE COURT SHOULD RETURN TO THE COMMON LAW RULE AND DISAVOW THE *MARKS* RULE

The *Marks* Rule is logically flawed. It does not provide clear guidance in many cases, including this one. The *Marks* decision is a weak precedent because it was not reasoned and ignored the common law. This Court has found the Rule not "useful."[12]

In recent years, this Court has failed to follow the Rule (that is why Brunetti uses "disavow" rather than "overrule").

As the argument in *Hughes v. United States*, 138 S. Ct. 1765 (2018), illustrated, the Court is aware of the problems created by the Rule, but concerned about what would replace the Rule. Brunetti suggests that the Court should return to the common law rule for *stare decisis*: a majority on the judgment and majority on the reasoning (hereinafter referred to as the Dual-Majority maxim).[13]

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of products, updated versions of the mark, or file again if it failed to renew a registration.

[12] *See Nichols v. United States*, 511 U.S. 738, 746 (1994).

[13] Brunetti proposes Dual-Majority as an unambiguous term for the common law rule for *stare decisis*: majority on the judgment and majority on the reasoning. Note that the term "dual majority" has been used to refer to a majority that includes the reasoning of dissenting opinion. *See, e.g.*, Bryan A. Garner, et al., *The Law of Judicial Precedent* 207 (2016). Only the former meaning, always with initial capitals, is used herein.

A. Under the Common Law, Only Majority Opinions are Precedential.

The common law rule is that, "[i]f all or a majority of the judges concur in the result but differ as to the reasons which lead them to this conclusion, the case is not an authority except upon the general result." Henry Campbell Black, *Handbook on the Law of Judicial Precedents or the Science of Case Law* (1912) at 135-36 (parenthetical omitted).

> "There must be a concurrence of a majority of the judges upon the principles, rules of law, announced in the case, before they can be considered settled by a decision. If the court be equally divided or less than a majority concur in a rule, no one will claim that it has the force of the authority of the court." *City of Dubuque v. Ill. Central R. Co.*, 39 Iowa 56, 80 (1874).

Comment, *Supreme Court No-Clear-Majority Decisions: A Study in Stare Decisis*, 24 CHI. L. REV. 99 (1956), makes an exhaustive analysis of this Court's no-clear-majority cases between 1900 and 1956. A fair summary of the author's conclusions is that no-clear-majority cases were cited and relied upon, but often without consideration of the fact that they were minority opinions. There seems to be little authority pre-*Marks* that minority opinions, *when the precedential value of the minority opinion was actually considered by the citing court*, establish binding precedents.

See also Richard M. Re, *Beyond the Marks* Rule, HARV. L. REV. 6 n.26 (forthcoming 2019) (*available at*

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3090620); Ryan C. Williams, *Questioning* Marks: *Plurality Decisions and Precedential Constraint*, 69 STANFORD L. REV. 795, 806 n.44, 845 n.239 (2017); Mark Alan Thurmon, Note, *When The Court Divides: Reconsidering the Precedential Value of Supreme Court Plurality Decisions*, 42 DUKE L.J. 419 (1992).

B. The *Marks* Rule Is Logically Flawed.

1. If Four Votes Are Not Enough, Then Fewer Votes Must Be Weaker.

The traditional rule is that the decision of an evenly divided court is without precedential effect. In that situation, the Court would remand *per curiam*.

> Nor was our affirmance of the judgment in that case by an equally divided court an authoritative precedent. While it was conclusive and binding upon the parties as respects that controversy, the lack of an agreement by a majority of the Court on the principles of law involved prevents it from being an authoritative determination for other cases. *United States v. Pink*, 315 U.S. 203 (1942) (citations omitted).

If four-to-four is without precedential effect as to the reasoning, how can an opinion joined by only three (or less) members have more weight?

The *Marks* Rule goes even further and can convert the opinion of a single member into a binding precedent. Some courts of appeals concluded that the *Marks* Rule made Justice Sotomayor's opinion in *Freeman v.*

United States, 564 U.S. 522 (2011), *not followed, Hughes, supra*, into a binding precedent.

2. Explicit Disagreement Is Converted into Implied Agreement by *Marks*.

The *Marks* Rule creates an irrefutable presumption that the other members concurring in the judgment impliedly concurred in whichever opinion is narrowest. In effect, *Marks* requires each member to give a blanket proxy to concur in whatever opinion is narrowest when there is no majority opinion. Even if the members in 1977 were willing to grant such implied proxy, it is doubtful that the current members wish to do so.

This is even less logical when the members explicitly refuse to concur. For example, in *Tam*, Justices Alito and Kennedy expressly refused to agree with the other concerning the level of scrutiny. Yet, under *Marks*, one opinion *has to be* the binding precedent.

A rule that converts a failure to agree, or even express disagreement, into implied agreement, is not logical.

C. The *Marks* Rule Is Anti-Majoritarian.

Collective bodies speak through majorities. An unquestioned assumption of American democracy is that it takes a majority to make law. It has never been suggested that, if a majority of a house of Congress agrees some bill should be passed but no single version has an

absolute majority, that the narrowest bill is "passed." As to the election of the President, "The person having the greatest number of votes for President, shall be the President, *if such number be a majority* of the whole number of Electors appointed. . . ." Constitution, Twelfth Amendment (emphasis added).

In the judiciary, the principle of majority rule is so fundamental that it is rarely expressed. Professor Amar writes: "From its first day to the present day, the [Supreme] Court has routinely followed the majority-rule principle without even appearing to give the matter much thought." Akhil Reed Amar, *America's Unwritten Constitution: The Precedents and Principles We Live By* (2012) at 360. He gives four reasons why "simple majority rule as the master norm among the justices. . . ." *Id.* at 357-60.

Since the Judiciary Act of 1869, Act of April 10, 1869, ch. 22, 16 Stat. 44, the number of justices has been set at nine. Courts of appeals decide (except *en banc* hearings) in panels of three. 28 U.S.C. § 46(c). Certain types of constitutional questions are heard in district court by three judges. 28 U.S.C. § 2284(a). Every single state supreme court has an odd number of justices. These are not coincidences; rather they reflect the fundamental assumption that cases should be decided by a majority and an odd number normally ensures a majority.

The exceptions to majority decision-making in this Court are certain powers granted to the Chief Justice,

or individual justices, or for granting certiorari. None of those situations are precedential.

D. The *Marks* Rule Is Not a Rule Because It Does Not Provide Answers.

Which is taller, left or right? Which is narrowest, government speech or strict scrutiny? Is "does not satisfy intermediate scrutiny" narrower than "the standard is exactly heightened scrutiny"? The *Marks* Rule fails as a useful maxim of judicial interpretation because often it is not clear what is "narrowest."

What is "narrowest" can be a function of how the question is presented. An example is Justice Stevens' claim in *Rapanos v. United States*, 547 U.S. 715, 810 n.14 (2006), that less-restrictive on federal jurisdiction was "narrowest." *See United States v. Robertson*, 875 F.3d 1281, 1292 (9th Cir. 2017). Actually, "narrowest" should be less-restrictive on the public (i.e., less federal jurisdiction). But assuming Justice Stevens' interpretation is plausible, the arbitrary phrasing of the question determines which opinion is "narrowest."

The multiple and inconsistent methods of identifying the "narrowest" opinion show another deficiency of the *Marks* Rule. Legal commentators cannot even agree as to how many methods there are.[14]

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[14] It is unclear whether any of the following methods are consistent with the literal language of *Marks*. "When the Supreme Court issues a splintered decision—that is, a decision where a majority of the Court agrees on the result but not the reasoning—the binding holding is the position taken by those Justices 'who

A non-exclusive list of such methods include:

Common Denominator. Garner writes "the prevailing view is that the narrowest grounds are those that, when applied to other cases, would consistently produce results that a majority of the Justices supporting the result in the governing precedent would have reached." Bryan A. Garner, *The Law of Judicial Precedent* (2016) at 200. *See, e.g.*, *King v. Palmer*, 950 F.2d 771, 781 (D.C. Cir. 1991) ("must embody a position implicitly approved by at least five Justices who support the judgment."); *Ass'n of Bituminous Contractors, Inc. v. Apfel*, 156 F.3d 1246, 1254 (D.C. Cir. 1998).

Logical Subset. "Narrowest" can be determined in some situations, such as nested Venn diagrams ("Russian doll" reasoning). But that does not mean A and A-Narrow can be combined. Justice Alito provided an example in the *Hughes* argument: just because someone wants to see a romantic comedy does not mean he also agrees to the "narrowest" choice of seeing a romantic comedy in French. *Hughes* Transcript, 14-15. It is untenable to assume that a member has a second choice. It is even less tenable to assume her second choice is always a narrower version of her first choice. If she has one, it could be a completely different rule. *See generally*, Re, 30-33, Williams, 808-13.

Median Opinion. Is the median opinion the "narrowest"? Law is not about the middle ground, but

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concurred in the judgment[ ] on the narrowest grounds.'" *United States v. Duvall*, 740 F.3d 604, 607-08 (D.C. Cir. 2013) (Kavanaugh, J., concurring on denial of rehearing *en banc*).

about the correct reasoning. While a centrist justice may be an important swing vote, it is illogical to give precedential weight to the median opinion because it is in the middle. Nor is the median opinion always the narrowest. *See generally*, Re, 27-30.

Fifth Vote. The "fifth" vote may not always be "narrowest." Why are the views of the fifth member more important than those of the fourth or the sixth? *See* Williams, 813-17.

Shared Agreement. Professor Ryan Williams proposed a "shared agreement" approach: if some members adopt Rule A and others adopt Rule B, then the holding is that both Rules A and B are required. In some cases that might be valid. But what if a member adopts "A but never B"? Or another member posits "either A or B"? Clearly "both A and B" is not the same. *See* Re, 33-36, Williams, 822-38.

Lesser/Greater Included. In some situations, the Rule is logical if the holding is understood to be a range. In *Freeman* (prior to *Hughes*), the correct precedent should have been "sometimes, but could be always." In *Tam*, a holding of "at least as great as intermediate scrutiny, but possibly as high as heightened scrutiny" might be the rule (assuming that Justice Kennedy implicitly agreed to anything other than "exactly heightened scrutiny").

Brunetti suggests that each of the possible methods are flawed and no universally valid definition is possible.[15]

E. Stare Decisis Does Not Prevent *Marks* from Being Overruled.

1. The *Marks* Rule Was Not Based on Precedent.

Marks was this Court's attempt to deal with the unique problems of the 1970s: fractured Courts on the death penalty and obscenity.[16]

The only basis for the *Marks* Rule was a footnote from *Gregg v. Georgia*, 428 U.S. 153, 169 n.15 (1976), which in its entirety reads:

> Since five Justices wrote separately in support of the judgments in *Furman*, the holding of the Court may be viewed as that position taken by those Members who concurred in the judgments on the narrowest grounds—MR.

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[15] It has been suggested that this Court merely needs to provide further explication of how the *Marks* Rule is to be applied. For example, in *Hughes*, the *Brief* Amicus Curiae *for Agricultural*, proposed four additional rules to make *Marks* useful in the *Freeman* situation. How many more rules to determine how *Marks* applies to *Tam*? How many in other situations? In total, how many rules are needed to apply *Marks* to each type of fractured case? Surely the number is large.

[16] As the Court was unable to agree on a rationale, it decided 31 consecutive obscenity cases by *per curiam* decisions. *Paris Adult Theatre I v. Slaton*, 413 U.S. 49, 82-83 n.8 (1973) (Brennan, J., dissenting).

JUSTICE STEWART and MR. JUSTICE WHITE. *See* n.36, *infra*.

The *Gregg* footnote contains no reasoning or authority. Significantly, the footnote was in an opinion joined by only three justices.

The complete lack of legal authority (other than the minority footnote in *Gregg*) severely undercuts the precedential strength of *Marks*. Nor did the Court acknowledge that it was creating a new rule or discuss any of its implications.

2. The *Marks* Rule Was *Dicta*.

It was agreed by both the Petitioners and the Government in *Marks* that *Memoirs v. Massachusetts*, 383 U.S. 413 (1966), was a sufficient change in the law that it raised *ex post facto* concerns under *Bouie v. City of Columbia*, 378 U.S. 347 (1964) (a new judicial interpretation may constitute an *ex post facto* violation). The Government confessed that instructions based upon *Miller v. California*, 413 U.S. 15 (1973), were erroneous. *See Brief of United States*, 18-34.

The parties failed to correctly identify the question to be decided in *Marks*. Solicitor General Bork framed the question as whether *Roth v. United States*, 354 U.S. 476 (1957) remained binding after *Memoirs*, or in the alternative, there was no obscenity law between *Memoirs* and *Miller*. He concluded that this meant that *Memoirs* was the law. *See Marks*, Transcript (Nov. 2, 1976 at 21-22).

However, the actual question in *Marks* was what jury instructions were to be given on re-trial for conduct occurring through February 1973. The Court correctly concluded that the jury instructions should be based upon *Memoirs*.

> Petitioners, engaged in the dicey business of marketing films subject to possible challenge, had no fair warning that their products might be subjected to the new standards. We have taken special care to insist on fair warning when a statute regulates expression and implicates First Amendment values. *Marks*, 430 U.S. at 195-96.

In this context, the defendants would have understandably read *Memoirs* and assumed that it was the governing law.

But Justice Powell said more. He wrote, "The view of the *Memoirs* plurality therefore constituted the *holding of the Court* and provided the governing standards." *Marks*, 430 U.S. at 194 (emphasis added). Justice Powell's analysis seems doubtful because Chief Justice Burger wrote in *Miller* that:

> But today, for the *first time since Roth* was decided in 1957, a *majority of this Court* has agreed on concrete guidelines to isolate "hard core" pornography from expression protected by the First Amendment. *Id.* at 29 (emphasis added). *See also id.* at 22 ("no majority of the Court has at any given time been able to agree").

The Chief Justice emphasized that *Memoirs* was a plurality and that *Miller* was the first case since *Roth* to establish a majority rationale. Why? Because the Court in *Miller* did not consider *Memoirs* to be a binding precedent.

If there is a *Marks* Rule, it should be only that defendants in obscenity cases can reasonably rely on the opinion printed first. Beyond that, the *Marks* Rule is *dicta*.

F. This Court Does Not Consider the *Marks* Rule to Be Binding.

Among the puzzling facts about the *Marks* Rule is that the Court does not consistently apply it. After *Marks*, this Court continued to apply the principle of majority rule. In *CTS Corp. v. Dynamics Corp. of Am.*, 481 U.S. 69, 81 (1987), the Court wrote, "As the plurality opinion in MITE did not represent the views of a majority of the Court, we are not bound by its reasoning." *CTS* implicitly overruled the *Marks* Rule.

Only in *City of Lakewood v. Plain Dealer Pub. Co.*, 486 U.S. 750, 764 n.9 (1988), did the Court overlook its decision in *CTS* and apply the *Marks* Rule for the first time. Justice White's dissent in *Lakewood* argued that it was illogical to rely on the minority opinion as a binding precedent.

> First, the 'rationale of *Kovacs*' on which the majority relies was not the Court's view at all, but rather, an opinion for a three-Justice plurality. In fact, four other Justices in *Kovacs*

> understood the Court's action in that case in the exact contrary manner. . . . White, J., *dissenting*, *Lakewood*, 486 U.S. at 785 (citations omitted).

The *Marks* Rule has an ambiguous record in this Court. Including *Lakewood*, this Court has expressly relied on the *Marks* Rule five times (*see* Re n.47-48). Once the Court merely noted that the lower court relied on the Rule (*id.* n.49). More frequently, the Court does not rely on the Rule. The Court has cited the Rule four times without applying it (*id.*, cases cited in n.50, and *Hughes*).

This Court has twice explicitly refused to apply the *Marks* Rule. In *Nichols*, 511 U.S. at 745-46, the Court stated:

> "[t]his test is more easily stated than applied to the various opinions supporting the result in [the referenced plurality decision]."

In *Grutter v. Bollinger*, 539 U.S. 306, 325 (2003), the Court quoted *Nichols*:

> "It does not seem 'useful to pursue the *Marks* inquiry to the utmost logical possibility when it has so obviously baffled and divided the lower courts that have considered it.'"[17]

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[17] If the *Marks* Rule had been applied to *Regents of Univ. of Cal. v. Bakke*, 438 U.S. 265 (1978), the Court would have been precluded from considering Justice Powell's views in any subsequent case. Justice Stevens' opinion was the narrowest (surely deciding the statutory issue before reaching the constitutional issue is narrowest). Yet, Justice Powell's views eventually

In summary, this Court does not consistently apply the *Marks* Rule, especially not recently. If a rule is applied sometimes, and sometimes not, it may be a guideline but it is not a binding rule.[18]

1. Third Time Is a Charm: if the *Marks* Rule Is Unhelpful, the Court Should Explicitly Reject It.

The Court could, as suggested in the Government's petition reply brief, "simply revisit[ ] the underlying question addressed in the decision rather than" applying the *Marks* Rule. Reply Brief for Petitioner, page 6 n*. That essentially concedes that the *Marks* Rule has no continuing vitality.

In this case, the Court has to apply *Marks* to *Tam*. The saying is "the third time is the charm." If, at least three times the Court considered *Marks* and concluded the Rule is not useful, then the Court has functionally overruled *Marks*. The Court might as well make its disavowal explicit.

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commanded a majority. Does not this example alone show the danger of taking minority views and converting them into precedents that bind this Court as well as lower courts?

[18] Interestingly, in his *Brief of Law Professors as* Amicus Curiae, in *Hughes*, at 4, 5, Professor Stearns acknowledges the *Marks* Rule is not binding on this Court. However, he asserts that *Marks* remains binding on lower courts. *Stare decisis* is both horizontal and vertical. Obviously, who can overrule a precedent, applies only horizontally.

The *Brief of Professor Richard M. Re as* Amicus Curiae in *Hughes*, at 13-14, deserves quotation:

> The *Marks* rule plays a significant and growing role in legal practice, yet there is a powerful case for abandoning it. . . . [W]hen governing decisions are unworkable or are badly reasoned, this Court has never felt constrained to follow precedent." *Payne*, 501 U.S. at 827-28. And because the *Marks* rule "is judge made and implicates an important matter involving internal Judicial Branch operations," the responsibility to take corrective action lies with this Court. *Pearson v. Callahan*, 555 U.S. 223, 233-34 (2009).

2. The Court Should Return to the Common Law Rule of Dual-Majority.

In place of the *Marks* Rule, the Court should return to the bright-line common-law maxim of Dual-Majority.

The Dual-Majority maxim will be beneficial for all the reasons the *Marks* Rule is deleterious. This Court will not be bound by horizontal *stare decisis* to follow the views of a minority in a prior case. Nor will lower courts feel compelled under the doctrine of vertical *stare decisis* to follow minority opinions.[19]

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[19] Approximately 400 court of appeals decisions have attempted to apply the *Marks* Rule to about 100 decisions of this Court, with highly divergent results and reasoning. *See* Re, *supra*, at 10-14.

There will be fewer precedential opinions if this Court returns to the common law maxim of Dual-Majority. Fewer precedents, if that means no binding precedents based upon minority opinions, is a good thing.

Lower courts will still be required to "run the facts through the opinions" of the fractured decision and see if there is an applicable precedent based upon the judgment.

> "[T]he necessary logical corollary to *Marks* is that lower courts should still strive to decide the case before them in a way consistent with how the Supreme Court's opinions in the relevant precedent would resolve the current case." *United States v. Duvall*, 740 F.3d 604, 611 (Kavanaugh, J., concurring on denial of petition for rehearing *en banc*).

Another corollary to the Dual-Majority maxim is a presumption against implied agreement. When a concurring or dissenting justice agrees in part with the rationales of other justices, she has the ability to say so explicitly. Members take great care in writing their opinions. In the absence of such explicit agreement, it should not be presumed that a justice forgot to express her agreement with other opinions.

It is best to disavow the *Marks* Rule completely with immediate effect because this Court has not consistently applied it. Disavowal is unlikely to adversely affect settled expectations (unlike rules affecting property interests), especially since the problems with the

Rule prevent settled expectations. Or the Court could apply the disavowal only prospectively, or even prospectively only to fractured cases decided after this case.

The Court must either apply the *Marks* Rule or ignore it. The Dual-Majority maxim is clearly preferable to attempting to apply the often indeterminate *Marks* Rule to reach sometimes illogical results.

CONCLUSION

Brunetti urges the Court to affirm the Court of Appeals by finding the Immoral/Scandalous Clauses facially unconstitutional. In doing so, Brunetti urges this Court to explicitly adopt a level of scrutiny that is strict. Should it be necessary to reach the issue, the Immoral/Scandalous Clauses are unconstitutionally vague.

The Court should also disavow the *Marks* Rule and return to the common law maxim of the Dual-Majority: majority on the judgment and majority on the rationale.

Respectfully submitted,

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Appendix

PTO's Examination of words in George Carlin's *Seven Filthy Words*[1] and on a list of Profane Words[2]

Applications **Registered** by PTO	Applications **Refused** by PTO
ASS or ASSHOLE	
ASS – registered over 200 times **AHOLES** – 5591208	**ASSHOLE** – 77/485121 **DON'T BE AN AHOLE!** – 86/570406 **A-HOLE PATROL** – 78/951377 **THE COMPLETE A**HOLE'S GUIDE TO. . . .** – 76/351811 *refusal affirmed*, T.T.A.B., January 4, 2005
BASTARD	
LANKY BASTARD – 5679769 **CRAFTY BASTARDS** – 5683491 **DIRTY BASTARDS** – 5497140 **ARROGANT BASTARD** – 2283904	

[1] Carlin's *Seven Filthy Words*: shit, piss, fuck, cunt, cocksucker, motherfucker, tits.

[2] This list was the highest result for "profane words" on Google: https://simple.wikipedia.org/wiki/Profanity (last accessed March 15, 2019).

BITCH	
THE FUNKY BITCH – 5686027; 5685985 **SHINY BITCHES** – 5670238 **BITCH PERFECT** – 5694730 **DIVINE BITCHES** – 3870498 **RICH BITCH** – 3117353	
COCK	
PHAT COCK – 5687273 **BIG COCK OWNER-SHIP CLUB** – 4869291 **I BRAKE FOR COCK!** – 5677097 **FAT COQ** – 4112430	**FAT COCK BEER** – 85/253332 **KING COCK** – 86/500922
COCKSUCKER	
COCKSUCKER – Approved, published, and then withdrawn from publication – 75/942851	
CUNT	
	CUNT – 77/048672
DICK	
DICK – 4652273; 4975914 **SMALL TOWN DICKS** – 5464581 **DICK DANGLER** – 4397617	**PHATDIX.COM** – 86/577413 **GET OFF MY DICK** – 88/101325

FUCK	
FAUQ-YEAH!! – 5282969 **WTF WORK?** – 4332574 **SAUCY AF** – 5699181 (AF refers to "*as fuck*") **WTF WHERE'S THE FOOD TRUCK** – 5642124 Note: search of the PTO database for "fuck" brings up the above four marks. **F'D UP** – 4495813 **FCUK** – 2920270; 2520614; 3028227; 4167152; 5301912 **THE F WORD** – 3116416 **PHUC** – 4354653	**FUCT** (appellant herein) – 85/310960 **FUCK CANCER** – 86/290011
MOTHERFUCKER	
	BAD MOTHER FUCKER – 79/031185
PISS	
SATAN'S PISS – 5233724 **DONKEY PISS** – 4113159 **PISS OFF** – 2958203	
PUSSY	
PUSSY NATURAL ENERGY – 4254281 **RICH PU$$Y** – 5307001 **PUSSY** – 4120676	**PUSSYWEAR** – 75/743995 **PU$$Y CONTROL** – 85/878245 **PUSSY POWER** – 77/387207

PUSSY POWER REVOLUTION – 4507246[3] **MY PUSSY LOVES YOU** – 5219014	**INFAMOUS PUSSY** – 87/448939 **PUSSY RIOT** – 87/152598
SHIT	
$#*! THE BED – 5192367 **$#*! MY DAD SAYS** – 4142745 **SCHIIT** – 5443096 **WHERE'S MY FREE SHIT** – 5292288	**APE $#!+** – 85/611740 **NO $#!+** 85855449 (*In re Jones*, 2013 T.T.A.B. LEXIS 615 (T.T.A.B. 2013) (not precedential)) **NO-SHIT** – 77/913273 **S#!TS & GIGGLES ELK POOP ACCESSORIES** – 85/542023
TITS	
TIT – 5056984 **TIT-PIK** – 4610032 **TITS** – 3120205	**TITS OUT FOR BAMBI** – 87/272072 **TITS FIRST** – 88/178580 **DON'T DRINK MILK FROM A WITCH'S TIT** – 86/699562

[3] Another example of PTO inconsistency is PUSSY POWER. The mark was okay in 2007, scandalous in 2009, okay again in 2014, and deemed scandalous again in 2017 and 2018. *See* POWER PUSSY (78/852737, allowed 02/13/2007); PUSSY POWER (scandalous per office action 02/15/2009); PUSSY POWER REVOLUTION (registered 04/01/2014); PUSSY POWER (87/520058, scandalous per office action 12/15/2017); PUSSY POWER (88/163730, scandalous per office action 12/14/2018).

No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

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v.

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ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

For more than a hundred years, Congress has prohibited federal registration of "scandalous" trademarks, *i.e.*, marks that a substantial segment of the public would find shocking. 15 U.S.C. 1052(a); see Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725. The only effect of that prohibition is the denial of the added benefits that come with federal registration. The owner of the mark remains free to engage in whatever speech he wishes, with or without the mark.

Respondent contends (Br. 1) that Section 1052(a)'s scandalous-marks provision restricts speech on the basis of viewpoint and is facially inconsistent with the First Amendment. The scandalous-marks provision, however, is not a restriction on speech, but a condition on government benefits. And while the provision (like

all of Section 1052(a)'s registration criteria) is based on the *content* of applicants' marks, it is *viewpoint*-neutral. The provision renders certain marks ineligible for registration not because they are thought to convey offensive *ideas*, but because they reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.* v. *City of St. Paul*, 505 U.S. 377, 393 (1992).

Under settled First Amendment principles, the scandalous-marks provision survives constitutional scrutiny because it is a reasonable, viewpoint-neutral condition on the availability of government benefits. The court of appeals' contrary judgment should be reversed.

A. Strict Scrutiny Under The First Amendment Is Unwarranted

Respondent contends that strict scrutiny is warranted under the First Amendment because (i) Section 1052(a)'s scandalous-marks provision discriminates based on viewpoint (Br. 9-19), and (ii) the provision "restricts speech" (Br. 19). Both of those characterizations are unsound. The scandalous-marks provision is viewpoint-neutral, and it is a condition on a government benefit rather than a restriction on speech. To treat the provision as a viewpoint-based speech restriction would call into doubt not only the Lanham Act's many other trademark-registration criteria, but also the exclusion of sexually explicit, profane, and other vulgar material from government forums and programs across the country.

1. The scandalous-marks provision is not a restriction on speech

Throughout his brief, respondent refers to Section 1052(a)'s scandalous-marks provision as a content-based "prohibition" on speech. Resp. Br. 12; see also, *e.g.*, *id.* at 7, 13, 25, 36. Respondent argues (Br. 19) that, when the government "restricts speech based on content," strict scrutiny should apply.

As our opening brief explains (at 20-25), however, the scandalous-marks provision does not restrict speech. It does not prohibit respondent from using the mark "FUCT" as his brand, as he has been doing for nearly 30 years, C.A. App. A52, or in advertising or other promotional materials. Nor does it prohibit him from engaging in any other speech or conduct. The only consequence of the USPTO's determination that the mark is "scandalous" was to render unavailable the additional commercial benefits that come with federal registration —benefits that are directly attributable to the substantial resources the USPTO devotes to examination, publication, and maintenance of registered trademarks. Gov't Br. 20-25. This Court has long held that, when the government "does not restrict" speech "but rather declines to promote" it, strict scrutiny is generally unwarranted. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009).

Respondent's reliance (Br. 19-20) on *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218 (2015), therefore is misplaced. The Town of Gilbert had "prohibit[ed] the display of outdoor signs * * * without a permit," while exempting certain categories of signs based on their content. *Id.* at 2224. Because the Town had imposed a content-based "restriction on truthful speech," *id.* at 2232 (citation omitted), the Court required it "to prove that the

restriction furthers a compelling interest and is narrowly tailored to achieve that interest," *id.* at 2231 (citation omitted).

Section 1052(a), by contrast, prohibits federal *registration* of scandalous trademarks, but it does not restrict the use of such marks in commerce or otherwise limit the speech in which respondent may engage. Rather, it is a condition on the availability of the governmentally conferred benefits that flow from federal trademark registration. Strict scrutiny is generally unwarranted when "the government is acting in a capacity other than as regulator," *Davenport* v. *Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007), and the government is acting in a non-regulatory capacity here.

In seeking to avoid that conclusion, respondent argues (Br. 25-26, 28-30) that the precedents cited in our opening brief involved government benefits different from those at issue here. He contends (Br. 28), for example, that the Court's "government subsidy" cases are inapposite because the benefits there took the form of direct monetary payments. The Court's decisions in such cases as *National Endowment for the Arts* v. *Finley*, 524 U.S. 569 (1998), and *Rust* v. *Sullivan*, 500 U.S. 173 (1991), however, did not turn on the particular nature of the benefits at issue. Rather, they turned on the "basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy." *Maher* v. *Roe*, 432 U.S. 464, 475 (1977); see *Finley*, 524 U.S. at 588 (quoting *Maher*, 432 U.S. at 475); *Rust*, 500 U.S. at 193 (same); see also *Christian Legal Soc'y Chapter of the Univ. of Cal., Hastings Coll. of the Law* v. *Martinez*, 561 U.S. 661, 687 n.17 (2010) (invoking the

"distinction between state *prohibition* and state *support*" in applying a "lesser standard of scrutiny" to content-based limitations on access to a limited public forum); *id.* at 682-683 (drawing the same distinction). Strict scrutiny thus is generally inapplicable to content-based conditions on government benefits, whether or not those benefits involve the payment of federal funds to or on behalf of private beneficiaries.

That principle likewise underlies this Court's decisions in *Davenport* and *Ysursa*. In *Davenport*, the government benefit at issue was the "power" of a public-sector union to "levy fees on government employees who do not wish to join the union," 551 U.S. at 184; in *Ysursa*, it was the "use" by such a union of "government payroll mechanisms for the purpose of obtaining funds" for "political activities," 555 U.S. at 355. The Court's decisions in both cases rested on the same basic distinction between an "abridgment" of speech and a decision not to "support" it. *Id.* at 359; see *Davenport*, 551 U.S. at 188-189.

By attempting to distinguish the foregoing cases on their facts, respondent fails to appreciate the deeper principle for which they all stand. The scandalous-marks provision is not a restriction on speech, and respondent cannot justify strict scrutiny by treating it as one.

2. Content-based distinctions are an inherent part of the federal trademark-registration program

As our opening brief explains (at 25-26), content-based distinctions are an "inherent and inescapable" part of any trademark-registration program. *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 49 (1983). In that respect, Section 1052(a)'s scandalous-

marks provision is not unique. Rather, *all* of the registration criteria set forth in Section 1052 are based on the content of applicants' marks. 15 U.S.C. 1052; see Gov't Br. 25. Those criteria have not heretofore been thought to raise meaningful First Amendment concerns, and application of strict scrutiny to all of them would severely impede the administration of the federal registration program.

Although respondent urges this Court (Br. 46) not to "speculate about the constitutionality of other Lanham Act provisions," he does not dispute that, under his view, those other provisions would likewise be subject to strict scrutiny. But just as strict scrutiny is "incompatible" with the "content-based judgments" that a public library must make "in selecting the material it provides to its patrons," *United States* v. *American Library Ass'n*, 539 U.S. 194, 204-205 (2003) (plurality opinion), and just as it is "incompatible" with the "content-based criteria" that the government must apply in selecting artists to fund, *id.* at 205 (citing *Finley*, 524 U.S. at 585), so too strict scrutiny is incompatible with the content-based (but viewpoint-neutral) distinctions that the USPTO must draw in determining whether particular marks are eligible for federal registration. Because no trademark-registration program could operate without taking into account the content of applicants' marks, strict scrutiny is particularly unwarranted here. Cf. *Christian Legal Soc'y*, 561 U.S. at 681 (declining to apply strict scrutiny where it "would, in practical effect, invalidate a defining characteristic" of a limited public forum).

3. The scandalous-marks provision is viewpoint-neutral

a. Our opening brief explains (at 26-30) why, unlike the disparaging-marks provision that the Court struck

down in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), the scandalous-marks provision is viewpoint-neutral. In resisting that conclusion (Resp. Br. 9-19), respondent explains that scandalous marks are refused registration because they are offensive, and he invokes Justice Alito's statement for four Justices in *Tam* that "[g]iving offense is a viewpoint." *Id.* at 9 (quoting *Tam*, 137 S. Ct. at 1763 (Alito, J.)).

Read in context, however, the language quoted above simply asserts that "[g]iving offense is a viewpoint" when the source of the offense is the "'ideas'" expressed. 137 S. Ct. at 1763 (Alito, J.) (citation omitted). Immediately after stating that "[g]iving offense is a viewpoint," Justice Alito explained that "'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Ibid.* (citation omitted). The Court in *Tam* found that Section 1052(a)'s disparagement provision discriminated based on viewpoint because that provision banned the registration of marks "on the ground that [they] expresse[d] ideas that offend." *Id.* at 1751; see *id.* at 1766 (Kennedy, J.) (concluding that the disparagement provision "reflects the Government's disapproval of a subset of messages it finds offensive").

The scandalous-marks provision is different. As our opening brief explains (at 27), "scandalous" marks are ineligible for registration not because they are thought to convey offensive *ideas*, but because such marks reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.*, 505 U.S. at 393. A mark is "scandalous" if, for example, it contains sexually explicit or profane material. Gov't Br. 27; see, *e.g.*, Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017) (providing a sample of vulgar marks for which the USPTO

had refused registration). This Court has never regarded laws that target such vulgarity as discriminating based on viewpoint. See, *e.g.*, *Denver Area Educ. Telecomms. Consortium, Inc.* v. *FCC*, 518 U.S. 727, 747 (1996) (plurality opinion); *Bethel Sch. Dist. No. 403* v. *Fraser*, 478 U.S. 675, 685 (1986); *FCC* v. *Pacifica Found.*, 438 U.S. 726, 746 nn.22-23 (1978) (plurality opinion). Rather, such vulgarity has long been understood to be "offensive irrespective of any message" sought to be conveyed. *Pacifica*, 438 U.S. at 746 n.23 (plurality opinion).

If it were otherwise, governments could not prevent advertisers from placing sexually explicit images or profanity on city buses and billboards. Gov't Br. 30. Nor could they exclude such vulgar material from other limited public forums. *Ibid.* Respondent contends (Br. 46) that the Court's decision here "will not affect the jurisprudence about forums." But even within a limited public forum, "'viewpoint discrimination' is forbidden." *Tam*, 137 S. Ct. at 1763 (Alito, J.) (citation omitted). Respondent does not explain how the federal government, States, or localities could continue to keep such forums free of sexually explicit and other vulgar material, if such efforts were deemed viewpoint-discriminatory.

b. Respondent argues (Br. 12) that the use of profanity itself expresses a viewpoint—namely, "nonconformance to conventional social mores." Nevertheless, both on its face and as applied to respondent's trademark, the scandalous-marks provision reflects Congress's objection "not to this point of view, but to the way in which it is expressed." *Pacifica*, 438 U.S. at 746 n.22 (plurality opinion). The ban on federal registration of marks that contain profanity reflects the fact that a substantial composite of society regards profanity as an

offensive mode of expression, even when it is used to express the view that profanity is "harmless." *Ibid.*

Cohen v. *California*, 403 U.S. 15 (1971), is not to the contrary. Although the State in *Cohen* had objected to the defendant's use of profanity in expressing an antidraft message, *id.* at 16-17, the Court did not treat that objection as one based on the defendant's viewpoint. Rather, the Court distinguished the defendant's "manner" of expression from the underlying "message" he sought to convey. *Id.* at 19; see Gov't Br. 29.

To be sure, the Court in *Cohen* ruled in the defendant's favor, sustaining his First Amendment challenge to the application of state law to his vulgar speech. See 403 U.S. at 26. The Court's holding was limited by its terms, however, to laws that *prohibit* the use of vulgar words in public places. Thus, the Court stated its "judgment that, absent a more particularized and compelling reason for its actions, the State may not * * * make the simple public display here involved of this single four-letter expletive a criminal offense." *Ibid.* That holding reflects the fact that content-based *restrictions on speech* are often incompatible with the First Amendment even when they are viewpoint-neutral. It does not cast doubt on the Lanham Act provision at issue here, which does not restrict the *use* of scandalous marks but simply denies such marks the benefits associated with federal registration. See pp. 3-5, *supra*.[1]

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[1] Contrary to respondent's suggestion (Br. 17), neither the government's argument that the scandalous-marks provision is viewpoint-neutral, nor our overall constitutional defense of that provision, rests on any "contention that only the idea is protected." The First Amendment substantially constrains the government's ability to restrict private speech, even when the restriction at issue focuses

c. Respondent observes (Br. 11) that application of the scandalous-marks provision turns on the "*degree*" of a mark's offensiveness. But that fact simply reinforces the conclusion, which the government has never disputed, that the provision is *content*-based. The fact that "scandalous[ness]" is a matter of degree does not logically suggest that the provision discriminates based on viewpoint.

Respondent also asserts (Br. 15) that application of the scandalous-marks provision turns on "the applicant's intended meaning." That is incorrect. Under the scandalous-marks provision—as under Section 1052 generally—the applicant's subjective intent is not determinative. The inquiry turns instead on how consumers would perceive the mark in the context of the goods or services identified in the registration application. See *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003) (explaining that whether a mark is scandalous "must be determined from the standpoint of a substantial composite of the general public"); cf., *e.g.*, *Seabrook Foods, Inc.* v. *Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977) (focusing on the "impression on consumers" rather than on the applicant's "intentions" in determining distinctiveness); *Hydra Mac, Inc.* v. *Mack Trucks, Inc.*, 507 F.2d 1399, 1400 (C.C.P.A. 1975) (focusing on the "actual impression created by the mark" rather than on the "impression intended by the user" in determining likelihood of confusion) (emphasis omitted).

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solely on the speaker's "mode of expression." *Ibid.* The government's defense of the scandalous-marks provision depends on *both* the viewpoint-neutral character of that provision *and* the fact that it addresses eligibility for a government benefit rather than restricts private speech.

To be sure, particular words may have multiple meanings, some vulgar and some innocuous. Whether consumers will regard a particular mark as offensive therefore may turn on the context in which such a word appears. See pp. 22-23, *infra*. The scandalous-marks provision might be somewhat easier for USPTO examining attorneys to administer if its application was based solely on a pre-existing list of categorically unregistrable words. Such an approach, however, would preclude registration of many marks that consumers would not find offensive in context. In any event, the USPTO's consideration of context in determining whether particular marks are scandalous does not suggest that the provision is viewpoint-based.

d. Respondent asserts that the USPTO's Trademark Trial and Appeal Board (TTAB or Board) found his mark "offensive *because* he 'critique[d] capitalism, government, religion and pop culture,'" and that the application of the scandalous-marks provision to his own mark therefore reflected viewpoint-based discrimination. Resp. Br. 7 (quoting Pet. App. 57a) (brackets in original). That is incorrect. Although the Board noted in passing that respondent had engaged in such critiques, Pet. App. 57a, it did not treat that fact as relevant to the registration decision. Rather, it explained that respondent's mark was unregistrable because the evidence demonstrated that "FUCT" would be perceived as the "slang and literal equivalent" of the past tense of a vulgar word. *Id.* at 61a; see *id.* at 64a (finding that the mark, "as used by [respondent], will be perceived by his targeted market segment as the phonetic equivalent" of a vulgar word); *id.* at 65a (finding "FUCT" to be the "phonetic twin" of a "vulgar" and "extremely offensive" word).

Respondent has never contended that the mark itself expresses any "critique" of "capitalism, government, religion and pop culture." Pet. App. 57a. Before the USPTO, he averred both that "FUCT" was "an arbitrary made up word," and that "to the extent I am asked for a meaning I refer to FRIENDS U CAN'T TRUST." J.A. 38. But he does not contend that the USPTO denied registration based on disagreement with *that* message, and his claim that he was the victim of viewpoint discrimination has no support in the record.

B. The Scandalous-Marks Provision Satisfies First Amendment Scrutiny

When the government "does not restrict" speech "but rather declines to promote" it in a viewpoint-neutral way, *Ysursa*, 555 U.S. at 355, the appropriate First Amendment inquiry turns on (1) whether the statute is "reasonabl[y]" related to a legitimate government interest, *ibid.*; and (2) whether the statute imposes an "unconstitutional condition" by seeking to "leverage" government benefits "to regulate speech outside the contours of the [government] program itself," *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 214-216 (2013). Both on its face and in its application to respondent's mark, the scandalous-marks provision satisfies those requirements.

1. The scandalous-marks provision is reasonably related to legitimate government interests

Respondent does not contend that Section 1052(a)'s scandalous-marks provision runs afoul of this Court's unconstitutional-conditions precedents. Rather, he argues (Br. 23) that the scandalous-marks provision "cannot survive any applicable level of scrutiny" because it

is not "narrowly drawn" to serve a "substantial governmental interest." That argument misstates the applicable level of scrutiny. As in other contexts where "the government is acting in a capacity other than as regulator," *Davenport*, 551 U.S. at 188, the scandalous-marks provision satisfies First Amendment review if it is "reasonabl[y]" related to a legitimate government interest, *Ysursa*, 555 U.S. at 355. That standard reflects Congress's broad discretion to "encourage certain activities it believes to be in the public interest." *Rust*, 500 U.S. at 193.

As our opening brief explains (at 31-38), the scandalous-marks provision satisfies that standard. Respondent's counterarguments lack merit.

a. Respondent argues that the government lacks a "substantial interest justifying broad suppression of speech." Resp. Br. 22 (quoting Pet. App. 34a). The scandalous-marks provision, however, does not "suppress[]" any speech. Rather, Congress has imposed reasonable conditions on the availability of commercial advantages that attend federal trademark registration and that are directly attributable to the USPTO's commitment of substantial resources to the examination, publication, and maintenance of registered trademarks. By rendering those advantages unavailable for marks that contain sexually explicit, profane, or other vulgar material, the government aims, among other things, to encourage the use of marks that are appropriate for all audiences, including children. Gov't Br. 32-33.

Respondent asserts (Br. 23) that the scandalous-marks provision does not "advance" that interest because "trademark owners can use their trademarks in any event." That observation simply underscores that the scandalous-marks provision does not restrict the

speech of respondent or any other would-be registrant. See pp. 3-5, *supra*. Respondent is also wrong in suggesting that the government can advance an interest only by prohibiting the conduct that it wishes to discourage. See *Christian Legal Soc'y*, 561 U.S. at 683 (explaining that a government may "dangl[e] the carrot of subsidy" as well as "wield[] the stick of prohibition"); *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 550 (1983) (similar).

Respondent also argues (Br. 23) that the government could advance the same interest simply by requiring "login and age verification to view offensive marks on the [USPTO] website." That proposed approach would be both cumbersome and unresponsive to the problems that the scandalous-marks provision seeks to address. The possibility that minors might scour the federal trademark register for titillating marks, or might stumble on such marks accidentally in the course of internet research, is neither a real-world concern nor one that the government has ever invoked as a rationale for the registration ban. Login and age-verification measures would do nothing to discourage the *commercial* use of scandalous marks in the countless places where goods or services are sold or marketed to the public, including to children. See Pet. App. 55a (observing that respondent sought to register the mark "FUCT" for children's and infants' apparel).

b. Respondent disputes (Br. 22-23) the existence of a meaningful relationship between the scandalous-marks provision and the orderly flow of commerce. That relationship, however, derives from the very nature of a scandalous mark. A mark that many consumers find shocking creates an evident risk of marketplace

disruption. Gov't Br. 33-34. The scandalous-marks provision promotes the orderly flow of commerce by discouraging such disruption.

c. As our opening brief explains (at 34-36), the government's interest in avoiding the appearance of government approval of scandalous marks provides a distinct rationale for the registration ban. In discounting that interest, respondent observes (Br. 27) that the *Tam* Court rejected a "government speech" argument. The argument here, however, is not that trademarks are government speech. Rather, it is that the government may reasonably seek to avoid the appearance that it approves of marks so vulgar that they would shock a substantial segment of the public. Gov't Br. 34-36. Respondent contends (Br. 27) that, instead of denying registration of such marks, the government could simply "add a disclaimer" to the certificates of registration that it issues to the marks' owners. But such a disclaimer would do little to dispel the appearance of government approval in the eyes of the public, which would still see the marks displayed with the ® symbol or "the words 'Registered in U.S. Patent and Trademark Office or 'Reg. U.S. Pat. & Tm. Off.'" 15 U.S.C. 1111.

d. The inherently commercial nature of trademarks and trademark registration reinforces the constitutionality of the scandalous-marks provision. Gov't Br. 36-38. Respondent asserts (Br. 32) that "[m]any trademarks are non-commercial." But federal law defines the term "trademark" as "any word, name, symbol, or device, or any combination thereof * * * used by a person * * * *to identify and distinguish his or her goods * * * from those manufactured or sold by others* and *to indicate the source of the goods.*" 15 U.S.C. 1127 (emphases added); see *ibid.* (defining "service mark" in

similar terms). And actual or intended use of a mark in commerce is a statutory prerequisite to federal registration. See 15 U.S.C. 1051(a) and (b). The benefits of trademark registration are entirely commercial in nature, giving mark owners particular advantages in suppressing the speech of their competitors in the marketplace for goods and services. Gov't Br. 37. Congress enjoys broader discretion when legislating in the commercial sphere, see *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 562 (1980), and Section 1052(a)'s scandalous-marks provision is a reasonable exercise of that discretion.

Respondent also asserts (Br. 33) that "many trademarks convey messages." Before the USPTO, however, respondent specifically disclaimed any suggestion that his own mark was expressive. See p. 12, *supra*. And, to the extent that respondent wishes to incorporate the mark "FUCT" into advertisements or other expressive materials, the statutory ban on federal *registration* does not prevent him from using the mark for any expressive purpose he wishes.

2. Upholding the scandalous-marks provision would not have the adverse consequences that respondent describes

As our opening brief explains (at 43-45), upholding the scandalous-marks provision would have no necessary implications for the constitutionality of a hypothetical statute that imposed analogous limits on registration of copyrights. Trademarks protect mere source identifiers, whereas copyrights protect creative works themselves. Gov't Br. 44. Trademark protection thus "has no necessary relation to invention or discovery," *Dastar Corp.* v. *Twentieth Century Fox Film Corp.*,

539 U.S. 23, 34 (2003) (citation omitted), whereas copyright protection "supplies the economic incentive to create and disseminate ideas," *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (citation omitted). Because a core purpose of the First Amendment is to "preserve an uninhibited marketplace of ideas in which truth will ultimately prevail," *McCullen* v. *Coakley*, 573 U.S. 464, 476 (2014) (citation omitted), that difference between the two regimes would be a salient one in the First Amendment analysis.

Respondent is also wrong in suggesting (Br. 48-49) that upholding the scandalous-marks provision would allow state and local governments to deny permits or licenses, or to restrict business-related expressive activity, based on an applicant's vulgar speech. Assuming that a business satisfied other applicable requirements, this Court's unconstitutional-conditions precedents would protect it from the denial of a permit or license based on the applicant's vulgar mode of expression. See *Koontz* v. *St. Johns River Water Mgmt. Dist.*, 570 U.S. 595, 604 (2013); Gov't Br. 38-40. State efforts to prohibit vulgar product labels (Resp. Br. 49) might occasionally present difficult First Amendment issues, but the Court's decision in this case will have no necessary implications for the resolution of those disputes. Although governmental bodies often have more extensive authority to regulate product labeling as commercial expression, a prohibition on vulgar labels still would appropriately be analyzed as a restriction on speech. See, *e.g.*, *Rubin* v. *Coors Brewing Co.*, 514 U.S. 476, 481-482 (1995). Here, by contrast, "the refusal to register a mark does not proscribe any conduct or suppress any form of expression." *Boulevard Entm't*, 334 F.3d at 1343.

C. The Court's Decision In *Tam* Is Not Controlling Here

All eight Justices who participated in *Tam* agreed that Section 1052(a)'s ban on registration of "disparag[ing]" trademarks discriminates based on viewpoint. 137 S. Ct. at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). That determination led Justice Alito and Justice Kennedy, each writing on behalf of four Justices, to conclude that the disparagement provision is unconstitutional. *Id.* at 1763-1764 (Alito, J.); *id.* at 1765-1769 (Kennedy, J.). Both Justice Alito and Justice Kennedy, however, "lef[t] open" whether a viewpoint-*neutral* provision could "be saved by analyzing [trademark registration] as a type of government program in which some content- and speaker-based restrictions are permitted." *Id.* at 1763 & n.16 (Alito, J.); see *id.* at 1768 (Kennedy, J.) (leaving open how a viewpoint-neutral provision "should be analyzed under the First Amendment"). Because Section 1052(a)'s scandalous-marks provision is viewpoint-neutral, the Court's decision in *Tam* does not control the outcome here. See Gov't Br. 15-18.

Respondent asks this Court (Br. 50-66) to revisit the rule in *Marks* v. *United States*, 430 U.S. 188 (1977), for identifying the precedential effect of divided decisions of this Court. The only reason he gives for doing so (Br. 29-30) is to determine the precedential status of certain parts of Justice Alito's opinion in *Tam* that addressed issues that Justice Kennedy did not reach. Because Justice Kennedy did not reach those issues, see *Tam*, 137 S. Ct. at 1765, however, his opinion is plainly the narrower of the two. No further analysis is necessary to determine that Justice Alito's opinion on those issues, on behalf of four Justices, lacks the status of binding precedent. Indeed, even under the so-called "Dual-Majority" rule that respondent endorses (Br. 50 n.13),

those portions of Justice Alito's opinion would not be entitled to precedential effect because they lacked the support of a "majority on the reasoning."

When the Court has previously reviewed a dispute about the application of *Marks* to a fractured prior decision, it has simply revisited the underlying legal issue rather than "pursu[ing] the *Marks* inquiry to the utmost logical possibility." *Nichols* v. *United States*, 511 U.S. 738, 746 (1994); see, *e.g.*, *Hughes* v. *United States*, 138 S. Ct. 1765, 1772 (2018); *Grutter* v. *Bollinger*, 539 U.S. 306, 325 (2003). There is no reason to follow a different course here.

D. The Scandalous-Marks Provision Is Not Unconstitutionally Vague

In his brief at the petition stage (at i, 17), respondent urged the Court to grant review not only on the First Amendment question presented in the petition for a writ of certiorari, but also on the question whether Section 1052(a)'s scandalous-marks provision is unconstitutionally vague under the First and Fifth Amendments. Although the government likewise urged the Court (Cert. Reply Br. 4) to "consider the vagueness question so that the constitutionality of the scandalous-marks provision can be definitively resolved," the Court granted the petition without requesting briefing on vagueness. Accordingly, the government did not address the question in its opening brief. In any event, respondent's vagueness argument (Br. 33-45) provides no sound basis for setting aside the USPTO's denial of his registration application.

1. As the court of appeals explained, the present tense of the word for which "FUCT" is a homonym is an "indisputably vulgar term." Pet. App. 40a; see *id.* at 6a;

Pacifica, 438 U.S. at 738-741.[2] The evidence demonstrated that "FUCT" would be perceived as "a slang and literal equivalent" of the past tense of that term. Pet. App. 61a; see *id.* at 6a-7a. The court therefore saw "no definition of scandalous that, in light of the [USPTO's] fact findings, would exempt [respondent's] mark." *Id.* at 10a. Because his own mark is clearly covered by the statutory ban on registration, respondent "cannot complain of the vagueness of the law as applied to the conduct of others." *Holder* v. *Humanitarian Law Project*, 561 U.S. 1, 19 (2010).[3]

2. Section 1052(a)'s scandalous-marks provision does not prohibit speech or impose any civil or criminal penalties, but simply precludes the government from providing a specified form of assistance to marks that contain scandalous material. Gov't Br. 20-25. When a statute neither prohibits nor penalizes speech, but simply confers benefits on speakers whose expression satisfies certain criteria, the vagueness standard is relaxed because there is less concern about chilling speech. See *Finley*, 524 U.S. at 588-589. Although re-

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[2] Respondent's current contention that "[t]he name of [his] brand is pronounced as four letters, one after another," Resp. Br. 1, lacks any record support, and it is contrary to the Board's finding that respondent's mark "will be perceived by his targeted market segment as the phonetic equivalent of" a vulgar term, Pet. App. 64a.

[3] Contrary to respondent's suggestion (Br. 2-3, 42), there was nothing inappropriate about the USPTO's decision to withdraw his application from publication in the agency's *Official Gazette*. C.A. App. A198; see 15 U.S.C. 1062. Even after an application has been approved for publication, the USPTO has a duty to correct any errors discovered through internal quality review. See USPTO, Dep't of Commerce, *Trademark Manual of Examining Procedure* §§ 706.01, 1504.01 (Oct. 2018).

spondent had been using the "FUCT" mark in commerce for many years before the USPTO determined that it was "scandalous," the agency's decision did not expose respondent to potential penalties for his prior or ongoing use of the mark, but simply denied him the benefits associated with federal trademark registration.

Under the more lenient standard that applies in this context, the Court has upheld even criteria that are "undeniably opaque" because "[i]n the context of selective subsidies," "the consequences of imprecision are not constitutionally severe." *Finley*, 524 U.S. at 588-589; see *id.* at 599 (Scalia, J., concurring in the judgment) ("Insofar as it bears upon First Amendment concerns, the vagueness doctrine addresses the problems that arise from government *regulation* of expressive conduct, not government grant programs.") (citation omitted). The scandalous-marks provision satisfies that standard. The term "scandalous" has long been given "its ordinary and common meaning," as encompassing material that is "'shocking to the sense of . . . propriety'" or "'offens[ive] to the conscience or moral feelings.'" *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938) (citation omitted). And it is well-established that the USPTO may prove that a mark is scandalous by showing that it is "[v]ulgar." *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971); see *Boulevard Entm't*, 334 F.3d at 1340.[4]

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[4] Pertinent judicial decisions have not given the term "immoral" any meaning independent from the term "scandalous." 15 U.S.C. 1052(a); see *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981) ("not[ing] the dearth of reported trademark decisions in which the term 'immoral' has been directly applied").

Contrary to respondent's contention (Br. 34-35, 42), the USPTO does not allow individual examining attorneys to rely on their own subjective views to determine whether registration of a particular mark is prohibited by the scandalous-marks provision. Instead, whether a mark "is scandalous is to be ascertained from the standpoint of * * * a substantial composite of the general public." *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981). Although respondent is critical (Br. 43-44) of that standard, the public understanding of a mark provides an "objective measure" of the mark's meaning. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). And while respondent faults the USPTO (Br. 44-45) for relying on dictionary definitions, dictionaries are often a reliable indicator of the public understanding of a word. See, *e.g.*, *Taniguchi* v. *Kan Pac. Saipan, Ltd.*, 566 U.S. 560, 567 (2012). Indeed, "dictionary definitions represent an effort to distill the collective understanding of the community with respect to language and thus clearly constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors." *Boulevard Entm't*, 334 F.3d at 1340.[5]

3. Alleged inconsistencies in the application of the scandalous-marks provision (Resp. Br. 38-41) do not establish that the provision is unconstitutionally vague.

Many alleged inconsistencies between agency decisions granting and refusing registration of similar marks can be explained by differences in context and contemporary attitudes. As our opening brief explains

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[5] Although consumer surveys regarding a word's meaning "would no doubt be instructive," *Boulevard Entm't*, 334 F.3d at 1341, the USPTO's "limited resources" make such surveys infeasible in the agency's ex parte examination process, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985).

(at 45-46), the determination whether a mark is scandalous must be made in the context of the goods or services identified in the registration application. See *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012). Because "the same words, placed in different contexts, sometimes mean different things," *Yates* v. *United States*, 135 S. Ct. 1074, 1082 (2015) (plurality opinion), the fact that the same (or similar) words appear in some marks granted registration and other marks refused registration does not, by itself, establish any inconsistency. And because the determination whether a mark is scandalous must be made "in the context of contemporary attitudes," "what constitutes 'immoral ... or scandalous matter' has evolved over time." *Fox*, 702 F.3d at 635 (citations omitted). Those factors make it particularly inappropriate to infer unconstitutional vagueness from purportedly inconsistent registration decisions.

In addition, the purported inconsistencies that respondent and his amici identify are between decisions of individual USPTO examining attorneys, not between precedential decisions of the TTAB. As our opening brief explains (at 47), Congress has established mechanisms for identifying and correcting alleged examiner errors through administrative and judicial review. Those are the same mechanisms that the agency and reviewing courts use to address claims of examiner error in the application of other content-based registration criteria (*e.g.*, the statutory bans on registration of marks that are "merely descriptive" or "functional," 15 U.S.C. 1052(e)(1) and (5)) whose constitutionality has not heretofore been questioned. The alleged inconsistencies that respondent has identified thus provide no sound basis for declaring the scandalous-marks provision facially invalid.

* * * * *

For the foregoing reasons and those stated in our opening brief, the judgment of the court of appeals should be reversed.

Respectfully submitted.

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APRIL 2019

No. 18-302

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

—v.—

ERIK BRUNETTI,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICI CURIAE* OF THE AMERICAN CIVIL LIBERTIES UNION AND THE ACLU OF THE DISTRICT OF COLUMBIA, IN SUPPORT OF RESPONDENT

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INTERESTS OF AMICI CURIAE

The American Civil Liberties Union ("ACLU") is a nationwide, nonprofit, nonpartisan organization with nearly 2 million members and supporters dedicated to the principles of liberty and equality embodied in our nation's Constitution and civil rights laws. Since its founding in 1920, the ACLU has frequently appeared before this Court in First Amendment cases, both as counsel of record and as amicus curiae. To preserve the principle of viewpoint neutrality, the ACLU and its affiliates have appeared in many cases throughout the country. Accordingly, the proper resolution of this case is a matter of substantial interest to the ACLU and its members. The American Civil Liberties Union of the District of Columbia is an affiliate of the national ACLU.[1]

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[1] Letters of consent to the filing of this brief have been lodged with the Clerk of the Court. Pursuant to Supreme Court Rule 37.6, counsel for *amici* state that no counsel for any party authored this brief in whole or in part, and no person or entity other than *amici* made a monetary contribution intended to fund preparation or submission of this brief.

SUMMARY OF ARGUMENT

Less than two years ago, this Court unanimously held that the Lanham Act's registration scheme constitutes government regulation of private speech, and that the government therefore cannot approve or deny trademark registration requests on the basis of viewpoint. In *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Court struck down the Lanham Act's "disparagement clause," which prohibited registration of trademarks that may disparage persons, institutions, beliefs, or national symbols, finding that it impermissibly regulates private speech because the speech "expresses ideas that offend." *Id.* at 1751 (unanimous opinion).

The prohibition against registering trademarks that are deemed "immoral ... or scandalous," 15 U.S.C. § 1052(a) (hereinafter "Section 2(a)" or "scandalous-marks provision"), is no less viewpoint-based. It, too, impermissibly regulates private speech because the speech "expresses ideas that offend." Moreover, the principle that the government may not regulate private expression because it deems it immoral or offensive is a bedrock foundation of the freedom of expression. *Texas v. Johnson*, 491 U.S. 397, 414 (1989). If, as this Court held in *Cohen v. California*, 403 U.S. 15 (1971), the First Amendment bars government officials from penalizing someone for wearing a jacket because officials considered its "Fuck the Draft" message offensive, so, too, the First Amendment prohibits officials from denying registration to Respondent's "FUCT" trademark because they deem it "immoral."

In an attempt to save a statute that, read literally, cannot possibly survive constitutional

scrutiny, the government argues that Section 2(a) can be construed to prohibit "vulgar" marks, and that such a prohibition is viewpoint-neutral. Pet. Br. 27. But the government's own enforcement of Section 2(a) has not been limited to an assessment of whether a mark is "vulgar"; it has considered the morality of the viewpoints expressed. In this very case, the Trademark Trial and Appeal Board denied registration under the challenged provision in part because it determined that Respondent's trademarked goods expressed "misogyny" and "extreme nihilism." In any event, substituting "vulgar" for "scandalous" would not cure Section 2(a)'s infirmity, because denying registration on that basis would still constitute viewpoint discrimination; it would simply enforce the viewpoints of the public that ostensibly deems a mark "vulgar."

Even if Section 2(a) is merely content-based, which the government does not contest, it must satisfy strict scrutiny. Yet the government does not even attempt to make the demanding showing required by both content- and viewpoint-based regulations of private speech. The government asserts three interests, but identifies none of them as "compelling," and makes no claim that the scandalous-marks provision is necessary to further the asserted interests, the showing required by strict scrutiny. Indeed, the nexus between the scandalous-marks provision and any legitimate interest is so tenuous that the provision would not even satisfy intermediate scrutiny.

Section 2(a) is also impermissibly vague. The scandalous-marks provision requires government officials to speculate about what a "substantial composite of the general public" would think about a

particular mark. It provides little, if any, guidance to trademark applicants, and therefore risks causing individuals and businesses to self-censor in choosing their marks. The provision imposes on government regulators the impossible task of speculating about what some hypothetical "composite" of the American public will deem immoral or offensive. And because this is unknowable, the standard affords those regulators unbridled discretion to deny registry to marks on the basis of rank speculation. Here, for example, the Trademark Trial and Appeal Board upheld the denial of registration for Respondent's mark, "FUCT," because, *inter alia*: it is a "phonetic equivalent" of a vulgar word; it would be used on clothing that has a theme of "misogyny" and "extreme nihilism"; and the mark's associated imagery is "lacking in taste." Pet. App. 64a. These are quintessentially subjective, ill-defined, and viewpoint-based determinations. Moreover, the record of Section 2(a)'s enforcement is rife with starkly inconsistent applications, in which the same words have been approved for some marks and rejected for others.

Finally, it is indisputable that the government could not deny copyrights and patents to otherwise eligible works on the basis of a bureaucrat's determination that the work was "scandalous." The same ought to hold true for trademarks. Ruling that the "immoral and scandalous" provision is unconstitutional for the same reasons that the "disparagement" provision is invalid would bring trademark law in line with copyright and patent law, both of which secure intellectual property rights without authorizing or requiring the government to

discriminate on the basis of inescapably subjective content- and viewpoint-based judgments.

ARGUMENT

I. THE LANHAM ACT'S PROHIBITION ON REGISTERING TRADEMARKS THAT INCLUDE "IMMORAL ... OR SCANDALOUS MATTER" IS VIEWPOINT-BASED DISCRIMINATION IN VIOLATION OF THE FIRST AMENDMENT.

In *Matal v. Tam*, this Court unanimously held that "[t]rademarks are private ... speech" and that the government cannot prohibit registration of a trademark on the basis that it may "disparage" any "persons, living or dead." *Tam*, 137 S. Ct. at 1744, 1760 (unanimous opinion). The Court reaffirmed the "bedrock First Amendment principle" that "[s]peech may not be banned on the ground that it expresses ideas that offend." *Id.* at 1751 (unanimous opinion). As Justice Alito wrote, "[g]iving offense is a viewpoint." *Id.* at 1763 (plurality opinion). And, in the words of Justice Kennedy's concurring opinion, "the Government's disapproval of a subset of messages it finds offensive .... is the essence of viewpoint discrimination." *Id.* at 1766 (Kennedy, J., concurring in part).

That logic applies with full force to the scandalous-marks provision, which, like the disparagement clause, allows government officials to refuse to register trademarks they deem offensive. The U.S. Patent and Trademark Office ("PTO") has long understood "immoral ... or scandalous matter" to mean "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable ....

[g]iving offense to the conscience or moral feelings ... [or] calling out [for] condemnation." *In re Riverbank Canning Co.*, 95 F.2d 327, 328–329 (C.C.P.A. 1938); *see also In Re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981) (explaining that "the issue we have to decide . . . is whether the mark "BULLSHIT" comprises matter which gives offense to the conscience or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States"); *In Re Red Bull Gmbh*, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006) (denying registration because the "term 'bullshit' is offensive to the conscience of a substantial composite of the general public"). According to current PTO definitions, "disparaging" marks are those that might offend a particular person or subset of society, while "scandalous" marks are those that might offend "a substantial composite of the general public." *Id.; see also Trademark Manual of Examining Procedure* (TMEP) (Oct. 2018) §§ 1203.01, 1203.03. In short, the provision targets, not a trademark's *subject matter*, but its "immoral," "offensive," or "disgraceful" *viewpoint*.

In enforcing the scandalous-marks provision, the government "is attempting to remove certain ideas or perspectives from a broader debate"—just as its enforcement of the disparagement clause did. *Tam*, 137 S. Ct. at 1767 (Kennedy, J., concurring in part). This is quintessential viewpoint discrimination. If the government cannot deny registration in order to avoid offense to a particular individual or group, it cannot do so to avoid offending the general public—or, more accurately, what some government official deems to be a "substantial composite of the general public." As this Court

announced long ago, "[t]he fact that society may find speech offensive is not a sufficient reason for suppressing it." *FCC v. Pacifica Foundation*, 438 U.S. 726, 745 (1978).

II. THE GOVERNMENT'S ATTEMPT TO NARROW THE SCANDALOUS-MARKS PROVISION TO PROHIBIT ONLY VULGAR MARKS CANNOT SAVE IT.

The government does not even try to defend Section 2(a) as it has been applied by the PTO, to single out for disfavor those trademarks that government officials deem "immoral" or "offensive" to a "substantial composite of the general public." Instead, the government argues that it is constitutional to deny registration to marks that are "vulgar," a term it insists is viewpoint-neutral because it regulates only the "mode of express[ion]." Pet. Br. 27. That reading is inconsistent with the PTO's long record of interpretation and application. And more importantly, the Court's decision in *Cohen v. California*, 403 U.S. 15, makes clear that such a construction would not save the statute. Outside of narrowly circumscribed situations, the state has no business regulating the "morality" or "offensiveness" of private speech.

As an initial matter, while the government's brief in this Court characterizes the mark in this case as vulgar, it has made no representation that application of Section 2(a)'s scandalous-marks provision is limited to vulgar material. Here, the record makes clear that the government refused to register "FUCT" not simply as "vulgar," but also because it was used in ways that the Board thought reflected "misogyny" and "extreme nihilism." Pet.

App. 64a. However objectionable they may be, misogyny and nihilism are both viewpoints, and the government may not regulate private speech because it believes "a substantial composite of the general public" finds it distasteful or offensive.

Moreover, even if the Court were to accept the government's narrowing construction, a prohibition on the registration of vulgar marks would still run afoul of the First Amendment. The government argues that such a prohibition is viewpoint neutral because it suppresses not a viewpoint, but an "especially offensive mode of expression." Pet. Br. 27–28 (quoting *R. A. V. v. City of St. Paul*, 505 U.S. 377, 393 (1992)). But this formulation is itself ultimately viewpoint-based, as it targets not all speech on a general subject matter, but particular marks that it believes the public will view as offensive. It necessarily enforces the majority's *viewpoint* in determining what can and cannot be registered. *See Tam*, 137 S. Ct. at 1763 (plurality opinion) ("Giving offense is a viewpoint."); *id.* at 1766 (Kennedy, J., concurring) (disapproval of "disparaging" marks is the "essence of viewpoint discrimination").

This Court has refused to "indulge the facile assumption that one can forbid particular words," including the word "fuck," "without also running a substantial risk of suppressing ideas in the process." *Cohen*, 403 U.S. at 26 (holding that government could not punish an individual for wearing a "Fuck the Draft" jacket in a courthouse). Otherwise, "governments might soon seize upon the censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* In addition, such a prohibition would unduly inhibit the important "emotive function" of speech, *id.*, and

would offer no limiting principle for stopping short of "cleans[ing] public debate to the point where it is grammatically palatable to the most squeamish among us." *Id.* at 25. Turning to the word "fuck" itself, the Court in *Cohen* held that "while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric." *Id.* This reasoning forecloses the government's arguments that limiting the scandalous-marks provision to prohibit only the registration of vulgar marks would cure its constitutional infirmity.

This Court's narrow acceptance of prohibitions on vulgarity in the specific settings of radio broadcasts, *see Pacifica*, 438 U.S. at 748, and school assemblies, *see Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675 (1986), does not alter this conclusion. In each case, the Court took pains to limit its holding to a specific context involving children, intrusions into the privacy of the home, or both. In *FCC v. Pacifica*, the Court expressly restricted its decision to the radio broadcast context, which "has received the most limited First Amendment protection," both because it intrudes upon "the privacy of the home, where the individual's right to be left alone plainly outweighs the First Amendment rights of an intruder" and because it "is uniquely accessible to children." 438 U.S. at 748–49. As the court below held, "[t]he government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*." Pet. App. 37a.

Similarly, in *Bethel*, the Court limited its holding to the school setting, noting that the "rights of students in public school are not automatically coextensive with the rights of adults in other settings." 478 U.S. at 682. Neither case can be read as justifying the regulation of offensive speech outside those contexts. Indeed, the Court in *Bethel* expressly distinguished *Cohen* by noting the limited rights of students. *Id.* at 692 n.2. And in *Cohen* itself, the Court refused to countenance similar restrictions on an adult's speech on government property, even though the government invoked the "presumed presence of unwitting listeners or viewers." 403 U.S. at 21. The Court cautioning that to do otherwise "would effectively empower a majority to silence dissidents simply as a matter of personal predilections." *Id.*[2]

Thus, even if the scandalous-marks provision could be rewritten to prohibit only vulgar trademarks, it would be unconstitutional.

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[2] Nor are the Court's cases addressing obscenity and sexually explicit entertainment zoning relevant. Obscenity is a form of unprotected speech. And the zoning of sexually explicit entertainment has turned on considerations of "secondary effects" rather than the perceived offensiveness of the expression. *See, e.g., Miller v. California*, 413 U.S. 15, 24 (1973) (obscenity); *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41 (1986) (zoning of adult movie theaters).

III. EVEN IF THE SCANDALOUS-MARKS PROVISION WERE DEEMED VIEWPOINT-NEUTRAL, IT COULD NOT PASS CONSTITUTIONAL MUSTER.

The scandalous-marks provision fails First Amendment scrutiny whether it is deemed viewpoint-based or merely content-based. While the government labors mightily to characterize the provision as viewpoint-neutral, it does not dispute that the provision is content-based. Pet. Br. 19. But strict scrutiny applies to both content- and viewpoint-based regulations of speech. "Content-based regulations are presumptively invalid." *R. A. V.* 505 U.S. at 382; *see also Police Dep't of Chicago v. Mosley*, 408 U.S. 92, 95 (1972). "For the state to enforce a content-based exclusion it must show that its regulation is necessary to serve a compelling state interest and that it is narrowly drawn to achieve that end." *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983). Yet remarkably, the government does not even argue that the scandalous-marks provision can survive strict scrutiny. *See* Pet. Br. 19–30.

Instead, it applies only lenient scrutiny and asserts three interests that it maintains are "substantial" (and notably, not "compelling") and are advanced by the provision (and again notably, not "necessary" to further the asserted interests). Pet. Br. 16. The government invokes interests in: (1) "protecting the sensibilities of the public," *id.* at 32, (2) preserving "the orderly flow of commerce," *id.* at 33–34, and (3) "avoiding any appearance that the government approves of such marks," *id.* at 34. None of these justifications satisfies strict scrutiny. The first and third interests are affirmatively

impermissible bases for regulating the speech of adults, and denying registration to scandalous marks is by no means "necessary" to further the second interest in an orderly flow of commerce.

The government first maintains that "Congress has a legitimate interest in encouraging the use of trademarks that are appropriate for all audiences, including children." Pet. Br. 33. But as noted above, the Court in *Cohen* already rejected limiting adult speech in public on the ground that children may be present. *Cohen*, 403 U.S. at 21. The government "may not reduce the adult population to only what is fit for children." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 875 (1997) (internal quotation marks and alterations omitted). As this Court warned in *Tam*, the government's interest in denying registration to marks that may be offensive to some audiences "strikes at the heart of the First Amendment." *Tam*, 137 S. Ct. at 1764 (plurality opinion). Indeed, "[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. at 414. The government's purported interest in "protecting the sensibilities of the public" is just another way of saying speech should be prohibited because society finds the idea expressed disagreeable.

The second interest, preserving an "orderly flow of commerce," may be legitimate, but the government has not made any showing that denying registration to "immoral" trademarks is the least restrictive means, let alone necessary, to further that interest. Indeed, the government makes no showing

that marks like Respondent's have any impact whatsoever on the orderly flow of commerce. Such marks can be used without registration, yet the government has offered not even a single anecdote to show how they have disrupted commerce. And as shown in the following section, the PTO has registered many marks that are indistinguishable from marks that other PTO officials have deemed "scandalous"—again, without any showing that their registration disrupted commerce.

The government's third interest—avoiding the appearance that it approves of the message of registered trademarks—was rejected in *Tam*, There, this Court squarely held that trademarks are private, not government, speech, *Tam*, 137 S. Ct. at 1760 (unanimous opinion), and noted that "[t]he PTO has made it clear that registration does not constitute approval of a mark." *Id.* at 1759 (unanimous opinion). As a result, "it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means." *Id.*

The government seeks to evade strict scrutiny by invoking inapposite doctrines governing at public universities, government subsidies, and commercial speech. Pet. Br. 19–23. But none of these doctrines is applicable here, where the government seeks to regulate private speech in the general marketplace of ideas because it deems it immoral.

First, the scandalous-marks prohibition is not associated with the running of a public university. The Court's rulings in the public university cases are "shaped by the educational context in which [they] arise[ ] ... : First Amendment rights ... must be analyzed in light of the special characteristics of the

school environment." *Christian Legal Soc'y Chapter of the Univ. of Cal. Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 685–86 (2010) (quoting *Widmar v. Vincent*, 454 U.S. 263, 267 n. 5 (1981) (internal quotation marks omitted)). Those characteristics are not present here, where the government seeks to regulate private speech irrespective of where it is expressed.

Second, as four Justices agreed in *Tam*, the government subsidy cases—including *Rust v. Sullivan*, 500 U.S. 173 (1991), *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983), and *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 570 U.S. 205 (2013)—are also inapposite.[3] "The federal registration of a trademark is nothing like the [subsidy] programs at issue in th[o]se cases." *Tam*, 137 S. Ct. at 1761 (plurality opinion). Likewise, *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) and *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007), "occupy a special area of First Amendment case law, and they are far removed from the registration of trademarks." *Tam*, 137 S. Ct. at 1762 (plurality opinion).[4]

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[3] Section III-B of Justice Alito's decision, addressing the applicability of government subsidy cases to trademark registration, was not joined by Justice Kennedy on the ground that it was not necessary to resolve the issue before the Court. *See Tam*, 137 S. Ct. at 1765 (Kennedy, J., concurring in part).

[4] Section III-C of Justice Alito's opinion was joined by Chief Justice Roberts, and Justices Thomas and Breyer. Justice Kennedy's concurrence in part, which was joined by Justices Ginsburg, Sotomayor and Kagan, declined to address whether the trademark registration scheme is subject to lesser scrutiny, reasoning that the disparagement clause constituted viewpoint-discrimination and was therefore unconstitutional regardless of

Third, this is not a regulation of commercial speech, as the scandalous-marks provision regulates nothing commercial about the mark. *See Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980). It regulates trademarks on the basis of their perceived "immorality," wholly unrelated to any commercial regulatory interest. *See Tam*, 137 S. Ct. at 1763 (plurality opinion). The commercial speech doctrine's intermediate scrutiny is predicated on the government's regulation of commercial transactions. Laws that do not serve that interest are not properly subject to commercial speech analysis. Thus, a law that denied registration to "liberal" or "conservative" marks would not be subject to intermediate review, even though it, too, would regulate marks used to sell goods. Where the government's interest is not in regulating commerce, the commercial speech doctrine does not apply.

In any event, the scandalous-marks provision would fail even intermediate scrutiny, because it is not "narrowly drawn" to serve a "substantial interest." *Central Hudson*, 447 U.S. at 564–65. Justice Alito's plurality opinion in *Tam* explained that "the disparagement clause [could not] withstand even *Central Hudson* review" because the clause is "far too broad" and because "[if] affixing the commercial label permits the suppression of any speech that may lead to political or social 'volatility,' free speech would be endangered." *Tam*, 137 S. Ct at 1764–65 (plurality opinion).

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the level of scrutiny applied. *See Tam*, 137 S. Ct. at 1765–69 (Kennedy, J., concurring in part).

IV. THE SCANDALOUS-MARKS PROVISION IS UNCONSTITUTIONALLY VAGUE.

The scandalous-marks provision is also unconstitutionally vague. *See* Pet. App. 40a n.6, 41a. Where a law is both content-based and vague, it creates an "obvious chilling effect." *Reno*, 521 U.S. at 871–72. That is plainly the case here.

This Court has examined statutes that vest unbridled discretion to regulate speech under both the First Amendment and the Due Process Clause. "It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). The requirement of clarity is especially stringent when a law interferes with First Amendment rights. *See Keyishian v. Bd. of Regents*, 385 U.S. 589, 604 (1967). The Constitution requires the government to define restrictions on speech with clarity both to ensure procedural fairness and to avoid chilling speech.

Section 2(a) provides little practical guidance to the PTO as to the meaning of "scandalous," or "immoral," leading to a long line of arbitrary and contradictory decisions. The TMEP states that in evaluating whether a mark is scandalous, trademark examiners should consider the potential offensiveness of a mark to a "substantial composite of the general public." TMEP § 1203.01. But the manual offers no further guidance as to how to identify such a "substantial composite," much less how to discern what that "composite" thinks is scandalous or offensive. It effectively requires the examiner to guess at an entirely hypothetical audience's reaction to a particular mark. The

legislative history of the Lanham Act provides no further explanation. While it is sometimes the case that "[a] term that appears vague on its face may derive much meaningful content from the purpose of the Act, its factual background, and the statutory context," *Thomas v. Union Carbide Agric. Prods. Co.*, 473 U.S. 568, 593 (1985) (citation and quotation marks omitted), no such purpose, background, or context helps to clarify Section 2(a). *See* TMEP § 1203.1.

The lack of clear standards is exemplified by the PTO's long history of bizarre and contradictory enforcement of the scandalous-marks provision: The very same terms have been granted registration in one case and denied in another, with no seeming continuity of logic. For example:

- The PTO rejected FUCT for use on clothing,[5] but registered "FAUQ Yeah!" for leisure wear associated with a bakery.[6]
- The PTO rejected "Hot Shitz" for use on food seasonings, [7] but registered "DEMSHITZ" for a water sports website and blog.[8]

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[5] U.S. Trademark Application Serial No. 74368986 (originally filed Mar. 18, 1993).

[6] Registration No. 5282969.

[7] U.S. Trademark Application Serial No. 88101544 (Filed Aug. 31, 2018). Consideration of this application has been suspended pending the outcome of this case.

[8] Registration No. 4129054.

- The PTO rejected "The Complete A**hole's Guide To . . ." as a trademark for a series of books providing information relating to advice, counseling, self-help, and humor,[9] but registered "Managing Your Inner A**hole," for books on the development of emotional intelligence.[10]
- The PTO rejected "Wanker" for use on clothing,[11] but registered it for use on beer.[12]
- The PTO rejected "Titmouse" for use on computer cursor control devices,[13] but registered "TitmouseInc." for animation production services.[14]
- The PTO rejected "Pussy Power" as a mark for entertainment services,[15] but accepted "PussyPowerRevolution" for

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[9] U.S. Trademark Application Serial No. 76,351,811 (filed Dec. 21, 2001).

[10] U.S. Trademark Application Serial No. 85,711,056 (filed Aug. 23, 2012) (not registered on other grounds).

[11] U.S. Trademark Application Serial No. 78,610,369 (filed Apr. 16, 2005).

[12] Registration No. 2,036,108.

[13] U.S. Trademark Application Serial No. 78,954,967 (filed Aug. 18, 2006).

[14] Registration No. 4,624,689.

[15] U.S. Trademark Application Serial No. 77,387,209 (filed Feb. 2, 2008).

use on clothing.[16]

In light of this decisional patchwork, no trademark applicant can ever be on notice as to what words or ideas will trigger PTO rejection. The PTO's sole limiting principle in applying Section 2(a) requires an examining attorney who believes a pending trademark is scandalous or immoral to "consult with his or her supervisor" if she believes, "for whatever reason, that a mark may be considered to comprise such matter," in order to "ensure consistency in examination with respect to immoral or scandalous matter." TMEP § 1203.01. But as the examples above make clear, having two people speculate about hypothetical audiences' subjective reactions to ostensibly "immoral" speech does nothing to cure the fundamental problem that a vague standard presents. The only thing that is consistent about the PTO's application of the scandalous-marks clause is its inconsistency.

Furthermore, the PTO's perpetual ability to revisit the offensiveness of existing trademarks and revoke them at any time magnifies the problems of insufficient notice and chilling effect. Applicants not only have to guess what the PTO may find scandalous or immoral today, but also what it may find objectionable years from now—long after substantial resources have been invested in establishing a recognizable mark. Those who wish to register a mark must therefore make their best guess about how to survive the timeless gauntlet of Section 2(a)'s moral judgment—by self-censoring.

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[16] Registration No. 4,507,246.

What may be deemed acceptable today may become scandalous tomorrow. For example, the word "occupy" had a strong sexual connotation in the 17th and 18th centuries, but it no longer carries that meaning.[17] In general, Americans seem to have grown more accepting of the use of profanity.[18] But terms commonly used to describe members of minority groups in the past are often deemed deeply offensive today. Therefore, in evaluating trademark applications against the scandalous-marks provision, the PTO is forced to measure the anticipated reaction of a substantial portion of the general public on an issue that is shifting over time.

Accordingly, Section 2(a) is impermissibly vague and grants government power to regulate without sufficient guidance, resulting in inconsistent and unconstitutional administrative action.

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[17] Merriam-Webster Dictionary, *occupy*, https://www.merriam-webster.com/dictionary/occupy (last visited Mar. 19, 2019).

[18] See Jean M. Twenge, Hannah VanLandingham, & W. Keith Campbell, *The Seven Words You Can Never Say on Television: Increases in the Use of Swear Words in American Books, 1950–2008*, SAGE Open (2017), https://journals.sagepub.com/doi/pdf/10.1177/2158244017723689.

V. INVALIDATING THE SCANDALOUS-MARKS PROVISION WOULD BRING TRADEMARK LAW IN LINE WITH COPYRIGHT AND PATENT LAW, WHERE VIEWPOINT-BASED "MORALITY" JUDGMENTS PLAY NO ROLE.

Declaring the scandalous-marks provision unconstitutional requires no extension of existing jurisprudence in light of this Court's decisions in *Tam* and *Cohen*. The government should not be in the business of regulating private speech based on assessments about whether it will be deemed "offensive" or "immoral," but should leave those judgments to the marketplace. Such a holding will bring trademark law into line with two other areas of intellectual property regulation—copyright and patent law—both of which secure intellectual property rights without authorizing government officials to make *ad hoc* and inevitably speculative judgments about the moral acceptability of private speaker's viewpoints.

As copyright law demonstrates, offensive ideas promulgated by private individuals are not incompatible with a sound regime for regulating intellectual property. To the contrary, other intellectual property regimes rightly refuse to draw viewpoint- or content-based distinctions about morality. "Congress has enacted two statutory copyright restrictions that were arguably content based, but afterwards repealed them." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 855 n.4 (5th Cir. 1979); *see also, e.g., Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (1977) (reversing the morality-based rejection of a patent for

a slot machine). "The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court" asked to determine whether a given expression is morally worthy of copyright protection would be "staggering to contemplate." *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973). In requiring government officers to make necessarily subjective judgments about the moral acceptability of private viewpoints, Section 2(a)'s regulation of trademarks is a clear outlier. *See Mitchell Bros.*, 604 F.2d at 855 n.4; *Belcher*, 486 F.2d at 1088.

While many copyrighted works are undoubtedly offensive to some subset of society, the government wisely leaves such judgments to the marketplace of ideas. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (Holmes, J.) (declining to become the "final judges of the worth of" any particular expressions, instead entrusting that decision to the public marketplace). That is precisely what the First Amendment demands here as well.

CONCLUSION

For the reasons stated above, this Court should hold that the portion of Section 2(a) barring the registration of "immoral ... or scandalous" trademarks is unconstitutional.

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No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter." The question presented is as follows:

Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

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STATEMENT OF INTEREST

The American Intellectual Property Law Association ("AIPLA"),[1] which files this brief with the written consent of both parties,[2] is a national bar association of approximately 13,500 members engaged in private and corporate practice, government service, and academia. AIPLA's members represent a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. AIPLA's mission includes providing courts with objective analyses to promote an intellectual property system that stimulates and rewards invention, creativity, and investment while accommodating the public's interest in healthy competition, reasonable costs, and basic fairness. AIPLA has no stake in any of the parties to this liti-

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[1] In accordance with Supreme Court Rule 37.6, AIPLA states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than AIPLA and its counsel. Specifically, after reasonable investigation, AIPLA believes that: (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to the litigation in this matter; (ii) no representative of any party to this litigation participated in the authorship of this brief; and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

[2] Pursuant to Supreme Court Rule 37.3(a), AIPLA has obtained the consent of the parties to file this amicus brief.

gation or in the result of this case. AIPLA's only interest is in seeking correct and consistent interpretation of the law as it relates to intellectual property issues.

SUMMARY OF ARGUMENT

The court of appeals properly invalidated the Lanham Act's prohibition on the registration as a trademark or service mark of immoral and scandalous matter under the Free Speech Clause of the First Amendment. This is so for two reasons. First, the prohibition has a viewpoint-discriminatory effect because the government often has applied it in a manner dependent on the approval or disapproval of the expressive content of particular marks or of the businesses in which their owners are engaged. Second, even if the prohibition constitutes mere content discrimination, it cannot pass intermediate scrutiny under *Central Hudson Gas & Electric Corp. v. Public Service Comm'n of New York*, 447 U.S. 557 (1980).

ARGUMENT

I. BACKGROUND

As this Court properly has recognized, "[f]ederal registration . . . 'confers important legal rights and benefits on trademark owners who register their marks.'" *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) (quoting *B & B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1299 (2015)). Nevertheless, the door to registration is not open to all marks. Instead Sections 2(a)-(e) of the Lanham Act, 15 U.S.C. § 1052(a)-(e), set forth a number of substantive grounds on which examiners within the U.S. Patent

and Trademark Office ("USPTO") must reject applications to register particular marks.[3]

Those substantive prohibitions include Section 2(a)'s bar on the registration of marks comprising "immoral . . . or scandalous matter." *Id.* § 1052(a). That prohibition originated in Section 5(a) of the Trademark Act of 1905, Pub. L. No. 489, 33 Stat. 724 (1905), which mandated the rejection of applications to register the same categories of applied-for marks. In 1946, Congress reenacted it as part of the Lanham Act, at which time Congress also adopted the prohibition on potentially disparaging marks invalidated by this Court in *Tam*.

In this case, the USPTO rejected Respondent's application to register the FUCT mark for various items of clothing as impermissibly scandalous, and the Trademark Trial and Appeal Board affirmed that refusal. As the Board summarized the record before it, "we have no doubt but that the word 'fuck' continues correctly to be characterized as 'offensive,' 'extremely offensive,' 'highly offensive,' 'intentionally offensive,' an 'obscenity,' 'vulgar slang,' the 'f-bomb,' and at the root of a number of other twisted and angry expressions." *In re Brunetti*, No. 85310960, 2014 WL 3976439, at *3 (T.T.A.B. Aug. 1, 2014) (footnote omitted), *rev'd*, 877 F.3d 1330 (Fed. Cir. 2017), *cert.*

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[3] In addition to the substantive prohibitions on registration set forth in Sections 2(a)-(e), USPTO examiners can reject applications failing to comply with various purely technical requirements. *See, e.g.*, *In re Anpath Grp.*, 95 U.S.P.Q.2d 1377 (T.T.A.B. 2010) (affirming refusal to register mark based on applicant's failure to submit adequate specimen demonstrating applicant's use of applied-for mark).

granted sub nom. Iancu v. Brunetti, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019). The court of appeals sustained that determination by the Board, but it held the statutory basis for the refusal of Respondent's application invalid under the First Amendment because "the provision impermissibly discriminates based on content in violation of the First Amendment." *In re Brunetti*, 877 F.3d 1330, 1341 (Fed. Cir. 2017), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019). The court of appeals additionally "question[ed] the viewpoint neutrality of the immoral or scandalous provision," *id.*; although the court ultimately did not resolve that issue, the parties addressed it at length at the petition stage, and the government's opening brief does the same.

II. PROHIBITION ON REGISTRATION OF IMMORAL OR SCANDALOUS MARKS VIOLATES FIRST AMENDMENT

The court of appeals properly recognized that this Court's decisions establish two categories of government restrictions on, or regulation of, protected speech: those that are content-based, on the one hand, and those that are viewpoint-based, on the other. It also properly recognized that the latter is a subcategory of the former and is highly disfavored under the First Amendment. *See generally Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). Although AIPLA does not take a position on whether the USPTO correctly classified Respondent's mark as scandalous, it respectfully submits that the statutory prohibition triggered by that classification cannot survive First Amendment scrutiny, regardless of

whether the prohibition is viewpoint discriminatory or content discriminatory.

A. The Prohibition Is an Impermissible Viewpoint-Based Restriction

Applications of the prohibition on the registration of marks that are "scandalous" or "immoral" traditionally have not distinguished between the two concepts in any material way. *See, e.g.*, *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) ("Because of our holding . . . that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark [also] is 'immoral.'"). Rather, "[a]lthough the words 'immoral' and 'scandalous' have slightly different connotations, case law has included immoral matter in the same category as scandalous matter." United States Patent and Trademark Office, *Trademark Manual of Examining Procedure* § 1203.01 (Oct. 2018); *see also McGinley*, 660 F.2d at 484 ("We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied.").

A two-step process governs evaluations of the degree of scandal attaching to a particular applied-for mark:

> The PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. [Second], whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority),

> and in the context of contemporary attitudes, keeping in mind changes in social mores and sensitivities.

In re Boulevard Entm't, Inc., 334 F.3d 1336, 1340 (Fed. Cir. 2003) (citation omitted).

Both before and after the development of this doctrinal test, applications of the prohibition on federal registration of scandalous marks have focused on the extent to which an applied-for mark is offensive.

For example, in *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938), the Court of Customs and Patent Appeals equated "scandalous" with "offensive" and "giving offense" while affirming the denial of registration to MADONNA as a mark for wine under Section 5(a) of the 1905 Act. *Id.* at 328-29. In contrast, the Trademark Trial and Appeal Board has reversed a refusal to register WEEKEND SEX as a mark for a magazine after finding it "not so offensive to the public sense of propriety or morality as to preclude registration thereof under the provisions of Section 2(a)." *In re Madsen*, 180 U.S.P.Q. 334, 335 (T.T.A.B. 1973).[4] This equivalence of scandalousness

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[4] *See also In re Red Bull GmbH*, Serial No. 75788830, 78 U.S.P.Q.2d 1375, 1382 (T.T.A.B. 2006) (affirming refusal to register BULLSHIT mark for energy drinks because "the evidence of record is sufficient to establish prima facie that the term 'bullshit' is offensive to the conscience of a substantial composite of the general public"); *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1933 (T.T.A.B. 1996) (affirming refusal to register mark consisting in part of stylized male genitalia after "ascrib[ing] offensive or vulgar significance to it"); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1221 (T.T.A.B. 1993) (reversing refusal to register OLD GLORY CONDOM CORP mark for condoms after framing inquiry as "whether the mark is offensive or shocking");

and offensiveness is consistent with the statutory language because that equivalence was reflected in dictionary definitions extant at the time of the Lanham Act's passage. *See McGinley*, 660 F.2d at 486 (citing circa-1940s dictionary definitions equating "scandalous" with "offensive" in affirming refusal to register a mark comprising "a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia" for a newsletter).[5]

As the USPTO's treatment of Respondent's application in this case demonstrates, offensiveness is

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In re Leo Quan, Inc., 200 U.S.P.Q. 370, 371 (T.T.A.B. 1978) (reversing refusal to register BADASS mark for bridges for stringed instruments as "giv[ing] no offense to morality nor rais[ing] scandal"); *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176, 178 (T.T.A.B. 1978) (defining "scandalous" by referring to in part as "that which offends established moral conception or disgraces all who are associated or involved"); *In re Runsdorf*, 171 U.S.P.Q. 443, 443 (T.T.A.B. 1971) (affirming refusal to register BUBBY TRAP mark for brassieres as "offensive to a segment of the public sense of proprietary or morality"); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275, 275 (T.T.A.B. 1968) (affirming refusal to register MESSIAS mark for wine and brandy as, *inter alia*, "offensive" and "giving offense to the conscience or moral feelings").

[5] *See also In re Hershey*, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. 1988) (citing dictionary definitions equating "scandalous" with "offensive" in reversing refusal to register BIG PECKER mark for T-shirts); *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863, 864 (T.T.A.B. 1981) (citing dictionary definitions in affirming refusal to register BULLSHIT mark for "accessories of a personal nature, and wearing apparel, namely: attache cases, handbags, purses, belts, and wallets" after finding it "comprises matter which gives offense to the conscious or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States").

not the only standard applied by the USPTO. Some reported opinions hold that "the PTO may prove scandalousness by establishing that a mark is 'vulgar,'" *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012).[6] Another has held that marks "shocking to the sense of propriety" qualify as scandalous, *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156, 156 (Exam'r in Chief 1938), and the Trademark Trial and Appeal Board has refused registration of at least one mark other than Respondent's as "obscene." *See In re Luxuria, s.r.o.*, 100 U.S.P.Q.2d 1146, 1150 (T.T.A.B. 2011) (affirming refusal to register shape of "a bottle in the shape of a hand with middle finger extended upwards" for beer after finding "the evidence shows that the finger gesture that comprises applicant's mark is treated as obscene in general, not as offensive only to the person to whom it is directed").[7] The USPTO's treatment of Respondent's application is thus a representative example of the agency's varying standards in refusing applications on this basis.

Nevertheless, the pervasive focus on offensiveness as the primary benchmark in interpretations of the prohibition at issue places that prohibition

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[6] *See also In re Michalko*, 110 U.S.P.Q.2d 1949, 1951 (T.T.A.B. 2014) (affirming refusal to register ASSHOLE REPELLANT mark for a novelty aerosol product and observing that "[t]o prove that the mark . . . is scandalous, it is sufficient if the Examining Attorney shows that the term is vulgar").

[7] *But see Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. 481, 482 (Exam'r in Chief 1952) (reversing refusal to register ORGASM mark for perfume because "when used in ordinary writing or speech, particularly among the class of persons who would be apt to use such a word, it would be considered shocking or offensive, or obscene").

squarely within this Court's case law proscribing viewpoint-discriminatory government action. This is so because applications of the prohibition can and do vary with the government's views of the context in which an applied-for mark is used.

That variability was established under interpretations of Section 5(a) of the 1905 Act and is apparent in *Riverbank Canning*. The *Riverbank Canning* court did not affirm a refusal to register the MADONNA mark at issue in that case because the mark was itself immoral or scandalous *per se*. 95 F.2d at 328 ("Of course, the word 'Madonna' is not per se scandalous."). Instead, the word only became unregistrable when used as a trademark for wine. As the court explained, "we feel certain that its use upon wine for beverage purposes would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it; therefore, we think such use of the word 'Madonna' would be scandalous and its registration prohibited . . . ." *Id.* at 329. Other interpretations of Section 5(a) of the 1905 Act and Section 2(a) of the Lanham Act are to similar effect, namely, that the message conveyed by an applied-for mark may be benign and registrable in one context but scandalous and unregistrable in another.[8]

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[8] *See, e.g.*, *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1588 (T.T.A.B. 2008) (affirming refusal to register SEX ROD mark and observing that "the use of the term on children's and infant clothing makes the term particularly lurid and offensive"); *Sociedade Agricola E. Comerical Dos Vinhos Messias*, 159 U.S.P.Q. at 276 (affirming refusal to register MESSIAS (messiah) mark when used in connection with wine and brandy); *In re P.J. Valckenberg, GmbH.*, 122 U.S.P.Q. 334, 334-35 (T.T.A.B. 1959) (affirming refusal to register MADONNA

Moreover, the contrary also is true. An applied-for mark that might otherwise be scandalous *per se* when used in connection with particular goods can pass scrutiny under Section 2(a) when used with other goods. For example, in *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1971), the USPTO initially refused an application to register the ACAPULCO GOLD mark based in part on the perception the mark was a commonly recognized reference to marijuana. Taking into account the goods sold under the mark, however, the Trademark Trial and Appeal Board held to the contrary that "in our opinion, to the average purchaser of suntan lotion in the normal marketing milieu for such goods the term 'ACAPULCO GOLD' would suggest the resort city of Acapulco, noted for its sunshine and climatic attributes rather than marijuana." *Id.* at 512.

Of greater consequence to the viewpoint-discriminatory effect of this prohibition on registration is *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993), in which the USPTO initially refused to register the following mark for condoms:

Although the Trademark Trial and Appeal Board ultimately reversed the refusal to register, a significant

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mark when used in connection with wine); *Martha Maid Mfg. Co.*, 37 U.S.P.Q. at 156 (affirming refusal to register QUEEN MARY mark for women's undergarments).

consideration underlying that outcome was the message conveyed by the applicant's marketing program:

> Here, applicant markets its condoms in packaging which emphasizes applicant's commitment to the sale of high quality condoms as a means of promoting safer sex and eliminating AIDS and its belief that the use of condoms is a patriotic act. . . . [T]he seriousness of purpose surrounding the use of applicant's mark — a seriousness of purpose made manifest to purchasers on the packaging for applicant's goods — is a factor to be taken into account in assessing whether the mark is offensive or shocking.

Id. at 1221.

The USPTO's practice of conditioning the registrability of marks on its approval of the mark owner's intended message[9] demonstrates that enforcement of the prohibition at issue can and sometimes does turn on "the specific motivating ideology or the opinion or perspective of the speaker." *Rosenberger*, 515 U.S. at 829. Whether the message is in the mark itself or elsewhere in the application's history,

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[9] An example of that practice working to the applicant's disadvantage appears in *In re Boulevard Entm't, Inc.*, No. 75414435, 2002 WL 1258274 (T.T.A.B. June 5, 2002), *aff'd*, 334 F.3d 1336 (Fed. Cir. 2003), in which the Trademark Trial and Appeal Board affirmed a Section 2(a)-based refusal to register because "[i]n [*Old Glory*] . . . , the Board pointed to the seriousness of purpose surrounding the use of applicant's mark as a campaign to prevent AIDS. Such a situation does not exist herein." *Id.* at *6.

government action such as this constitutes presumptively invalid viewpoint discrimination. *See id.* ("It is axiomatic that the government may not regulate speech based on its substantive content or the message it conveys."). For example, in *Tam*, all eight participating Justices of this Court concluded that the closely similar prohibition on the registration of potentially disparaging marks, 15 U.S.C. § 1052(a), constituted impermissible viewpoint discrimination. Justice Alito's four-Justice opinion noted, "[the prohibition] denies registration to any mark that is offensive to a substantial percentage of the members of any group. But in the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint." 137 S. Ct. at 1763 (Alito, J.). Justice Kennedy's four-Justice opinion similarly concluded that "[t]he law . . . reflects the Government's disapproval of a subset of messages it finds offensive. This is the essence of viewpoint discrimination." *Id.* at 1766 (Kennedy, J.).

Although dividing the Court on a four-to-four basis, each of those opinions is consistent with this Court's broader First Amendment jurisprudence, which has at times applied an offensiveness-based standard to hold statutory limits on speech constitutionally infirm *per se*.[10] One of those opinions suggested that "viewpoint discrimination occurs when

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[10] For example, the invalidation of the municipal ordinance in *Coates v. City of Cincinnati*, 402 U.S. 611 (1971), did not turn on the city's targeting of only particular views on a particular subject; rather, that result held because the ordinance prohibited the assembly of individuals whose conduct was "annoying" to passers-by. *See id.* at 615 ("Our decisions establish that mere

the government intends to suppress a speaker's beliefs, but viewpoint discrimination need not take that form in every instance." *Tam*, 137 S. Ct. at 1766–67 (Kennedy, J.) (citation omitted)). There is no doubt, however, that restrictions triggered by the government's disapproval of the message conveyed by a mark only in certain contexts are disfavored and presumptively unconstitutional. In *Rosenberger*, this Court explained that:

> It is axiomatic that the government may not regulate speech based on its substantive content or the message it conveys. . . . When the government targets not subject matter, but particular views taken by speakers on a subject, the violation of the First Amendment is . . . blatant.

Rosenberger, 515 U.S. at 830; *see also Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

It is no answer, as the government suggests, that the refusal to register an applied-for mark does not affirmatively prohibit the mark's use. This Court has long held under the unconstitutional conditions doctrine that:

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public intolerance or animosity cannot be the basis for abridgment of these constitutional freedoms.").

> [E]ven though a person has no "right" to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.

Perry v. Sindermann, 408 U.S. 593, 597 (1972); *see also 44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 513 (1996) ("Even though the government is under no obligation to provide a person, or the public, a particular benefit, it does not follow that conferral of the benefit may be conditioned on the surrender of a constitutional right.").

The prohibition likewise cannot be justified as an exercise of Congress's plenary spending power. Although the government asserts the registration system reflects targeted subsidies of favored marks, Section 2's structure does not bear that theory out. Instead, Section 2's preamble provides that "[n]o [distinctive] trademark . . . shall be refused registration on the principal register on account of its nature unless," with the following subsections specifically excluding particular applied-for marks. This approach brings Section 2 squarely within the scope of this Court's past decisions disapproving of the extension of government benefits to a broad class of recipients but purposefully excepting certain categories of potential recipients. *See, e.g.*, *Ark. Writers' Project, Inc. v. Ragland*, 481 U.S. 221, 232-33 (1987) (invalidating

state sales tax scheme exempting newspapers and religious, professional, trade, and sports journals but taxing general interest magazines); *cf. Dept. of Agric. v. Moreno*, 413 U.S. 528, 533-38 (1973) (invalidating scheme of allocating benefits in light of impermissible legislative intent to burden class of recipients comprising suspected hippies). Of equal importance, because the USPTO's trademark-related operations are financed through user fees, applicants for registration receive only what they themselves pay for, and this Court has never extended the subsidy doctrine to situations not involving financial benefits. *See Autor v. Pritzker*, 740 F.3d 176, 183 (D.C. Cir. 2014).

The court of appeals therefore correctly questioned the validity of Section 2(a)'s viewpoint-discriminatory prohibition on the registration of immoral and scandalous marks, and this Court should answer that question by invalidating the prohibition.

B. Even If the Prohibition Is Merely a Content-Based Restriction, It Cannot Survive Scrutiny

Although the registration prohibition at issue is invalid as viewpoint-discriminatory, there are two additional reasons why this Court should affirm the court of appeals even if the prohibition constitutes mere content discrimination. First, the court of appeals properly recognized that this Court's opinion in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557 (1980), provides the proper framework for evaluating the prohibition's constitutionality under a content-discrimination rubric. And, second, the court of appeals reached

the correct conclusion in an application of that framework. Be that as it may, it important to point out that the correctness of that conclusion does not call into question the validity of the remaining prohibitions in Section 2 under the First Amendment.

In *Central Hudson*, this Court held that the content-discriminatory regulation of commercial speech is subject to a lesser form of scrutiny (as opposed to the presumptive unconstitutionality of a viewpoint-discriminatory government action). Specifically, and assuming the speech in question concerns lawful activity and is not misleading, government action can survive First Amendment scrutiny if it reflects a substantial government interest, it directly advances that interest, and it is no more extensive than necessary. *Id.* at 566. Although neither the Court's opinion nor the two four-four opinions in *Tam* necessarily endorsed the application of *Central Hudson* to the trademark registration process, courts in addition to the court of appeals in this case routinely have invoked that case when weighing the constitutionality of content-based government restrictions on particular marks. *See, e.g., Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 101 (2d Cir. 1998); *Sambo's Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981); *Hornell Brewing Co. v. Brady*, 819 F. Supp. 1227, 1239 (E.D.N.Y. 1993).

With respect to the first step in the *Central Hudson* analysis, and as reflected in the history of the application for registration at issue, the classification of a mark as obscene will render the mark impermissibly immoral or scandalous. Nevertheless, the con-

verse is not true, because obscenity is not a prerequisite for a finding of immorality or scandal. *See McGinley*, 660 F.2d at 485 n.9 ("[T]he threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene' . . . ."); *see also Brunetti*, 877 F.3d at 1356 ("Despite the concurrence's suggestion to the contrary, none of the dictionary definitions cited define 'immoral' or 'scandalous' in sexual terms."). Likewise, although the USPTO has at times denied registrations to marks as both scandalous *and* likely to be confused with another party's prior-used mark, *see, e.g.*, *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1638-39, 1641 (T.T.A.B. 1988), most Section 2(a)-based refusals historically have occurred on a standalone basis. Consequently, the marks underlying those refusals typically involve marks constituting neither unlawful nor misleading matter.

Nevertheless, as the court of appeals properly determined, Section 2(a)'s prohibition on the registration of immoral or scandalous matter cannot satisfy the remaining prongs of the *Central Hudson* analysis. Under that or other analyses, this Court routinely has held that "the fact that protected speech may be offensive to some does not justify its suppression." *Carey v. Population Servs. Int'l*, 431 U.S. 678, 701 (1977); *accord Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983); *see also Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988) ("[T]he fact that society may find speech offensive is not a sufficient reason for suppressing it." (quoting *FCC v. Pacifica Found.*, 438 U.S. 726, 755-56 (1978)); *Street v. New York*, 394 U.S. 576, 592, (1969) ("[T]he public expression of ideas may

not be prohibited merely because the ideas are themselves offensive to some of their hearers."). Whether phrased affirmatively (the promotion of *inoffensive* marks) or negatively (the discouragement of *offensive* ones) the prohibition at issue therefore does not reflect a cognizable substantial government purpose.

Indeed, the protection of the citizenry from offense is only a perceived government interest for trademarks. Congress allows registration of offensive copyright content and patents in other intellectual property legislation. As the court of appeals recognized, Section 2(a)'s treatment of allegedly offensive marks distinguishes the Lanham Act from the Copyright Act. *See Brunetti*, 877 F.3d at 1357 ("There are . . . a cadre of . . . offensive images and words that have secured copyright registration by the government. There are countless songs with vulgar lyrics, blasphemous images, scandalous books and paintings, all of which are potentially protectable under federal law. No doubt many works registered with the Copyright Office offend a substantial composite of the general public."). Likewise, the allegation that an otherwise patentable technology is harmful to public morality will not disqualify the technology from protection under patent law. *See, e.g.*, *Ex parte Murphy*, 200 U.S.P.Q. 801, 802-03 (Bd. Pat. App. 1977) (reversing refusal of utility patent application covering device used solely for gambling).

Moreover, even if limiting the public's exposure to the *use* of offensive marks did qualify as such a purpose, the prohibition on the *registration* of those marks would not directly advance that purpose. This

Court and others have recognized that "[w]ithout federal registration, a valid trademark may still be used in commerce." *Tam*, 137 S. Ct. at 1752; *see also McGinley*, 660 F.2d at 484 ("[T]he PTO's refusal to register [an applicant's] mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed." (citation omitted)); *Fox*, 702 F.3d at 635 ("[A] refusal to register a mark has no bearing on the applicant's ability to use the mark . . . ."). The court of appeals therefore correctly held that the prohibition does not directly advance the government's asserted interest. *Brunetti*, 877 F.3d at 1353. Indeed, the prohibition arguably *undermines* the government's stated purpose by making it more difficult to challenge in litigation any infringing copies of the purported immoral or scandalous mark. Because the prohibition therefore does not reasonably "address the harm intended to be regulated," it fails this prong of *Central Hudson* as well. *44 Liquormart*, 517 U.S. at 529 .

Finally, as historically applied, the prohibition is not narrowly tailored. This Court previously has held that uncertain standards weigh against a determination that a statute is sufficiently specific to further a stated congressional goal. *See Reno v. ACLU*, 521 U.S. 844, 871 (1997). Here, the Court need not refer to the inconsistent treatments of applications to register similar marks identified by the court of appeals, *Brunetti*, 877 F.3d at 1353-54, to know that imprecise standards govern the inquiry into whether an applied-for mark is impermissibly immoral or scandalous. To the contrary, the USPTO itself has acknowledged that imprecision on multiple occasions. *See, e.g.*, *Hershey*, 6 U.S.P.Q.2d at 1471 ("[T]he . . .

guidelines are somewhat vague and . . . a determination that a mark is scandalous is necessarily a highly subjective one."); *accord In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, 1654 (T.T.A.B. 1990).[11] The prohibition therefore is constitutionally infirm under the final *Central Hudson* factor as well.

This is not to say, however, that the invalidation of the prohibition at issue under an application of *Central Hudson* would mandate the same result with

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[11] Although it apparently has declined to accept Respondent's invitation to entertain a vagueness-based challenge to the prohibition in question, this Court has previously recognized that "[the] requirement of clarity in regulation is essential to the protections provided by the Due Process Clause of the Fifth Amendment," which "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). When, as in this case, content-based restrictions on speech are involved, "vagueness . . . raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno*, 521 U.S. at 871-72. If the vagueness of such a statute or regulation "threatens to inhibit the exercise of constitutionally protected rights . . . a more stringent vagueness test should apply." *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982). A statute or regulation is impermissibly vague when it "fails to provide a person of ordinary intelligence fair notice of what is prohibited, or is so standardless that it authorizes or encourages seriously discriminatory enforcement." *FCC*, 132 S. Ct. at 2317 (quoting *United States v. Williams*, 553 U.S. 285, 304 (2008)); *see also Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972) (to survive a vagueness challenge, a statute must "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited" and "provide explicit standards for those who apply [it]" to prevent "arbitrary and discriminatory enforcement"). The ban on the registration of immoral and scandalous marks in Section 2(a) has both of these flaws. Its provisions are unclear and require subjective interpretation, and its application is often inconsistent.

respect to the remaining grounds for refusing applications under Sections 2(a)-(e) of the Lanham Act. For example, some prohibitions on registration address deceptive and misleading commercial speech and therefore do not qualify for First Amendment protection in the first place. *See Bolger*, 463 U.S. at 65 ("In light of the greater potential for deception or confusion in the context of certain advertising messages, content-based restrictions on commercial speech may be permissible." (citation omitted)). These include the bars on the registration of deceptive marks, 15 U.S.C. § 1052(a), deceptively misdescriptive marks lacking acquired distinctiveness, *id.* § 1052(e)(1), primarily geographically deceptively misdescriptive marks, *id.* § 1052(e)(3), and marks either falsely suggesting an association with a person or entity, *id.* § 1052(a), or likely to be confused with the marks of prior users, *id.* § 1052(d). They may also include Section 2(b)'s prohibition on the registration of "the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." *Id.* § 1052(b).

Moreover, even if the court of appeals is correct that all prohibitions unrelated to an applied-for mark's source-identifying function constitute suspect content discrimination, *Brunetti*, 877 F.3d at 1349, that holding does not reach a number of content-based grounds for unregistrability that *do* have such a relation. These include the prohibitions on the registration of generic terms, merely descriptive marks lacking acquired distinctiveness, 15 U.S.C. § 1052(e)(1), primarily geographically descriptive marks lacking acquired distinctiveness, *id.* § 1052(e)(2), surnames lacking acquired distinctiveness, *id.* § 1052(e)(4), and

functional matter. *Id.* § 1052(e)(5). Future applicants might conceivably challenge these prohibitions as content-based and therefore subject to intermediate scrutiny under *Central Hudson*. The government, however, has a substantial interest in preventing the use of trademark law to acquire exclusive rights to claimed marks barred by these prohibitions. Indeed, that interest may have *constitutional* dimensions. *See Wilhelm Pudenz GmbH v. Littlefuse Inc.*, 177 F.3d 1204, 1208 (11th Cir. 1999) ("The functionality doctrine . . . eliminat[es] the possibility of a perpetual exclusive right to the utilitarian features of a product under trademark law, which would be impossible (as well as unconstitutional) under the Patent Act."); *Deckers Outdoor Corp. v. Ozwear Connection Pty Ltd.*, No. CV 14-2307 RSWL FFMX, 2014 WL 4679001, at *9 n.3 (C.D. Cal. Sept. 18, 2014) ("First Amendment issues could be triggered if a person is enjoined from using a generic . . . term . . . .").

Likewise, the remaining content-based prohibitions on registration set forth in Section 2 directly advance that substantial government interest. As this Court recognized in *Tam*, a federal registration on the USPTO's Principal Register is evidence of the registered mark's validity and of the registrant's ownership of it; such a registration also is necessary for certain remedies. *See generally Tam*, 137 S. Ct. at 1753. The refusal of an application to register a mark falling within those prohibitions therefore disadvantages any attempt by the applicant to claim exclusive rights to which it is not entitled. Finally, neither the doctrinal tests for those prohibitions nor applications of

those tests vary in such a manner as to call into question whether they are no more extensive than necessary.

III. CONCLUSION

Like the court of appeals, this Court should invalidate the Lanham Act's prohibition on the registration of immoral or scandalous marks as fatally inconsistent with the Free Speech Clause of the First Amendment. Such a disposition should not, however, disturb the remaining grounds for refusal of applications set forth in Sections 2(a)-(e) of the Act, which either address deceptive or misleading commercial speech and therefore are outside the ambit of First Amendment protection or, alternatively, are justifiable under the *Central Hudson* test.

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No. 18-302

In the
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE KURT M. ANDERSON IN SUPPORT OF PETITIONER'S REQUEST FOR REVERSAL

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QUESTIONS PRESENTED

Presented by the Petitioner: Whether 15 U.S.C. § 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

Additional Question Addressed: Whether the Free Speech Clause of the First Amendment mandates the recognition of proprietary rights in speech.

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IDENTITY AND INTEREST OF AMICUS CURIAE

Pursuant to Supreme Court Rule 37, Kurt M. Anderson (for purposes of this statement only, "I") respectfully submits this brief amicus curiae in support of Petitioner Andrei Iancu. [1]

I have been admitted to practice before this Court for three decades. Like other citizens of the United States, I have also followed political developments throughout my lifetime, which for me covers parts of seven decades.

I am increasingly concerned that our political processes have been preempted from all directions with newly discovered applications of constitutional law. One may complain in relatively mild terms that our democracy is beginning to resemble a half-eaten apple, with the associated colors of decay as one faction or another (or in the present case, possibly all factions) takes a bite out of it. As citizens are denied their normal processes for resolving their political

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[1] Pursuant to this Court's Rule 37.3(a), all parties have consented to the filing of this brief. Letters evidencing such consent have been filed with the Clerk of the Court.

Pursuant to Rule 37.6, Amicus Curiae affirms that no counsel for any party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than Amicus Curiae made a monetary contribution to its preparation or submission.

differences, polarization and instability are increasingly evident.

I write this brief to plead for renewed respect for majoritarian democracy; and to uphold the power of the people, through their elected representatives, to set qualitative standards when granting intellectual property rights.

I do not request to participate in oral argument. I will not appear for oral argument unless directed to do so by the Court.

SUMMARY OF ARGUMENT

The First Amendment nurtures the marketplace of ideas that allows us to continuously regenerate our political and national culture. However, the resulting cultural fungi do not have equal value. The Constitution empowers us – through our elected representatives – to make distinctions among them while requiring us to tolerate the differences. The First Amendment is not a branch of the land patent office; its beneficiaries are entitled to toleration of their speech, but not to homestead an acre for it.

The copyright clause stands alongside the First Amendment, and it empowers Congress to "promote the progress of science and *useful* arts," U.S. Const. Art. I, Section 8, clause 8 (emphasis added), by granting proprietary rights in some speech or expression while denying it in others. Clause 3, the commerce clause, broadly empowers Congress to "regulate commerce with foreign nations, and among the several states, and with the Indian tribes." Under the latter clause, Congress has enacted the trademark law at issue in this case.

The interaction between the First Amendment and the intellectual property statutes was best expressed by Federal Circuit precedent that now, unfortunately, appears to be overruled:

> With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to

> register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.

In re McGinley, 660 F.2d 481, 484 (C.C.P.A. 1981), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015), *aff'd sub nom. Matal v. Tam*, 137 S. Ct. 1744 (2017) (citation omitted).

Well-established principles of administrative or equal protection law are sufficient to guard against unfair classifications and denials of intellectual property rights. Resort to the First Amendment, if ever, should be rare.

The Court should reinstate the *McGinley* holding, if necessary overruling *Matal v. Tam*.

Because Respondent's claim does not reach a First Amendment threshold, there is no governmental or commercial speech issue in this case.

ARGUMENT

I. THE FIRST AMENDMENT DOES NOT MANDATE INTELLECTUAL PROPERTY RIGHTS IN SINGLE-WORD "VIEWPOINTS"

A single word, with or without an article, expresses no viewpoint. Even the most colorful four-letter interjections require reference to a situation or context in order to give them meaning.

A person complaining of viewpoint discrimination in trademarks or copyrights should have the threshold burden of demonstrating the expression of a viewpoint, without reference to context. Typically, expression of a viewpoint requires at least two parts of speech, in the present case pairing an adjective or verb with the noun in question. According to the Respondent, exactly who or what is, was, or might be fuct?

On the other hand, a single word may generate a nearly infinite array of viewpoints. Making that word the private property of a trademark or copyright holder gives that holder control over the key term of the discussion. Giving the Respondent exclusive rights in the word "Fuct" may also give him the power to prohibit more explicit rejoinders such as as "Fashion is Fuct" or "These T-Shirts are Fuct." In this regard, it is worth considering the "balance between [the] speech-restricting and speech-enhancing consequences" of the Respondent's First Amendment claim. *Bartnicki v. Vopper*, 532 U.S. 514, 536 (2001)

(Breyer, J., concurring). In this case, the balance tips toward denying the property rights, and Congress was empowered to do so. The proper result is no regulation at all of the speech in issue.

II. DENIAL OF INTELLECTUAL PROPERTY RIGHTS DOES NOT UNCONSTITUTIONALLY CHILL SPEECH

If a law does not "condemn as criminal any category of speech, ... the potential chilling effect is eliminated, or at least much diminished." *Ashcroft v. Am. Civil Liberties Union*, 542 U.S. 656, 667 (2004). Denial of intellectual property rights is not "extraordinary harm," *id.* at 671, that unconstitutionally chills speech. A decision not to register the asserted trademark is a decision not to regulate the speech.

Beyond the threat of criminal prosecution, such "extraordinary harm" exists only in limited situations. *See, e.g., Bartnicki v. Vopper, supra* at 533 ("the fear of public disclosure of private conversations might well have a chilling effect on private speech"). The "serious disincentive" the Federal Circuit enunciated in *In re Tam, supra* at 1341, was not previously deemed so extraordinary as to unconstitutionally chill speech. [2]

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[2] Some observers also may object to the equation of a denied incentive (in social science terms, a form of reinforcement) with a punishment or penalty. *E.g., https://www.mytutor.co.uk/answers/8603/A-*

> Moreover, the existence of a 'chilling effect,' even in the area of First Amendment rights, has never been considered a sufficient basis, in and of itself, for prohibiting state action. Where a statute does not directly abridge free speech, but—while regulating a subject within the State's power—tends to have the incidental effect of inhibiting First Amendment rights, it is well settled that the statute can be upheld if the effect on speech is minor in relation to the need for control of the conduct and the lack of alternative means for doing so.

Younger v. Harris, 401 U.S. 37, 51 (1971) (citations omitted). As far as the record indicates, both the Respondent's fashion line and Mr. Tam's dance band enjoyed a large degree of commercial success without having exclusive and privileged rights in any form of speech. A music group or fashion line organized by the Ku Klux Klan, using another imaginative but generally offensive name, might also achieve a significant degree of success without that privileged status.

On the other side of the scale, the seven core articles of our Constitution are not a mere plumbing schematic – and if they were, it nevertheless would be vital to follow the schematic. Our founders spent several hot summer months working out optimal

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Level/Psychology/What-is-the-difference-between-reinforcement-and-punishment-in-operant-conditioning (last visited February 12, 2019).

relationships between the federal and state governments, and between the branches of the federal government, in order to create a durable democracy. In the copyright clause, they expressly empowered Congress to make qualitative judgments when granting exclusive rights in creative expression. There is no reason to conclude that they intended less when they prescribed Congress's power to regulate commerce. The government has a legitimate interest in denying property rights in speech that falls short of its qualitative standards.

In short *McGinley*, quoted *supra*, correctly expressed the relationship between freedom of speech and intellectual property law. The First Amendment does not mandate the registration of the Respondent's asserted trademark.

III ADMINISTRATIVE LAW (AND IF NECESSARY, EQUAL PROTECTION) STANDARDS ARE SUFFICIENT TO PREVENT UNFAIR APPLICATION OF 15 U.S.C. § 1052

The Administrative Procedure Act's standards of judicial review, 5 U.S.C. § 706, fully apply to USPTO proceedings. *Dickinson v. Zurko*, 527 U.S. 150 (1999). In the decision now under review, the Federal Circuit acknowledged its authority to review the USPTO's fact finding under a substantial evidence standard, and its ultimate conclusion *de novo*. *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017). The Circuit concluded that the "scandalous"

criterion was correctly applied in this case, before commencing its constitutional analysis.[3] *Id.* at 1337–40. [4] There was nothing insufficient in the administrative and APA judicial review process in this case.

If one recognizes the constitutional authority of Congress to make qualitative distinctions in the realm of intellectual property law, then the burden falls on the applicant to challenge those distinctions on constitutional grounds outside of First Amendment jurisprudence. As against the federal government, the right to equal protection is secured by the Fifth Amendment. *See, e.g., Weinberger v. Wiesenfeld*, 420 U.S. 636, 643 (1975). A party such as the Respondent could assert that his form of expression cannot be classified differently from the name or form of expression found in the New York Times or the National Review. A *prima facie* rebuttal to that assertion would not be difficult to make, but the outcome would have to await that case and day. The Court has a well-developed framework for addressing equal protection issues.

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[3] As the Federal Circuit concurrence noted in *In re Tam*, the majority of that court did not rely on vagueness as an independent ground for invalidating a portion of § 1052. 808 F.3d at 1358. In the decision below, the Circuit criticized the apparent vagueness of the "immoral" and "scandalous" standards, but apparently that only affected its analysis of the commercial speech issue the government raised. *In re Brunetti*, *supra* at 1354–55.

[4] Without enunciating a standard of review, this Court came to a similar result in *Matal v. Tam*. 137 S.Ct. at 1755-57.

IV. IF NECESSARY, THE COURT SHOULD OVERRULE *MATAL V. TAM*

In addition to challenging the Federal Circuit decision now under review, the arguments in this brief challenge the rationale of this Court's *Matal v. Tam* precedent. If necessary for the decision of the present case, the Court should overrule that precedent.

Matal v. Tam assumed contrary to *McGinley, supra,* that there was a presumptive First Amendment right at issue. Its analysis commenced with the incorrect factual premise that some speech had been "banned." 137 S. Ct. at 1751; *see also id.* at 1769 (Thomas, J, characterizing the speech as having been "restricted"). It then considered and rejected three technical reasons why the presumptive right should not apply in that case. *Id.* at 1757 et seq.

None of the *Matal v. Tam* opinions addressed Congress' power to make qualitative judgments in granting intellectual property rights. *Cf. Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003):

> The Copyright Clause ... empowers Congress to *define* the scope of the substantive right. Judicial deference to such congressional definition is but a corollary to the grant to Congress of any Article I power.

(Emphasis in original; citations and internal quotes omitted).

"[W]hen governing decisions are unworkable or are badly reasoned, 'this Court has never felt constrained to follow precedent.'" *Payne v. Tennessee*, 501 U.S. 808, 827 (1991), *quoting Smith v. Allwright*, 321 U.S. 649, 665 (1944). In addition to *Matal v. Tam*'s misstatements that speech had been prohibited or restricted, it opens the door to a new form of land rush. It also allows purveyors of cultural miscellany (to charitably state the case) to compel our citizenry to bow before new pedestals of offensively labeled property rights. The precedent is less than two years old, and overruling it would nip these unfortunate effects in the bud.

CONCLUSION

The Court should uphold the statute, instead of creating another carve-out from democratic lawmaking processes. However, regardless of whether this Court applies a renewed majoritarian approach to the present issue, no speech has been banned, restricted, or chilled in this case. The constitution empowers Congress to make qualitative judgments in granting intellectual property rights. The First Amendment contains no guaranty of property rights in speech or expression.

Therefore, the Court should reverse the judgment of the Federal Circuit and reinstate

McGinley doctrine, thus affirming the decision of the U.S. Patent and Trademark Office.

DATED: February 18, 2019.

Respectfully submitted,

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On Writ of Certiorari
to the United States Court of Appeals
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BRIEF FOR PROFESSORS BARTON BEEBE AND JEANNE FROMER AS *AMICI CURIAE* SUPPORTING RESPONDENT

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INTEREST OF THE *AMICI CURIAE*[1]

Amici are law professors at New York University School of Law.[2] We have no personal stake in the outcome of this case. Rather, we have a professional interest in seeing trademark law interpreted with fidelity to the First Amendment. We have recently published a large-scale empirical study of all 6.7 million trademark applications filed at the PTO from 1985 through 2016, together with the 300,000 trademarks already registered at the PTO as of 1985. See Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 Harv. L. Rev. 945 (2018) (Beebe & Fromer, *Are We Running Out of Trademarks?*). As a result of that work, we are in possession of comprehensive data on the operation of the trademark registration process at the PTO. This brief seeks to put these data at the Court's disposal in the hope that doing so proves useful in resolving the question presented.

INTRODUCTION AND SUMMARY OF ARGUMENT

In 2017, this Court held that the Lanham Act's prohibition on the registration of trademarks that

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[1] All parties have consented to the filing of this brief. No counsel for a party authored this brief in whole or in part, and no person other than *amici* and their counsel made a monetary contribution to its preparation or submission.

[2] Our institutional affiliation is given for identification purposes only.

"disparage * * * or bring * * * into contemp[t] or disrepute" any "persons, living or dead," 15 U.S.C. § 1052(a), violates the Free Speech Clause of the First Amendment. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

This case presents the question whether the neighboring prohibition on the registration of trademarks that "[c]onsis[t] of or compris[e] immoral * * * or scandalous matter," 15 U.S.C. § 1052(a), also runs afoul of the First Amendment's Free Speech Clause. Whether this provision is unconstitutional turns in part on whether, and to what extent, the PTO has applied this provision arbitrarily or inconsistently.

We have therefore undertaken a large-scale empirical study of trademark applications and registrations at the PTO to assess to what degree the PTO is arbitrary or inconsistent in its implementation of the § 1052(a) prohibition on the registration of immoral or scandalous marks. In particular, we have systematically studied all 3.6 million applications for marks that include text (which we refer to as "word-mark applications") filed at the PTO from 2003 through 2015 to learn which marks the PTO has refused to register for being immoral or scandalous in contravention of § 1052(a).

Our study shows, from multiple vantage points, that the PTO's enforcement of the immoral-or-scandalous-marks provision is systematically inconsistent and arbitrary. That conclusion has led us to file this brief supporting respondent. Whether or not the Court agrees with our ultimate conclusion, however, our data may be useful to the Court's

decision, and we have submitted the results of our study to assist the Court as fully as possible.

ARGUMENT

I. THE PTO'S ENFORCEMENT OF § 1052(a)'S IMMORAL-OR-SCANDALOUS-MARKS PROVISION IS SYSTEMATICALLY INCONSISTENT AND ARBITRARY.

Our study shows that the PTO's enforcement of the immoral-or-scandalous-marks provision is systematically inconsistent and arbitrary. First, many of the PTO's refusals show inconsistency on their face: the PTO routinely states that it cannot register an applied-for mark because the mark is immoral or scandalous—*and* because in any event, it has already allowed *someone else to register the same mark*, or a highly similar one, with respect to the same or similar goods or services. Second, the PTO is arbitrary and inconsistent in allowing certain applications to overcome an immoral-or-scandalous refusal under § 1052(a). Third, the PTO often treats identical or highly similar marks on identical or highly similar goods differently, approving some for publication and refusing others as immoral or scandalous. Fourth, in its immoral-or-scandalous refusals, the PTO has discriminated between registrable and unregistrable marks based on those marks' viewpoint.

A. Study Design.

For our study, we used two datasets. First is the PTO's Trademark Case Files Dataset, which the PTO made publicly available in 2012 and has since

updated annually.[3] That dataset currently provides detailed information about all 7.3 million trademark applications filed at the PTO from 1982 through 2017, including data on applicant and mark characteristics, prosecution events, and ownership and renewal history. The dataset also provides more limited information on the 208,084 trademarks already registered at the PTO as of 1982 that were based on applications filed before 1982.

A significant limitation of the Trademark Case Files Dataset, however, is that it does not indicate the grounds for a refusal to register a mark. We therefore developed a second dataset of our own, containing all office actions issued by the PTO from 2003 (when the PTO began posting its office actions online) through 2017.[4] To develop this dataset, we systematically downloaded some 3.1 million office actions from the PTO website and used keywords and key phrases to autocode them for certain characteristics. Most relevant here, we autocoded the

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[3] See U.S. Patent & Trademark Office, Trademark Case Files Dataset (2018), https://www.uspto.gov/learning-and-resources/electronic-data-products/trademark-case-files-dataset-0; *see also* Stuart Graham et al., U.S. Patent & Trademark Office, *The USPTO TradeMark Case Files Dataset: Descriptions, Lessons, and Insights* 3, 35 (2013), https://www.uspto.gov/sites/default/files/ip/officechiefecon/Trademark_Case_File_Data_Documentation_31January2013_final.pdf (describing the dataset and surveying trends in trademark applications and registrations).

[4] This dataset is discussed further in Beebe & Fromer, *Are We Running Out of Trademarks?*, at 973-74.

office actions for whether the PTO refused registration on the basis that the applied-for mark was immoral or scandalous, 15 U.S.C. § 1052(a), and on the basis that the applied-for mark was confusingly similar to an already-registered mark, 15 U.S.C. § 1052(d).[5]

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[5] The trademark registration process begins when the applicant files an application identifying, among other things, the mark for which the applicant seeks registration and the goods or services with which the applicant currently uses the mark or intends in the future to use the mark. The PTO then examines the application for compliance with formalities and to determine if there are any grounds for refusal to register the mark, such as that the mark is immoral or scandalous under § 1052(a) or that the mark is confusingly similar to an already-registered mark under § 1052(d). If the PTO determines that the application complies with all formalities and that there are no grounds for refusal, the PTO then publishes the mark in the Trademark Official Gazette. At this stage, the PTO has essentially declared that as far as it is concerned, the mark is ready to be registered (though in rare instances, the PTO will sometimes issue a refusal even after the mark has been published). Any party that believes it may be harmed by registration of the mark then has thirty days to oppose registration of the mark. If no opposition is filed or if the mark is unsuccessfully opposed, the mark then proceeds to registration, except that if the applicant was not yet using the mark in commerce at the time of application, the applicant must first submit evidence of actual use in commerce before the PTO will register the mark. See U.S. Patent & Trademark Office, Trademark process, https://www.uspto.gov/trademarks-getting-started/trademark-process#step1 (providing an overview of the trademark registration process); Barton Beebe, *Trademark Law: An Open-Source Casebook* 269-73 (5th ed. 2018), http://tmcasebook.org/wp-content/uploads/2018/07/BeebeTMLaw-5.0-Full-Book.pdf.

We used these two datasets, along with others, in recently published work to study whether we are exhausting the supply of competitively effective trademarks. Beebe & Fromer, *Are We Running Out of Trademarks?*. Here, we use these datasets to analyze comprehensively the PTO's application of the § 1052 prohibition on the registration of immoral or scandalous marks with respect to applications filed from 2003 through 2015. Because of the significant computational challenges presented by the analysis of trademark applications for marks consisting only of images, we restrict our analysis here to word-mark applications. During the period studied, 97% of trademark applications submitted to the PTO were for marks that consisted in whole or part of text.

As background, Appendix 1 shows the number of word-mark applications for registration on the Principal Register received by the PTO from 2003 through 2015. For applications filed from 2003 through 2015, Appendix 2 details by filing year the number of word-mark applications that received an immoral-or-scandalous refusal and the number of such refusals that were overcome.

Before relaying our findings, we note (and we caution the reader) that they include a number of words and phrases not appropriate for polite company. We have included these details so that the Court can decide for itself why the PTO registered some marks and refused registration to others—sometimes to the same mark. They are included in full so that the Court can fully evaluate the PTO's consistency—or lack thereof.

B. The PTO Routinely Refuses Registration on the Basis That the Asserted Mark Both Contravenes § 1052(a)'s Immoral-or-Scandalous-Marks Provision and § 1052(d)'s Prohibition on Registration of a Mark That Is Confusingly Similar to an Already-Registered Mark.

While § 1052(a) of the Lanham Act prohibits the registration of a mark that "[c]onsists of or comprises immoral * * * or scandalous matter," § 1052(d) prohibits the registration of a mark that "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office * * * as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Remarkably, the PTO routinely issues refusals to the same application on the twin bases that the applied-for mark is immoral or scandalous under § 1052(a) and that the applied-for mark is confusingly similar to an already-registered mark under § 1052(d). In each of these cases, the PTO stated that the mark was immoral or scandalous and thus could not be registered—*and* that the PTO had already registered a highly similar mark on highly similar goods or services. By its own admission, therefore, the PTO is making a large number of inconsistent applications of the § 1052(a) prohibition on the registration of immoral-or-scandalous marks—and often just a short time apart.

Consider some examples of applications for marks that are similar to respondent's proposed mark FUCT. In 2009, the PTO refused to register the mark FUK!T

in connection with apparel (Class 25)[6] and the operation of an internet website (Class 42) on the bases that the applied-for mark was immoral or scandalous under § 1052(a) and confusingly similar under § 1052(d) to the recently-registered mark PHUKIT for apparel (Class 25).[7] Similarly, on June

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[6] Class numbers denote what goods or services the mark is to be used with. A trademark applicant must specify the goods and services in connection with which the applicant claims the exclusive right to use the mark. See 15 U.S.C. § 1051(a)(2). The applicant includes a written description of the goods and services and also designates one or more of the forty-five categories of goods and services contained in the International Classification of Goods and Services for the Purposes of the Registration of Marks, which are listed in Appendix 3. U.S. Patent & Trademark Office, *Trademark Manual of Examining Procedure* § 1401.03 (Oct. 2017); 37 C.F.R. § 2.32(a)(7); see also List of Classes with Explanatory Notes, World Intell. Prop. Org., http://web2.wipo.int/classifications/nice/nclpub/en/fr/20170101/classheadings/?explanatory_notes.

Appendix 4 sets forth the international classes of goods or services claimed by all word-mark applications filed from 2003 through 2015 that received a § 1052(a) immoral-or-scandalous refusal. As Appendix 4 indicates, a very large proportion of applications receiving a § 1052(a) immoral-or-scandalous refusal claim the applied-for mark for use in connection with apparel goods (Class 25). Entertainment services (Class 41) and printed matter (Class 16) also show significant levels of applications receiving a § 1052(a) immoral-or-scandalous refusal.

[7] Trademark Application Serial No. 77,818,033 was filed on September 1, 2009, in connection with FUK!T for apparel. In the same office action letter dated December 7, 2009, the PTO refused registration on the twin grounds of immoral-or-scandalous content and confusing similarity with the mark in U.S. Registration No. 2,934,721, namely PHUKIT for apparel, as registered on March 22, 2005.

18, 2013, the PTO registered the mark PHUC for apparel (Class 25). Four days before, on June 14, 2013, the PTO sent out an office action refusing to register the mark P.H.U.C. CANCER (PLEASE HELP US CURE CANCER) in connection with apparel (Class 25) on the bases that the mark was immoral or scandalous and confusingly similar to the about-to-be-registered mark PHUC for apparel. At no time during its registration process did the earlier-filed mark PHUC for apparel receive any immoral-or-scandalous refusal.[8]

The PTO has done this repeatedly—*i.e.*, given different treatment to the same (or nearly same) F-word variant, for use on the same kind of goods. For

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[8] Trademark Application Serial No. 85,418,294 was filed on September 8, 2011, for the mark PHUC for apparel (Class 25). Trademark Application Serial No. 85,855,531, was subsequently filed on February 20, 2013, for the mark P.H.U.C. CANCER (PLEASE HELP US CURE CANCER) in connection with apparel (Class 25). Because the earlier-filed application had not yet been published and registered, the PTO's office action noted that this "mark[] in [a] prior-filed pending application[] may present a bar to registration of applicant's mark," and that "[i]f the mark[] in the referenced application[] register[s], applicant's mark may be refused registration * * * because of a likelihood of confusion between the marks." Office Action, June 14, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85855531&docId=OOA20130614133853#docIndex=2&page=1. The earlier-filed application received no immoral-or-scandalous refusal and was published on March 20, 2012, and registered on June 18, 2013 (U.S. Registration No. 4,354,653). The subsequent application for P.H.U.C. CANCER (PLEASE HELP US CURE CANCER) was abandoned after the PTO issued the office action refusing to register it.

example, the PTO registered F U 2 for apparel, but barely two years later refused to register F.U. for apparel because it was both immoral and confusingly similar to the registered mark F U 2.[9] Similarly, the PTO registered FVCK STREET WEAR for apparel, but then two years later refused to register FVCKD because it was scandalous and also confusingly similar to an already-registered mark.[10]

There is a wide range of marks for which these twin refusals occur, well beyond those that are variations on respondent Brunetti's applied-for mark. As illustration, the PTO has asserted in office actions that each of the following marks both contravenes the immoral-or-scandalous-marks provision and is confusingly similar to an already-registered mark:

- MILF SEEKER for online entertainment services, immoral or scandalous and

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[9] Trademark Application Serial No. 86,533,866, filed on February 12, 2015, sought to register the mark F.U. in connection with apparel (Class 25). In an office action dated May 26, 2015, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration No. 4,254,831, namely F U 2 for apparel (Class 25), as registered on December 4, 2012.

[10] Trademark Application Serial No. 86,808,278, filed November 3, 2015, sought to register the mark FVCKD in connection with apparel (Class 25). In an office action dated August 26, 2016, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration 4,515,888, namely FVCK STREET WEAR for apparel (Class 25), as registered on April 15, 2014.

confusingly similar to the recently-registered mark MILFHUNTER for online entertainment services;[11]

- DS DIRTY SANCHEZ for apparel, immoral or scandalous and confusingly similar to the recently-registered mark DIRTY SANCHEZ for prerecorded video and entertainment services;[12]
- HONKEY SOCAL for apparel, immoral or scandalous and confusingly similar to the recently-registered mark HONKEE for apparel;[13]

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[11] Trademark Application Serial No. 77,043,802, filed November 14, 2006, sought to register the mark MILF SEEKER in connection with online entertainment services (Class 41). In an office action dated March 19, 2007, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration 2,936,139, namely MILFHUNTER for online entertainment services (Class 41), as registered on March 29, 2005.

[12] Trademark Application Serial No. 78,495,056, filed October 5, 2004, sought to register the mark DS DIRTY SANCHEZ in connection with apparel (Class 25). In an office action dated May 9, 2005, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration 2,926,500, namely DIRTY SANCHEZ for prerecorded video (Class 9) and entertainment services (Class 41), as registered on February 15, 2005.

[13] Trademark Application Serial No. 77,133,487, filed March 16, 2007, sought to register the mark HONKEY SOCAL in connection with apparel (Class 25). In an office action dated

- MIDDLEFINGER for apparel, immoral or scandalous and confusingly similar to the recently-registered mark JONNY MIDDLEFINGER for bags and apparel;[14]
- BANGBOAT for online adult-entertainment services, immoral or scandalous and confusingly similar to the recently-registered mark BANGBUS for online adult-entertainment services;[15]
- FAT COCK BEER for beer, immoral or scandalous and confusingly similar to the

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June 29, 2007, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly-similar with the mark in U.S. Registration 3,128,361, namely HONKEE for apparel (Class 25), as registered on August 15, 2006.

[14] Trademark Application Serial No. 78,863,232, filed April 17, 2006, sought to register the mark MIDDLEFINGER in connection with apparel (Class 25). In an office action dated September 25, 2006, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly-similar with the mark in U.S. Registration 2,381,895, namely JONNY MIDDLEFINGER for bags (Class 19) and apparel (Class 25), as registered on August 29, 2000.

[15] Trademark Application Serial No. 78,618,356, filed April 27, 2005, sought to register the mark BANGBOAT in connection with online adult-entertainment services (Class 42). In an office action dated December 2, 2005, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly-similar with the mark in U.S. Registration 2,810,145, namely BANGBUS for online adult-entertainment services (Class 41), as registered on February 3, 2004.

recently-registered mark RED COCK BEER for beer;[16]

- CAMEL TOES for apparel, immoral or scandalous and confusingly similar to the already-registered mark CAMEL TOES for apparel.[17]

These twin refusals also occur with regard to marks containing non-English words. Consider the following examples, both in Spanish:

- PINCHE TAQUERIA (translated by the PTO in its § 1052(a) refusal as "fucking taco stand") for food services (Class 43), immoral or scandalous and confusingly similar to an application filed nine days earlier for PINCHES TACOS for food services (Class 43), which received no immoral-or-

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[16] Trademark Application Serial No. 85,253,332, filed February 28, 2011, sought to register the mark FAT COCK BEER in connection with beer (Class 32). In an office action dated July 5, 2011, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration 3,793,133, namely RED COCK BEER for beer (Class 32), as registered on May 25, 2010.

[17] Trademark Application Serial No. 78,697,334, filed August 22, 2005, sought to register the mark CAMEL TOES in connection with apparel (Class 25). In an office action dated March 10, 2006, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration 1,872,570, namely CAMEL TOES for apparel (Class 25), as registered on January 10, 1995.

scandalous refusal and was subsequently registered;[18]

- UN CABRON POR MI PATRON (translated by the PTO in its § 1052(a) refusal as "a prick or motherfucker for my boss") for apparel, immoral or scandalous and confusingly similar to the recently-registered mark CABRON 49 for apparel.[19]

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[18] Trademark Application Serial No. 77,513,028 was filed on July 1, 2008, for the mark PINCHES TACOS in connection with food services (Class 43). Trademark Application Serial No. 77,519,564 was subsequently filed on July 10, 2008, for PINCHE TAQUERIA in connection with food services (Class 43). In an office action dated October 20, 2008, the PTO refused registration of the PINCHE TAQUERIA mark on the bases that it was immoral or scandalous and confusingly similar to the earlier-filed PINCHES TACOS mark. Because the earlier-filed application had not yet been published and registered, the PTO's office action noted that "a potentially conflicting mark in a prior-filed pending application [the earlier-filed application] may present a bar to registration," and that "[i]f the referenced application registers, registration may be refused in this case under Section 2(d)." Office Action, Oct. 20, 2008, http://tsdr.uspto.gov/documentviewer?caseId=sn77519564&docId=OOA20081020172830#docIndex=1&page=1. The PINCHE TAQUERIA applicant then abandoned its application. PINCHES TACOS received no immoral-or-scandalous refusal and was published on November 25, 2008, and registered on February 10, 2009.

[19] Trademark Application Serial No. 77,060,638, filed December 8, 2006, sought to register the mark UN CABRON POR MI PATRON in connection with apparel (Class 25). In an office action dated February 15, 2007, the PTO refused registration on the bases that the applied-for mark was immoral or scandalous and confusingly similar to the mark in U.S. Registration

Appendix 5 sets forth, by filing year, all 114 trademark applications filed from 2003 through 2015 that were refused registration (and failed to publish) on the bases that the applied-for mark was immoral or scandalous under § 1052(a) and confusingly similar under § 1052(d) to a mark that the PTO had already registered or at least already approved for publication in the Official Gazette.[20] This appendix shows more comprehensively what these examples illustrate: that the PTO has acted inconsistently in issuing immoral-or-scandalous refusals to a wide range of words—from commonly used profanities like FUCK and its variations to a slew of less widespread words—suggesting that the inconsistent treatment is broad and irremediable.

3,202,335, namely CABRON 49 for apparel (Class 25), as registered on January 23, 2007.

[20] We do not include in this list trademark applications that received twin refusals for being immoral or scandalous and for being confusingly similar when the confusing similarity related to a different aspect of the mark than the one the PTO found immoral or scandalous. For example, with regard to the trademark application for ADIOS M.F. for alcoholic cocktail mixes (Class 33), see Trademark Application Serial No. 77,560,340, filed Sept. 2, 2008, the PTO, on December 8, 2008, refused the application on the ground that the mark was immoral or scandalous for meaning "goodbye motherfucker," and also that it was confusingly similar to registered mark ADIOS AMIGO for mixed drinks (Class 33), Trademark Registration No. 3,262,700, registered July 10, 2007. In such an instance, a twin refusal does not suggest inconsistency on the part of the PTO in application of the immoral-or-scandalous-marks provision.

These inconsistencies cannot be explained away as merely the result of the marks at issue being used in different contexts—such as differing "meaning in relation to the particular goods and services for which registration is sought" and "change[s in attitudes] over time," as petitioner suggests. Gov't Br. 45-46. This is precisely because in these situations of twin refusals, the PTO asserted that the applied-for mark was immoral or scandalous and contextually similar enough to the already-registered mark that consumer confusion would result.[21] Moreover, the PTO issued these twin refusals against applied-for marks whose application dates were close in time to the publication and registration dates of the earlier-filed marks that the PTO cited as the basis for its confusing similarity refusals under § 1052(d), which indicates that changing attitudes cannot explain these inconsistencies.

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[21] Specifically, in deciding to refuse the registration of an applied-for mark as confusingly similar to an already-registered mark, the PTO looks to "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression" and "[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

C. The PTO Is Inconsistent and Arbitrary in Allowing Certain Applications to Overcome a § 1052(a) Immoral-or-Scandalous Refusal.

Sometimes the PTO refuses to register a mark as immoral or scandalous, but then backs down and allows the mark to be published and ultimately registered. A review of these registrations provides further evidence that the PTO is arbitrary and inconsistent in its administration of the immoral-or-scandalous marks provision.

Of the 1,901 word-mark applications filed from 2003 through 2015 that were refused registration as immoral or scandalous, 140 applications overcame that refusal and 91 proceeded to registration.[22] In many instances, the PTO appears arbitrarily to have accepted dubious reasoning in withdrawing its § 1052(a) immoral-or-scandalous refusal—reasoning that the PTO has rejected in similar contexts.

For example, in 2013 the PTO refused to register the mark F'D UP for use in connection with apparel (Class 25) and skateboard parts (Class 28)[23] on the ground that it was immoral or scandalous, reasoning in an office action that "'F'D UP' is a common abbreviation for the obscene and vulgar phrase

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[22] See Appendix 2.

[23] See Trademark Application Serial No. 85/762,896 (filed Oct. 24, 2012).

'fucked up.'"[24] The applicant responded: "We have defined the f'd up to represent fired up (get fired up)[, and] we are now using the words fired up with our advertising of f'd up products."[25] Apparently accepting this representation as sufficient to resolve the matter, the PTO issued no further office actions, published the application on September 3, 2013, and registered it on March 11, 2014.

By contrast, in 2010 the PTO refused to register the mark EFF U for use in connection with apparel (Class 25)[26] on the ground that it was immoral or scandalous, reasoning in an office action that "EFF U, * * * the phonetic equivalent of 'Fu' meaning 'fuck you,'" is "scandalous, immoral, and offensive."[27] The applicant responded that EFFU was not necessarily vulgar and an "example of eff-u not being vulgar would be a television show called EFFIN science."[28]

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[24] See Office Action, Feb. 28, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85762896&docId=OOA20130228165144#docIndex=17&page=1.

[25] See Response to Office Action, June 10, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85762896&docId=ROA20130610185140#docIndex=16&page=1.

[26] See Trademark Application Serial No. 77,959,391, filed Mar. 15, 2010.

[27] See Office Action, June 9, 2010, http://tsdr.uspto.gov/documentviewer?caseId=sn77959391&docId=OOA20100609155823#docIndex=5&page=1.

[28] See Response to Office Action, Nov. 7, 2010, http://tsdr.uspto.gov/documentviewer?caseId=sn77959391&docId=OOA20100609#docIndex=3&page=1.

The PTO maintained its refusal, stating that "EFFU, which is a direct vulgar insult meaning 'go away' or 'go to hell,' is distinguishable from the term EFFIN."[29] The applicant subsequently abandoned its application.

In the instant case, respondent has similarly asserted to the PTO that FUCT is not necessarily vulgar. He argued in response to the PTO's immoral-or-scandalous refusal that "[a]lthough FUCT is a made-up word, "to the extent it has any meaning at all, it is FRIENDS U CAN'T TRUST."[30] Indeed, Mr. Brunetti cited in support of this definition the same source, the "Urban Dictionary," that the PTO itself cites. But unlike the applicant for the mark F'D UP, Brunetti drew an examiner who was unwilling to accept reasoning of this nature.

Another example: in 2007, the PTO refused to register the mark MILF NEXT DOOR for use in connection with adult-oriented internet audiovisual entertainment (Class 41), [31] explaining that "the acronym MILF means MOTHER I'D LIKE TO

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[29]See Office Action, Nov. 22, 2010, http://tsdr.uspto.gov/documentviewer?caseId=sn77959391&docId=OOA20100609155823#docIndex=2&page=1.

[30] See Response to Office Action, Jan. 2, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85310960&docId=ROA20111221192649#docIndex=6&page=1.

[31] See Trademark Application Serial No. 77/064,757 (filed Dec. 14, 2006).

F**K."[32] In response, the applicant explained, among much else, that "MILF is a title of distinction—a badge of honor—a triumph of the mature woman over a society that fetishizes youth and deems age to be akin to rot. Against this onslaught, this forty-something woman proudly bears the title, and no less importantly craves to retain it." [33] The PTO maintained and made final its immoral-or-scandalous refusal.[34] But then six months later, it inexplicably withdrew its refusal[35] and published the mark for opposition on August 5, 2008. The mark was registered on October 21, 2008.

By contrast, in 2005 the PTO refused under § 1052(a) to register the mark MILF.XXX in connection with adult-oriented internet audiovisual entertainment (Class 41),[36] explaining that "the term 'MILF' included in the applied-for mark means

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[32] See Office Action, Apr. 9, 2007, http://tsdr.uspto.gov/documentviewer?caseId=sn77064757&docId=OOA20070409153925#docIndex=24&page=1.

[33] See Response to Office Action, Oct. 9, 2007, http://tsdr.uspto.gov/documentviewer?caseId=sn77064757&docId=ROA20071010192525#docIndex=17&page=1.

[34] See Office Action, Nov. 1, 2007, http://tsdr.uspto.gov/documentviewer?caseId=sn77064757&docId=OOA20071101124745#docIndex=15&page=1.

[35] See Notation to File, June 4, 2008, http://tsdr.uspto.gov/documentviewer?caseId=sn77064757&docId=OOA20071101124745#docIndex=13&page=1.

[36] See Trademark Application Serial No. 78/643,772 (filed June 4, 2005).

'Mother [or Mom] I'd Like [to] Fuck' and is thus scandalous because it refers to a lewd or scandalous act." [37] The applicant responded that "'MILF' is susceptible to multiple meanings which may be completely innocuous," among them "'Moro Islamic Liberation Front (Muslim group in the Philippines)," "'Man I Like Fragging (Counter Strike gaming clan)," and "'Mother I'd Like to Find" (polite form; from the movie American Pie)."[38] In a subsequent office action, the PTO maintained and made final its refusal, stating that "a substantial composite of the general public would associate the term 'MILF' with the offensive phrase 'mom [or mother] I'd like to fuck,' rather than one of the possible alternative meanings offered by the applicant."[39] The PTO asserted that this was particularly true in light of the type of adult entertainment services offered by MILF.XXX, which was precisely the same type of services offered in connection with the mark MILF NEXT DOOR, which was registered two years later. After the PTO's final refusal, the applicant for MILF.XXX abandoned its application.

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[37] See Office Action, Dec. 28, 2005, http://tsdr.uspto.gov/documentviewer?caseId=sn78643772&docId=OOA20051228022840#docIndex=7&page=1.

[38] See Response to Office Action, June 29, 2006, http://tsdr.uspto.gov/documentviewer?caseId=sn78643772&docId=OOA20051228#docIndex=4&page=1.

[39] See Office Action, Aug. 10, 2006, http://tsdr.uspto.gov/documentviewer?caseId=sn78643772&docId=OOA20051228022840#docIndex=3&page=1.

These dubious allowances and conflicting refusals are not isolated instances. Appendix 6 sets forth, by filing year, all 140 word-mark applications filed from 2003 through 2015 that were refused registration on the basis that the applied-for mark was immoral or scandalous but that overcame that refusal—a subset of which then proceeded to registration. Appendix 6 reports numerous examples of published and registered word marks that should not have merited publication or registration if the PTO were applying its immoral or scandalous review in a non-arbitrary and consistent manner.

D. The PTO Often Treats Identical or Highly Similar Marks on Identical or Highly Similar Goods Differently, Approving Some for Publication and Refusing Others as Immoral or Scandalous.

For applications filed from 2003 through 2015, the PTO failed to issue an immoral-or-scandalous refusal to and approved for publication a significant number of applications that sought to register a word mark that, based on the PTO's own § 1052(a) refusal practices, was immoral or scandalous regardless of context.

For example, in 2011 the PTO issued an immoral-or-scandalous refusal to an application for the mark HUNG LIKE A MULE .COM YOU HAVE A VOID AND WE CAN FILL IT 7+ in connection with dating services (Class 45), owing to the subpart HUNG

LIKE A MULE.[40] The applicant subsequently abandoned its application. Yet in 2015, the PTO registered the mark HUNG LIKE A M.U.L.E. for apparel (Class 25) without any immoral-or-scandalous objection.[41]

Taking another example, in 2007 the PTO issued an immoral-or-scandalous refusal to an application for the mark STFU for apparel (Class 25),[42] stating that "STFU is an acronym for the expletive 'shut the fuck up.'"[43] The applicant then abandoned its application. By contrast, in 2016 the PTO registered the mark STFU for noise suppressors for firearms (Class 13) without any immoral-or-scandalous objection.[44]

Other examples emerge from applications for marks containing non-English words. In 2008, the PTO issued an immoral-or-scandalous refusal to an application for the mark CAJONES for dietary

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[40] See Trademark Application Serial No. 85/418,659 (filed Sept. 9, 2011). The PTO issued this refusal in an office action dated December 27, 2011.

[41] See Trademark Registration No. 4,796,702, registered Aug. 18, 2015.

[42] See Trademark Application Serial No. 77/090,708 (filed Jan. 25, 2007).

[43] Office Action, May 19, 2007, http://tsdr.uspto.gov/documentviewer?caseId=sn77090708&docId=OOA20070519190640#docIndex=1&page=1.

[44] See Trademark Registration No. 4,932,276, registered on January 16, 2016.

supplements (Class 5).[45] It cited evidence from urbandictionary.com, among other sources, in support of the conclusion that:

> the proposed mark "CAJONES" means "TESTICLES" or "BALLS" and is thus scandalous because it is a commonly used vulgar slang term for a part of the male genitalia. In addition, while the proper spelling of the term is "COJONES" the attached evidence demonstrates that "CAJONES" is a common and often intentional misspelling of the word "COJONES" and has the same overall commercial impression.[46]

The applicant subsequently abandoned the application.

Yet in 2008 the PTO registered the mark CAJONES for party games (Class 28) without any immoral-or-scandalous objection,[47] even though, with authorization from the applicant's attorney, it amended the application record to include the following translation statement: "The foreign wording in the mark translates into English as drawers, and

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[45] See Trademark Application Serial No. 77/291,198 (filed on Sept. 28, 2007).

[46] Office Action, Jan. 4, 2008, http://tsdr.uspto.gov/documentviewer?caseId=sn77291198&docId=OOA20080104140332#docIndex=2&page=1.

[47] See Trademark Registration No. 3,444,976, registered June 10, 2008.

as a slang term for testicles." Similarly, in 2005 the PTO issued no immoral-or-scandalous refusal to the mark CAJONES for beer (Class 32)[48] and published the mark. In an office action, the PTO had asked the applicant for a translation of the mark, stating: "The following translation statement is suggested: 'The English translation of CAJONES is drawers.'" (The application subsequently failed to proceed to registration because the applicant failed to submit evidence of actual use of the mark).

As a final example, the PTO has been inconsistent in its treatment of "obscenicons" (defined as "strings of symbols, like %$*$##@, used in comic books to represent obscenities" [49]), approving some for publication, while refusing to register other very similar obscenicons on the basis that they are immoral or scandalous. For example, in 2009 the PTO issued no immoral-or-scandalous refusal to the mark $#!+ for use in connection with novelty gift items (Class 20) and apparel (Class 25).[50] By contrast, the PTO issued immoral-or-scandalous refusals to the

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[48] See Trademark Application Serial No. 78/452,365 (filed July 17, 2004).

[49] Patricia T. O'Conner & Stewart Kellerman, *What Do You Call a %$*$##@?*, Grammarphobia Blog (Mar. 1, 2011), https://www.grammarphobia.com/blog/2011/03/grawlix.html.

[50] See Trademark Application Serial No. 77/668,860 (filed Feb. 12, 2009). The mark was published on January 5, 2010 (but failed to register because the applicant filed no evidence of use in commerce).

marks NO $#!+[51] and APE $#!+,[52] both filed only a few years after the application for the mark $#!+.

Again, these are not isolated examples. Appendix 7 sets forth all word-mark applications for words longer than one letter filed from 2003 through 2015 that received no immoral-or-scandalous refusal and proceeded to publication (and often to registration) even though the applications were for word marks that identically matched terms which had elsewhere triggered an immoral-or-scandalous refusal. Perhaps context could explain some of the rejections, *i.e.*, the PTO might have thought some of the word marks listed in Appendix 7 were immoral or scandalous with respect to some goods or services, but not

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[51] See Trademark Application Serial No. 85/855,449 (filed Feb. 20, 2013), for NO $#!+ for website (Class 41). In an office action dated May 15, 2013, the PTO explained: "The attached evidence from The Merriam-Webster On-line Dictionary, Dictionary.com, and the Urban Dictionary show[s] that this wording is an expression of incredulity and is considered to be vulgar. The substitution of the symbols $ # ! + for the letters S H I T is a chat room designation used to circumvent language filters." Office Action, May 15, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85855449&docId=OOA20130515082926#docIndex=8&page=1.

[52] See Trademark Application Serial No. 85/611,740 (filed Apr. 30, 2012), for APE $#!+ for apparel (Class 25). In an office action dated May 22, 2013, the PTO explained: "The attached evidence from the web-based *Urban Dictionary* shows that the lettering $#!+ is a common substitution for the word 'shit.'" Office Action, May 22, 2013, http://tsdr.uspto.gov/documentviewer?caseId=sn85611740&docId=OOA20130522162859#docIndex=6&page=1.

others.[53] But context cannot explain them all. And in any event, the need for the PTO to engage in such difficult contextual judgments helps show the essential arbitrariness of the process of determining that certain uses of a word mark are immoral or scandalous while certain other uses of the same mark are not.

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[53] For example, the PTO has refused registration of numerous applications for marks consisting in whole or part of the term BALLS. See, *e.g.*, Trademark Application Serial No. 77/587,730 (filed Oct. 7, 2008), for GOT BALLS... in connection with apparel (Class 25); Trademark Application Serial No. 85/051,113 (filed May 31, 2010), for FEEL YOUR BALLS in connection with apparel (Class 25). However, the PTO issued no immoral-or-scandalous refusal to Trademark Application Serial No. 85/071,112 (filed on June 24, 2010), which sought to register the mark BALLS for use in connection with services relating to the organizing of rocketry conventions (Class 41). In response to a PTO request for clarification of the meaning of the mark, the applicant stated: "The term 'Balls' does not have a particular meaning or significance in the relevant industry, nor is it a term of art within the industry. The term is being used solely in a suggestive sense." Response to Office Action, Apr. 4, 2011, http://tsdr.uspto.gov/documentviewer?caseId=sn85071112&docId=ROA20110405173926#docIndex=8&page=1. Apparently satisfied with this explanation, the PTO published the mark on June 7, 2011, and it was subsequently registered on August 23, 2011. Yet the "suggestive sense" of BALLS presumably is the same sense in which the earlier applicants wanted to use it on apparel—yet the PTO refused those applications.

E. In Its Immoral-or-Scandalous Refusals, the PTO Has Discriminated Between Registrable and Unregistrable Marks Based on Those Marks' Viewpoint.

From 2003 through 2015, the PTO issued immoral-or-scandalous refusals to at least 50 applied-for marks for being drug-related (including TIGHT BLUNTS for apparel, [54] WHITE POWDER for apparel, [55] COCAINE for soft drinks and energy drinks, [56] and YOU CAN'T SPELL HEALTHCARE WITHOUT THC for pain-relief medication[57]). In its immoral-or-scandalous refusals, the PTO frequently cites the glorification of drug usage as the basis for the immorality or scandalousness of these marks.[58]

By contrast, during the same time period, the PTO has both not issued an immoral-or-scandalous refusal and has published marks that contain an anti-drug

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[54] See Trademark Application Serial No. 78/521,773 (filed Nov. 23, 2004).

[55] See Trademark Application Serial No. 78/674,808 (filed July 20, 2005).

[56] See Trademark Application Serial No. 77/006,212 (filed Sept. 25, 2006).

[57] See Trademark Application Serial No. 77/833,964 (filed Sept. 24, 2009).

[58] See, *e.g.*, Office Action, Oct. 19, 2006, http://tsdr.uspto.gov/documentviewer?caseId=sn77006212&docId=OOA20061019082158#docIndex=12&page=1; Office Action, Feb. 8, 2006, http://tsdr.uspto.gov/documentviewer?caseId=sn78674808&docId=OOA20060208095100#docIndex=2&page=1.

message (such as DOGS AGAINST DRUGS / DOGS AGAINST CRIME for charity services,[59] D.A.R.E. TO RESIST DRUGS AND VIOLENCE for apparel and other goods,[60] and SAY NO TO DRUGS - REALITY IS THE BEST TRIP IN LIFE for printed matter[61]).

II. THIS SYSTEMATIC INCONSISTENCY AND ARBITRARINESS OF PTO ENFORCEMENT OF THE IMMORAL-OR-SCANDALOUS-MARKS PROVISION SUGGEST THAT THE PROVISION VIOLATES THE FIRST AMENDMENT'S FREE SPEECH CLAUSE.

This Court made clear in *Matal v. Tam* that the law's regulation of trademarks, specifically legal prohibitions on registration of certain categories of marks, implicates First Amendment interests. See *Tam*, 137 S. Ct. at 1751 ("We now hold that [§ 1052(a)'s disparagement] provision violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.").

Viewed through the lens of the First Amendment, many of the marks subject to an immoral-or-scandalous refusal are instances of high-value speech. Whichever level of scrutiny the Court chooses to apply to analyze the constitutionality of this provision, the PTO's inconsistent and arbitrary

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[59] See U.S. Registration No. 2,822,861, filed Sept. 25, 2006.

[60] See U.S. Registration No. 2,975,163, filed May 5, 2003.

[61] See U.S. Registration No. 2,966,019, filed Mar. 12, 2004.

enforcement of the provision is problematic. It suggests a lack of fit between the purposes of the provision and the provision as enforced. The PTO's inconsistent and arbitrary enforcement also indicates unconstitutional vagueness.

A. Many of the Marks Subject to an Immoral-or-Scandalous Refusal Are Instances of High-Value Speech.

Although it might be tempting to dismiss many of the marks refused as immoral or scandalous as low-value speech at best, a good number of the mark applications in our study that received a § 1052(a) immoral-or-scandalous refusal contain political speech or "'speech concerning public affairs,'" *Snyder v. Phelps*, 562 U.S. 443, 452 (2011) (quoting *Garrison v. Louisiana*, 379 U.S. 64, 74-75 (1964)), which "'occupies the highest rung of the hierarchy of First Amendment values, and is entitled to special protection.'" *Id.* (quoting *Connick v. Myers*, 461 U.S. 138, 145 (1983)). For example, of the 1,091 word-mark applications in our sample that received an immoral-or-scandalous refusal, 22 of them are a variation of one kind or another on FUCK CANCER (listed in Appendix 8). [62] See generally Denise Restauri, *When Cancer Gets Personal, a Daughter Gets Mad and Starts a Human Movement*, Forbes,

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[62] Of these marks, only two were published, both for F CANCER, and only one of these registered. Trademark Application Serial No. 77,954,532, filed Mar. 9, 2010 (published only); Trademark Application Serial No. 77,983,618, filed Mar. 9, 2010 (registered).

Dec. 17, 2013, https://www.forbes.com/sites/deniserestauri/2013/12/17/when-cancer-gets-personal-a-daughter-gets-mad-and-starts-a-human-movement ("That was the beginning of the charity Fuck Cancer—a story about a young women who really just wanted to help her mom and ended up starting a movement that targets Millennials to engage them in an open dialogue about early detection with a clear call to action to involve, engage and educate their parents—and put an end to late stage cancer."). Others contain political commentary, such as mark applications for OBAMA BIN LADEN for apparel,[63] KATRINA BLOWS BUSH SUCKS for bumper stickers,[64] CRAPITOL HILL for magnets, printed matter, and apparel, among other things,[65] REPUBLICANS ARE LIKE DIAPERS... TIGHT ON THE POOR MAN'S ASS AND ALWAYS FULL OF SHIT for bumper stickers,[66] and FUCK PARIS FUCK LONDON I LOVE NEW YORK for apparel.[67]

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[63] Trademark Application Serial No. 77/086,418 (filed Jan. 19, 2007).

[64] Trademark Application Serial No. 78/706,886 (filed Sept. 5, 2005).

[65] Trademark Application Serial No. 85/503,117 (filed Dec. 23, 2011).

[66] Trademark Application Serial No. 85/506,065 (filed Dec. 29, 2011).

[67] Trademark Application Serial No. 86/727,750 (filed Aug. 17, 2015).

Compare these marks with a jacket worn by an individual in public bearing the visible words "Fuck the Draft." *Cohen v. California*, 403 U.S. 15 (1971). In that case, this Court held that criminalization of this individual's conduct was inconsistent with the First Amendment for forbidding core speech. *Id.* at 26. The Court reasoned that despite the distastefulness of the language used:

> Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. Yet no readily ascertainable general principle exists for stopping short of that result were we to affirm the judgment below. For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual.

Id. at 25. The Court also emphasized that:

> much linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech has little or no regard for that emotive function which practically speaking,

> may often be the more important element of the overall message sought to be communicated. Indeed, as Mr. Justice Frankfurter has said, "[o]ne of the prerogatives of American citizenship is the right to criticize public men and measures—and that means not only informed and responsible criticism but the freedom to speak foolishly and without moderation."

Id. at 26 (quoting *Baumgartner v. United States*, 322 U.S. 665, 673-74 (1944)).[68]

Many of the mark applications in our study are also sexual, a category of speech which this Court has treated as valuable and protected. See, *e.g.*, *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 813-14 (2000) (subjecting restrictions of sexually-oriented programming on cable television to strict scrutiny); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988) (doubting that there is "a principled standard" to separate a parody advertisement about a minister's first time having sexual relations with his mother in an outhouse from "more traditional political cartoons").

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[68] It is principally only in the narrow context of broadcast television, which appears "in the privacy of the home" and "is uniquely accessible to children, even those too young to read," that this Court has limited the First Amendment protection afforded to explicit speech. *FCC v. Pacifica Found.*, 438 U.S. 726, 748-51 (1978).

B. Whichever Level of Scrutiny the Court Applies, the Inconsistency and Arbitrariness of the PTO's Enforcement of the Immoral-or-Scandalous Marks Provision Are Constitutionally Problematic for a Lack of Fit Between the Provision's Purposes and Its Enforcement.

The PTO's inconsistency and arbitrariness in enforcing the immoral-or-scandalous-marks provision suggests that there is insufficient fit between the governmental purpose of the provision and the provision's inconsistent and arbitrary enforcement. The government has asserted three interests in the immoral-or-scandalous-marks provision: "protecting the sensibilities of the public," Gov't Br. 32, "the orderly flow of commerce," *id.* at 34, and "avoiding any appearance that the government approves of such marks," *id.*

This fit is relevant for both stricter and more relaxed forms of scrutiny.

To the extent that this provision must withstand strict scrutiny, the inconsistency and arbitrariness of the PTO's enforcement of the immoral-or-scandalous-marks provision bears on the provision's constitutionality. Specifically, the inconsistency and arbitrariness of the PTO's enforcement of the provision suggests that the provision is seriously underinclusive (by failing to refuse registration to all immoral or scandalous marks) and overinclusive (by refusing registration to marks that are not immoral or scandalous (and are not otherwise prohibited to be registered by trademark law)), thereby calling into

question the provision's constitutionality. See *Reed v. Town of Gilbert, Ariz.*, 135 S. Ct. 2218, 2231 (2015) ("Because the [law] imposes content-based restrictions on speech, those provisions can stand only if they survive strict scrutiny, 'which requires the Government to prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.'" (quoting *Ariz. Free Enterprise Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 734 (2011)); *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786, 805 (2011) ("[W]hen [laws] affect First Amendment rights they must be pursued by means that are neither seriously underinclusive nor seriously overinclusive."); cf. *Williams-Yulee v. Fla. Bar*, 135 S. Ct. 1656, 1668-669 (2015) (observing that "a law's underinclusivity raises a red flag," especially when it is "riddled with exceptions"); *City of Ladue v. Gilleo*, 512 U.S. 43, 52-53 (1994) ("Exemptions from an otherwise legitimate regulation of a medium of speech * * * may diminish the credibility of the government's rationale for restricting speech in the first place.").

The analysis is similar even if the immoral-or-scandalous-marks provision is subject to a more relaxed form of constitutional scrutiny pursuant to *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557 (1980), as a regulation of commercial speech. The fourth prong of the *Central Hudson* inquiry requires a determination whether the law at issue "is not more extensive than necessary to serve [a substantial government] interest." *Id.* at 566. As the Federal Circuit held below in the instant case:

> [N]o matter the government's interest, it cannot meet the fourth prong of *Central Hudson*. The PTO's inconsistent application of the immoral or scandalous provision creates an "uncertainty [that] undermines the likelihood that the [provision] has been carefully tailored." See *Reno v. Am. Civil Liberties Union*, 521 U.S. 844, 871 (1997). Nearly identical marks have been approved by one examining attorney and rejected as scandalous or immoral by another. * * * * Although the language in these marks is offensive, we cannot discern any pattern indicating when the incorporation of an offensive term into a mark will serve as a bar to registration and when it will not.

Pet. App. 39a; cf. *Tam*, 137 S. Ct. at 1756-57 (acknowledging that that "the huge volume of [trademark] applications have produced a haphazard record of enforcement" of the disparagement provision, and that "today, the principal register is replete with marks that many would regard as disparaging to racial and ethnic groups"); *id.* at 1764-65 (plurality opinion) ("[T]he disparagement clause is not 'narrowly drawn' to drive out trademarks that support invidious discrimination. The clause reaches any trademark that disparages any *person, group, or institution*. It applies to trademarks like the following: 'Down with racists,' 'Down with sexists,' 'Down with homophobes.' It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.") (emphasis in original).

The Court has made clear that when, as here, "[t]he operation of [a law] is so pierced by exemptions

and inconsistencies * * * the Government cannot hope to exonerate it" under the fourth prong of *Central Hudson. Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 190 (1999); cf. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 489 (1995) ("[E]xemptions and inconsistencies [in an alcohol labeling ban] bring into question the purpose of the labeling ban.").

Indeed, to the extent the Court thinks the PTO's inconsistency in enforcement of the provision means the provision suffers from a lack of fit between its purposes and its enforcement whatever the level of scrutiny, the Court need not resolve whether trademarks are commercial speech. Cf. *Tam*, 137 S. Ct. at 1764 (plurality opinion) ("We need not resolve this debate between the parties [over whether trademarks are commercial speech] because the disparagement clause cannot withstand even *Central Hudson* review."); *id.* at 1767 (Kennedy, J., concurring in part and concurring in the judgment, joined by Ginsburg, Sotomayor, and Kagan, JJ.) ("The parties dispute whether trademarks are commercial speech and whether trademark registration should be considered a federal subsidy. The former issue may turn on whether certain commercial concerns for the protection of trademarks might, as a general matter, be the basis for regulation. However that issue is resolved, the viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.").

C. The Inconsistency and Arbitrariness of the PTO's Enforcement of the Immoral-or-Scandalous-Marks Provision Also Suggest That the Provision Is Unconstitutionally Vague.

In addition to bearing on the fit between the government's purpose in the immoral-and-scandalous-marks provision and its enforcement, the PTO's inconsistency and arbitrariness in enforcement suggests that § 1052(a) is unconstitutionally vague in the context of the First Amendment. This Court has consistently emphasized that a law that contains "no standard for determining" how to satisfy a requirement of the law is constitutionally problematic. *Kolender v. Lawson*, 461 U.S. 352, 358 (1983). That is because in such an instance, the law "vests virtually complete discretion in the hands of the [government] to determine whether the" legal requirement is met. *Id.* This Court has concluded that such a law "is unconstitutionally vague on its face because it encourages arbitrary enforcement by failing to describe with sufficient particularity what [one] must do in order to satisfy the statute." *Id.* at 361.

The "concern * * * is based upon the 'potential for arbitrarily suppressing First Amendment liberties.'" *Id.* (quoting *Shuttlesworth v. City of Birmingham*, 382 U.S. 87, 91 (1965)). Specifically, "the vagueness of * * * a [content-based] regulation [of speech] raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno*, 521 U.S. at 871-72. For this reason, although unconstitutional vagueness arises in multiple contexts, this Court has

made clear that "[i]f * * * [a] law interferes with the right of free speech * * *, a more stringent vagueness test should apply." *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982).

In the instant case, the inconsistent and arbitrary enforcement by the PTO of the immoral-or-scandalous-marks provision suggests that the provision is unconstitutionally vague, in that the vagueness engenders trademark examiners' inconsistent applications of the provision. Cf. *Tam*, 137 S. Ct. at 1756 (acknowledging the "admitted vagueness of the disparagement test" in § 1052(a)); *Winters v. New York*, 333 U.S. 507, 509-10 (1948) (finding unconstitutionally vague a criminal law prohibiting the sale of obscene magazines, and reasoning that "[a] failure of a statute limiting freedom of expression to give fair notice of what acts will be punished and such a statute's inclusion of prohibitions against expressions, protected by the principles of the First Amendment violates a[subject's] rights under * * * freedom of speech").

CONCLUSION

Our study shows that the PTO's enforcement of the immoral-or-scandalous-marks provision is systematically inconsistent and arbitrary. This inconsistency and arbitrariness suggest that the provision violates the First Amendment's Free Speech clause, because of a lack of fit between the provision's purposes and its enforcement as well as unconstitutional vagueness. Whether or not the Court agrees with our ultimate conclusion, however, our data may be useful to the Court's decision, and

we have submitted the results of our study to assist the Court as fully as possible.

Respectfully submitted.

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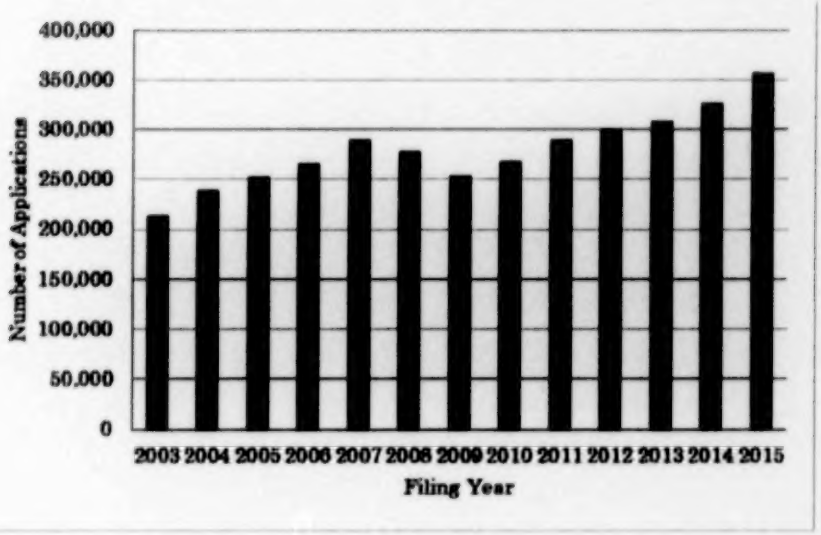
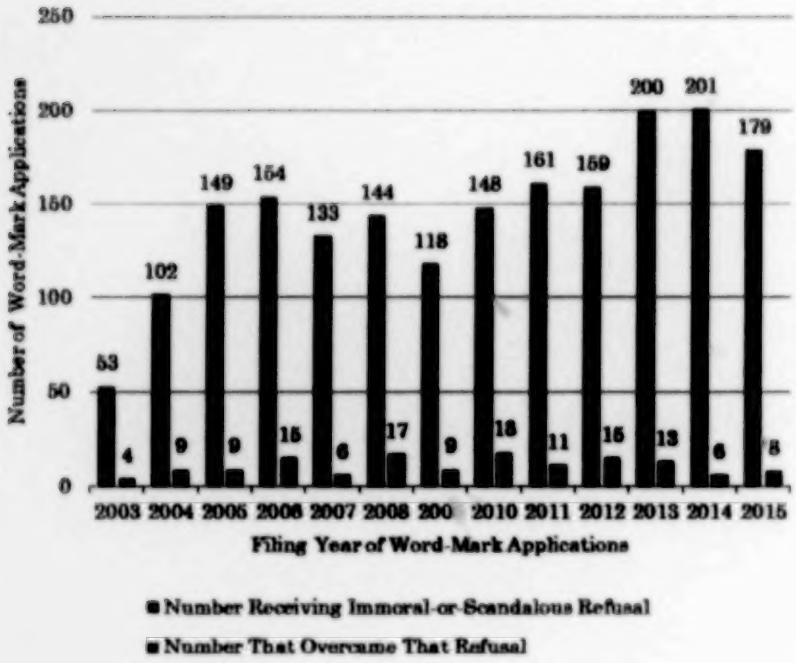
March 25, 2019

APPENDIX

Appendix 1
Number of Word-Mark Applications Filed at the Patent and Trademark Office for Registration on the Principal Register, 2003-2015



Appendix 2
Number of Word-Mark Applications Receiving a § 1052(a) Immoral-or-Scandalous Refusal and Number of Such Applications That Overcame That Refusal, by Filing Year, 2003-2015



Appendix 3
International Classification of Goods and Services for the Purposes of the Registration of Marks (https://www.wipo.int/classifications/nice/nclpub/en/fr/20190101/classheadings/?explanatory_notes=show&lang=en&menulang=en)

Goods

Class 1: Chemicals for use in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fire extinguishing and fire prevention compositions; tempering and soldering preparations; substances for tanning animal skins and hides; adhesives for use in industry; putties and other paste fillers; compost, manures, fertilizers; biological preparations for use in industry and science.

Class 2: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants, dyes; inks for printing, marking and engraving; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art.

Class 3: Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

Class 4: Industrial oils and greases, wax; lubricants; dust absorbing, wetting and binding compositions; fuels and illuminants; candles and wicks for lighting.

Class 5: Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 6: Common metals and their alloys, ores; metal materials for building and construction; transportable buildings of metal; non-electric cables and wires of common metal; small items of metal hardware; metal containers for storage or transport; safes.

Class 7: Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines.

Class 8: Hand tools and implements, hand-operated; cutlery; side arms, except firearms; razors.

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus.

Class 10: Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopaedic articles; suture materials; therapeutic and assistive devices adapted for the disabled; massage apparatus; apparatus, devices and articles for nursing infants; sexual activity apparatus, devices and articles.

Class 11: Apparatus and installations for lighting, heating, cooling, steam generating, cooking, drying, ventilating, water supply and sanitary purposes.

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 13: Firearms; ammunition and projectiles; explosives; fireworks.

Class 14: Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments.

Class 15 Musical instruments; music stands and stands for musical instruments; conductors' batons.

Class 16: Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks.

Class 17: Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics and resins in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, tubes and hoses, not of metal.

Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips,

harness and saddlery; collars, leashes and clothing for animals.

Class 19: Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; asphalt, pitch, tar and bitumen; transportable buildings, not of metal; monuments, not of metal.

Class 20: Furniture, mirrors, picture frames; containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of-pearl; shells; meerschaum; yellow amber.

Class 21: Household or kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; combs and sponges; brushes, except paintbrushes; brush-making materials; articles for cleaning purposes; unworked or semi-worked glass, except building glass; glassware, porcelain and earthenware.

Class 22: Ropes and string; nets; tents and tarpaulins; awnings of textile or synthetic materials; sails; sacks for the transport and storage of materials in bulk; padding, cushioning and stuffing materials, except of paper, cardboard, rubber or plastics; raw fibrous textile materials and substitutes therefor.

Class 23: Yarns and threads for textile use.

Class 24: Textiles and substitutes for textiles; household linen; curtains of textile or plastic.

Class 25: Clothing, footwear, headwear.

Class 26: Lace, braid and embroidery, and haberdashery ribbons and bows; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair.

Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings, not of textile.

Class 28: Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yoghurt and other milk products; oils and fats for food.

Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

Class 31: Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt.

Class 32: Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages.

Class 33: Alcoholic beverages, except beers; alcoholic preparations for making beverages.

Class 34: Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers' articles; matches.

Services

Class 35: Advertising; business management; business administration; office functions.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37: Building construction; repair; installation services.

Class 38: Telecommunications.

Class 39: Transport; packaging and storage of goods; travel arrangement.

Class 40: Treatment of materials.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

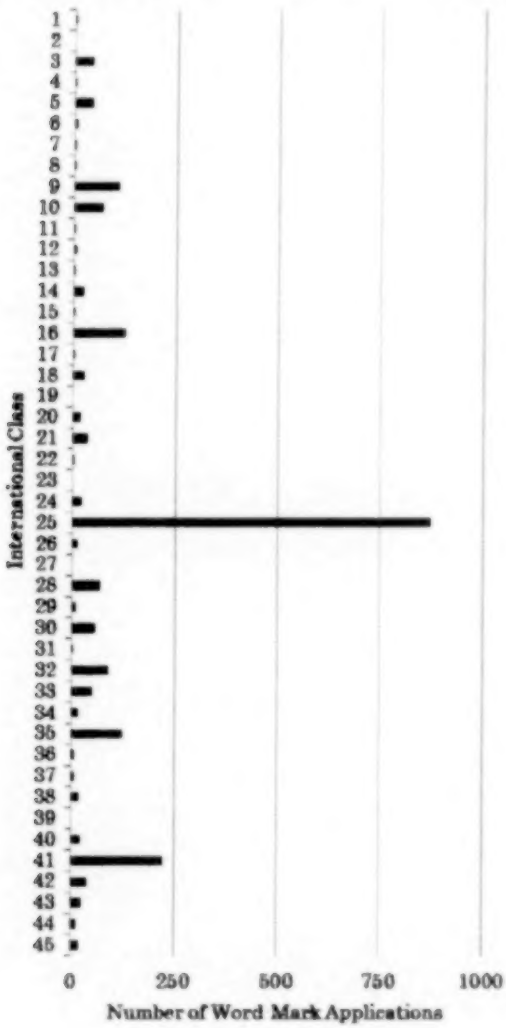
Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and industrial research services; design and development of computer hardware and software.

Class 43: Services for providing food and drink; temporary accommodation.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

Class 45: Legal services; security services for the physical protection of tangible property and individuals; personal and social services rendered by others to meet the needs of individuals.

Appendix 4
International Classes Claimed by Word-Mark Applications Receiving a § 1052(a) Immoral-or-Scandalous Refusal, Filing Years 2003-2015



Appendix 5
All Word-Mark Applications Filed From 2003 Through 2015 That Received Both a § 1052(a) Refusal on the Basis That the Applied-For Mark Was Immoral or Scandalous and a § 1052(d) Refusal on the Basis That the Applied-For Mark Was Confusingly-Similar with an Already Published or Registered Mark

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
DICKWEAR <Class 10>	78,207,741 (1/28/2003)	DICKS <Class 35>	75,658,351 (3/11/1999) [10/22/2002]
		DICK'S <Class 35>	75,658,352 (3/11/1999) [4/9/2002]
THE BIG WOODIE <Class 28>	78,214,752 (2/13/2003)	WOODY <Class 28>	75,251,914 (3/5/1997) [6/9/1998]
NAKA DASHI <Class 9>	76,501,004 (3/26/2003)	CREAM PIE <Class 41>	75,740,629 (6/30/1999) [3/21/2000]
C P CREAM PIE <Classes 9, 41>	76,511,051 (5/2/2003)	CREAM PIE <Class 41>	75,740,629 (6/30/1999) [3/21/2000]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
NICE CAMELTOE <Class 28>	78,253,440 (5/22/2003)	CAMEL TOES <Class 25>	74,439,311 (9/23/1993) [1/10/1995]
WIFEBEADER <Class 25>	78,282,968 (8/4/2003)	HUSBAND * BEATER <Class 25>	78,353,517 (1/18/2004) [2/28/2006]
M F MO FO WWW.MOFOSHOP.COM GEAR WITH A FLIPPIN'ATTITUDE <Class 25>	76,550,070 (10/6/2003)	MOFO <Class 25,41>	73,593,770 (4/16/1986) [2/23/1988]
BRASS BALLS <Classes 32, 33>	78,335,045 (12/2/2003)	BRASS BALLS SALOON <Class 42>	73,500,342 (9/20/1984) [5/28/1985]
NICE SNATCH <Class 25>	78,393,971 (3/31/2004)	SNACH CLOTHING COMPANY <Class 25>	76,205,985 (2/7/2001) [6/8/2004]
RUSSKY STANDART <Class 32>	78,452,112 (7/16/2004)	RUSKI <Class 33>	75,737,420 (6/25/1999) [6/17/2003]
		LEMON RUSKI <Class 33>	75,737,422 (6/25/1999) [8/12/2003]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
RUSSKY STANDART <Class 32>	78,452,091 (7/16/2004)	RUSKI <Class 33>	75,737,420 (6/25/1999) [6/17/2003]
		LEMON RUSKI <Class 33>	75,737,422 (6/25/1999) [8/12/2003]
PHUKIT APPAREL <Class 25>	78,451,664 (7/16/2004)	PHUKIT <Class 25>	78,257,504 (6/3/2003) [3/22/2005]
DS DIRTY SANCHEZ <Class 25>	78,495,056 (10/5/2004)	DIRTY SANCHEZ <Classes 9, 41>	76,132,917 (9/20/2000) [2/15/2005]
A DOZICH <WITH IMAGE> <Class 25>	78,515,009 (11/11/2004)	<IMAGE OF TWO STICK FIGURES ENGAGED IN SEX> <Class 25>	78,121,581 (4/14/2002) [9/19/2006]
TIGHT BLUNTS <Class 25>	78,521,773 (11/23/2004)	BLUNT <Class 25>	74,338,427 (12/9/1992) [1/18/1994]
MO FO JEANS <Class 25>	78,541,440 (1/3/2005)	MOFO.COM <Class 42>	75,914,802 (2/9/2000) [10/23/2001]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
FUKITOL <Classes 21, 25>	78,564,750 (2/10/2005)	PHUKIT <Class 25>	78,257,504 (6/3/2003) [3/22/2005]
WANKER <Class 25>	78,610,369 (4/16/2005)	WANK. <Class 25>	78,421,170 (5/18/2004) [9/26/2006]
		WANCHORS <Class 25>	78,591,173 (3/21/2005) [9/26/2006]
MILF GOLF <Class 25>	78,614,007 (4/21/2005)	MYLF <Class 25>	78,351,515 (1/13/2004) [5/17/2005]
BANGBOAT <Class 42>	78,618,356 (4/27/2005)	BANGBUS <Class 41>	76,483,301 (1/21/2003) [2/3/2004]
MILF SEEKER <Class 42>	78,618,337 (4/27/2005)	MILFHUNTER <Class 41>	78,306,103 (9/26/2003) [3/29/2005]
THE SHOCKER <Class 25>	78,638,901 (5/27/2005)	SHOCKERS <Class 25>	73,120,720 (3/28/1977) [12/23/1980]
HB HUSBANDBEATER <Class 25>	78,638,942 (5/27/2005)	HUSBAND * BEATER <Class 25>	78,353,517 (1/18/2004) [2/28/2006]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
CLONE A PUSSY <Class 20>	78,692,020 (8/12/2005)	CLONE-A-WILLY <Classes 10, 28>	78,419,307 (5/14/2004) [1/10/2006]
CAMEL TOES <Class 25>	78,697,334 (8/22/2005)	CAMEL TOES <Class 25>	74,439,311 (9/23/1993) [1/10/1995]
TALKING COCK <Class 10>	78,716,443 (9/20/2005)	TALKING HEAD <Class 10>	78,686,087 (8/4/2005) [7/17/2007]
THE JACK MAG <Class 16>	78,772,903 (12/14/2005)	JACK <Classes 9, 16, 41>	76,448,506 (9/6/2002) [2/22/2005]
SOFA KING AWESOME <Class 14>	78,784,188 (1/3/2006)	TEAM SOFA KING <Classes 16, 21, 25, 35, 41>	76,514,970 (5/16/2003) [6/3/2008]
MIDDLEFINGER <Class 25>	78,863,232 (4/17/2006)	JONNY MIDDLEFINGER <Classes 18, 25>	75,685,285 (5/11/1999) [8/29/2000]
BONER BATS ROCK HARD WOOD <Class 28>	78,904,458 (6/9/2006)	BONER <Classes 25, 28>	76,535,752 (8/11/2003) [8/3/2004]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
WIGGA PLEASE <Class 25>	78,951,841 (8/14/2006)	WIGGA WEAR <Class 25>	78,160,418 (9/4/2002) [8/10/2004]
BALL SACK POWDER <Class 3>	78,963,466 (8/30/2006)	BALSAC <Class 3,18>	75,649,424 (3/1/1999) [5/7/2002]
MILF DUDS <Class 25>	77,004,154 (9/21/2006)	MYLF <Class 25>	78,351,515 (1/13/2004) [5/17/2005]
UKININAM <Class 25>	77,004,145 (9/21/2006)	SCREW YOU <Class 25>	78,699,134 (8/24/2005) [9/24/2013]
HARDWOODY LURES <Class 28>	77,007,106 (9/25/2006)	WOODY LURE COMPANY <Class 28>	78,693,734 (8/16/2005) [†]
MILF SEEKER <Class 41>	77,043,802 (11/14/2006)	MILFHUNTER <Class 41>	78,306,103 (9/26/2003) [3/29/2005]
UN CABRON POR MI PATRON <Class 32>	77,060,638 (12/8/2006)	KBRON <Class 25>	78,070,454 (6/21/2001) [8/15/2006]
		CABRON 49 <Class 3, 18, 25>	79,015,795 (2/17/2005) [1/23/2007]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
MILF DUDS #1-B <Class 25>	77,070,433 (12/22/2006)	MYLF <Class 25>	78,351,515 (1/13/2004) [5/17/2005]
WIFEBEATER <Class 25>	77,121,502 (3/2/2007)	HUSBAND*BEATER <Class 25>	78,353,517 (1/18/2004) [2/28/2006]
FIELD NEGRO <Class 25>	77,124,403 (3/7/2007)	PHIELD NEGRO 74 <Class 25>	78,800,557 (1/26/2006) [3/23/2010]
HONKEY SOCAL <Class 25>	77,133,487 (3/16/2007)	HONKEE <Class 25>	76,594,332 (5/26/2004) [8/15/2006]
HARD ASS CRACKER <Class 25>	77,163,723 (4/23/2007)	CRACKER <Class 25>	75,048,627 (1/25/1996) [5/27/1997]
PUSSY VODKA <Class 33>	77,174,382 (5/7/2007)	RED PUSSY <Class 32>	77,162,516 (4/21/2007) [†]
AY CABRON <Classes 16, 25, 29, 30, 32>	77,184,231 (5/17/2007)	CABRON 44 <Classes 3, 18, 25>	79,015,795 (2/17/2005) [1/23/2007]
PUSSIE VODKA <Class 33>	77,201,989 (6/8/2007)	RED PUSSY <Class 32>	77,162,516 (4/21/2007) [†]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
FADED. TITTIES. BEER. <Class 25>	77,263,236 (8/23/2007)	TITTY'S BEER <Class 25>	78,820,782 (2/22/2006) [†]
POTHEAD 420 <Class 25>	77,290,998 (9/27/2007)	POTTHEAD <Class 25>	77,235,554 (7/22/2007) [†]
PUSSY <Class 33>	77,314,522 (10/26/2007)	RED PUSSY <Class 32>	77,162,516 (4/21/2007) [†]
SUCK IT! <Class 25>	77,350,732 (12/12/2007)	SUCKIT. <Class 16>	77,296,697 (10/4/2007) [3/23/2010]
THE G-MILF HUNTER <Class 41>	77,376,265 (1/20/2008)	MILFHUNTER <Class 41>	78,306,103 (9/26/2003) [3/29/2005]
PINCHE TAQUERIA <Class 43>	77,519,564 (7/10/2008)	PINCHES TACOS <Class 43>	77,513,028 (7/1/2008) [2/10/2009]
DAMN! DIGITAL MAGAZINE <Class 9>	77,538,713 (8/4/2008)	DAMN GIRL MAGAZINE <Class 41>	77,390,430 (2/6/2008) [10/12/2010]
SCRW-U <Class 25>	77,558,390 (8/28/2008)	SCREW YOU <Class 25>	78,699,134 (8/24/2005) [9/24/2013]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
BOYS2RENT <Class 45>	77,646,070 (1/8/2009)	MEN4RENTNOW.COM <Class >	77,150,767 (4/6/2007) [3/31/2009 – Supp. Reg.]
BAMF BRAND <Class 25>	77,665,028 (2/6/2009)	B.A.M.F. <Class 25>	78,345,314 (12/24/2003) [9/19/2006]
MARYJANE COLA <Classes 5, 32>	77,673,405 (2/19/2009)	MARY JANE'S RELAXING SODA <Class 32>	77,687,542 (3/10/2009) [2/21/2012]
		MARY JANE'S SODA <Class 5>	77,642,501 (1/2/2009) [2/21/2012]
BAMF <Class 25>	77,687,946 (3/10/2009)	B.A.M.F. <Class 25>	78,345,314 (12/24/2003) [9/19/2006]
COCK BLOC <Class 25>	77,798,234 (8/6/2009)	KOK-BLOCKERS <Class 25>	76,348,076 (12/13/2001) [3/2/2004]
FU <Classes 21, 25>	77,814,006 (8/27/2009)	F.U. HOLLYWOOD <Class 25>	77,778,897 (7/10/2009) [8/14/2012]
FUK!T <Classes 25, 42>	77,818,033 (9/1/2009)	PHUKIT <Class 25>	78,257,504 (6/3/2003) [3/22/2005]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
OMFG <Class25>	77,835,813 (9/26/2009)	OMFG <Class 25>	77,607,951 (11/5/2008) [2/9/2010]
SON OF A BITCH <Classes 9, 18, 25, 28, 41>	77,852,839 (10/20/2009)	SOM BITCH <Class 25>	75,353,099 (9/8/1997) [1/9/2001]
TITS 'N PEARL GIRL <Class 25>	77,859,966 (10/28/2009)	TITS <WITH IMAGE OF BIRDS> <Class 25>	76,379,045 (3/5/2002) [8/15/2006]
PUSSY NATURAL ENERGY <Classes 25, 32>	77,880,452 (11/25/2009)	PUSSY NATURAL ENERGY <Class 32>	77,817,308 (9/1/2009) [12/4/2012]
KO KANE <Class 33>	85,038,867 (5/14/2010)	KOKANEE <Class 32>	73,572,784 (12/10/1985) [2/3/1987]
UNGLORYHO LE <Class 41>	85,114,580 (8/24/2010)	GLORYHOLE <Class 41>	77,389,462 (2/5/2008) [8/26/2008]
FUCK CANCER <Class 16>	85,237,359 (2/8/2011)	SCREW CANCER <Class 36>	85,207,375 (12/29/2010) [8/16/2011]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
FAT COCK BEER <Class 32>	85,253,332 (2/28/2011)	RED COCK BEER <Class 32>	77,875,474 (11/18/2009) [5/25/2010]
SOCK MY COCK <Class 25>	85,264,154 (3/11/2011)	COCKSOX <Class 25>	85,185,067 (11/24/2010) [4/10/2012]
CAMEL TOE BLUE JEANS <Class 25>	85,277,696 (3/25/2011)	CAMEL TOES <Class 25>	74,439,311 (9/23/1993) [1/10/1995]
THE GLORY HOLE <Class 9>	85,329,178 (5/24/2011)	GLORYHOLE INITIATIONS <Class 41>	77,389,460 (2/5/2008) [8/26/2008]
		GLORYHOLE <Class 41>	77,389,462 (2/5/2008) [8/26/2008]
HAUTE COCK <Class 25>	85,333,389 (5/30/2011)	HAUTE COQ <Class 25>	78,461,869 (8/4/2004) [9/20/2005]
BIG DICK'N IT <Class 25>	85,344,736 (6/13/2011)	BIG DICK'S <Class 25>	74,266,388 (4/16/1992) [12/8/1992]
COCKSTAR <Classes 5, 10, 35>	85,376,863 (7/21/2011)	PARTY LIKE A COCKSTAR <Class >	77,312,851 (8/5/2007) [8/21/2008 – Supp. Reg.]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
I BANGED BETTY <Class 25>	85,386,222 (8/1/2011)	BETTY BANGS <Class 25>	77,447,517 (4/14/2008) [12/9/2008]
POK-HER GOOD <Class 10>	85,386,833 (8/2/2011)	POKER <Class 10>	78,566,655 (2/14/2005) [8/8/2006]
LITTLE PUSSIE <Class 32>	85,408,947 (8/27/2011)	PUSSY NATURAL ENERGY <Class 32>	77,817,308 (9/1/2009) [12/4/2012]
CHINGA <Class 25>	85,464,503 (11/4/2011)	CHENGA <Class 25>	85,006,316 (4/5/2010) [4/12/2011]
PHUCKET! <Class 25>	85,482,448 (11/29/2011)	PHUKET THAI <Class 25>	76,202,633 (1/26/2001) [12/23/2003]
COCKED N LOADED <Class 5>	85,561,169 (3/6/2012)	COCKED & LOADED <Class 32>	85,146,710 (10/6/2010) [5/31/2011]
OINK <Classes 16, 35, 38, 41, 42, 45>	85,587,247 (4/3/2012)	OINK.COM <Class 35>	85,137,460 (9/24/2010) [5/24/2011]
PHUP DUC <Class 25>	85,716,502 (8/29/2012)	PHUP DUC <Class 25>	85,640,365 (5/31/2012) [†]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
#@%&! BREAST CANCER <Class 25>	76,712,792 (11/6/2012)	#@%&! <Class 25>	75,770,446 (9/2/1999) [8/14/2001]
COOLIE <Class 25>	85,785,992 (11/22/2012)	KOOLEY <Class 25>	85,489,665 (12/7/2011) [5/29/2012]
P.H.U.C. CANCER (PLEASE HELP US CURE CANCER) <Class 25>	85,855,531 (2/20/2013)	PHUC <Class 25>	85,418,294 (9/8/2011) [6/18/2013]
CAMO-TOE <Class 25>	85,866,252 (3/4/2013)	CAMOTOES <Class 25>	85,775,183 (11/8/2012) [†]
T.I.T.S. (TOES IN THE SAND) <Class 25>	85,872,690 (3/11/2013)	TITS <WITH IMAGE OF BIRDS> <Class 25>	76,379,045 (3/5/2002) [8/15/2006]
BEAVER BUTTER <Class 3>	85,923,590 (5/4/2013)	BEAVER <Class 3>	85,821,724 (1/11/2013) [4/15/2014]
PRETTY PUSSY <Class 25>	85,939,135 (5/22/2013)	THE PRETTY PUSSYCAT <Class 25>	76,453,991 (9/30/2002) [4/3/2007]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Word Mark Cited in § 1052(d) Refusal <Int'l Class>	Cited Mark Serial No. (Application Date) [Registration Date]
F K CANCER <Class 25>	86,016,028 (7/22/2013)	F CANCER <Class 25>	77,954,532 (3/9/2010) [†]
LADIES LOVE BIG ROD'S <Class 43>	86,048,968 (8/27/2013)	BIG ROD'S <Class 43>	78,377,360 (3/2/2004) [6/7/2005]
I GOT STUFFED AT BIG ROD'S <Class 43>	86,050,041 (8/28/2013)	BIG ROD'S <Class 43>	78,377,360 (3/2/2004) [6/7/2005]
COOLIE <Class 25>	86,092,994 (10/16/2013)	KOOLEY <Class 25>	85,489,665 (12/7/2011) [5/29/2012]
		COOLEY HIGH CLOTHING COMPANY <Class 25>	85,834,638 (1/28/2013) [7/15/2014]
FUCK CANCER <Class 25>	86,286,757 (5/20/2014)	F CANCER <Class 25>	77,983,618 (3/9/2010) [6/10/2014]
F CK CANCER <Class 42>	86,288,375 (5/21/2014)	F CANCER <Class 25>	77,983,618 (3/9/2010) [6/10/2014]
FUCK CANCER <Class 25>	86,290,011 (5/23/2014)	F CANCER <Class 25>	77,983,618 (3/9/2010) [6/10/2014]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Word Mark Cited in § 1052(d) Refusal <Int'l Class>	Cited Mark Serial No. (Application Date) [Registration Date]
SHE GOT THE D <Class 25>	86,295,630 (5/30/2014)	THE D <Class 25>	85,654,302 (6/18/2012) [4/9/2013]
NAMASTE MOTHER FUCKER <Class 25>	86,350,476 (7/28/2014)	NAMASTE MF <Class 25>	85,827,086 (1/18/2013) [4/1/2014]
JEBAO <Class 7>	86,350,659 (7/29/2014)	JEBO <Classes 7, 11, 16>	79,033,500 (4/17/2006) [9/1/2009]
FREE THE NIPPLE X X <Class 25>	86,380,758 (8/29/2014)	FREE THE NIPPLE <Class 25>	86,151,239 (12/23/2013) [10/21/2014]
SUPER WANG <Class 5>	86,400,750 (9/19/2014)	SUPERWANG <Class 5>	85,962,120 (6/17/2013) [7/29/2014]
FVCK LA <Class 25>	86,405,502 (9/25/2014)	FVCK STREET WEAR <Class 25>	85,826,194 (1/17/2013) [4/15/2014]
F.U! <Class 25>	86,468,096 (12/1/2014)	F U 2 <Class 25>	85,394,120 (8/10/2011) [12/4/2012]
HOLY SH!T <Class 33>	86,507,039 (1/19/2015)	HOLY EXPLETIVE <Class 33>	85,142,000 (9/30/2010) [1/10/2012]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Word Mark Cited in § 1052(d) Refusal <Int'l Class>	Cited Mark Serial No. (Application Date) [Registration Date]
F.U. <Class 25>	86,533,866 (2/12/2015)	F U 2 <Class 25>	85,394,120 (8/10/2011) [12/4/2012]
FVCK IT <Class 25>	86,535,216 (2/13/2015)	FVCK STREET WEAR <Class 25>	85,826,194 (1/17/2013) [4/15/2014]
CAMELTOEN ER <Class 16>	86,535,371 (2/14/2015)	CAMEL TOES <Class 25>	74,439,311 (9/23/1993) [1/10/1995]
BULLSHIT FLAG <Class 24>	86,550,661 (3/2/2015)	BS <Classes 20, 24>	76,528,727 (7/9/2003) [12/27/2005]
BOMB PUNANI <Class 25>	86,550,637 (3/2/2015)	PUNANI <Class 25>	77,396,582 (2/14/2008) [9/15/2009]
I (HEART DESIGN) BALLS! <Classes 14, 25>	86,570,398 (3/19/2015)	I (HEART DESIGN) MY BALLS <Class 14>	85,291,848 (4/11/2011) [1/15/2013]
CRACKER LIFE <Class 25>	86,616,548 (5/1/2015)	CRACKER LIFE <Class 25>	85,236,440 (2/8/2011) [8/30/2011]
BIG COCK SPORTSWEAR <Class 25>	86,661,862 (6/14/2015)	BIG COCKE <Class 25>	77,870,338 (11/11/2009) [5/3/2011]

Applied-For Word Mark Receiving § 1052(a) & § 1052(d) Refusals <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Word Mark Cited in § 1052(d) Refusal <Int'l Class>**	**Cited Mark Serial No. (Application Date) [Registration Date]**
		BIG COCK COUNTRY <Class 25>	85,225,003 (1/24/2011) [3/26/2013]
CRACKER LIFE <Class 25>	86,707,984 (7/29/2015)	CRACKER LIFE <Class 25>	85,236,440 (2/8/2011) [8/30/2011]
FVCKD <Class 25>	86,808,278 (11/3/2015)	FVCK STREET WEAR <Class 25>	85,826,194 (1/17/2013) [4/15/2014]

† The application was abandoned after publication.

Appendix 6
All Trademark Applications Filed From 2003 Through 2015 That Received a § 1052(a) Immoral-or-Scandalous Refusal and That Overcame That Refusal and Were Published/Registered

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
COOCHY <Class 3>	78,214,120 (2/12/2003)	6/1/2004	8/24/2004
POTATOFINGER <Class 29>	78,215,674 (2/17/2003)	5/3/2005	7/26/2005
BIG BLACK DICK - PREMIUM RUM- NORTH SOUTH GRAND CAYMAN SEVEN MILE BEACH CARRIBEAN SEA BBD <Classes 21, 25, 33>	78,219,113 (2/26/2003)	12/28/2004	11/22/2005
HONKIES <Class 28>	78,233,268 (4/2/2003)	9/14/2004	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BITCH WHIFFS <Class 34>	78,390,812 (3/25/2004)	9/20/2005	†
BITCH WHIFFS <Class 25>	78,397,712 (4/7/2004)	9/13/2005	12/6/2005
BITCH WHIFFS <Class 28>	78,398,827 (4/8/2004)	9/20/2005	†
CHILITOS CAFE <Class 35>	78,406,642 (4/22/2004)	7/17/2007	†
WANK. <Class 25>	78,421,170 (5/18/2004)	3/7/2006	9/26/2006
VELVETPARK DYKE CULTURE IN BLOOM <Class 16>	78,448,110 (7/8/2004)	5/23/2006	8/15/2006
DYKEDOLLS <Class 28>	78,497,352 (10/9/2004)	4/10/2007	6/26/2007
OSHIRT <Class 25>	78,522,338 (11/24/2004)	9/27/2005	†
EFENK?L <Classes 16, 25>	78,536,608 (12/21/2004)	11/21/2006	2/6/2007

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
OUR MEMBERS GET LAID & OUR AFFILIATES GET PAID! <Class 35>	78,545,359 (1/11/2005)	6/13/2006	9/5/2006
ONE JACK OFF <Class 25>	78,604,378 (4/7/2005)	9/18/2007	6/17/2008
FUW <Class 25>	78,613,631 (4/21/2005)	8/8/2006	10/24/2006
WTF <Class 41>	78,623,114 (5/4/2005)	8/15/2006	†
ANGRY PUSSY <Class 25>	78,657,002 (6/23/2005)	9/2/2008	†
DIRTY HOE LANDSCAPIN G <Class 44>	78,677,596 (7/25/2005)	11/14/2006	1/30/2007
WHIPPEDASS <Class 41>	78,680,652 (7/28/2005)	8/14/2007	10/30/2007
PRICK PILLS <Class 20>	78,684,903 (8/3/2005)	1/9/2007	1/1/2008
SCREW YOU <Class 25>	78,699,134 (8/24/2005)	12/1/2009	9/24/2013

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
THE SEX WHISPERER <Class 9>	78,791,631 (1/13/2006)	9/4/2007	†
SWEATYBALL Z <Class 25>	78,834,247 (3/10/2006)	1/30/2007	†
SCREW YOU <Classes 3, 10, 32>	78,874,735 (5/2/2006)	11/17/2009	4/2/2013
GOY CRAZY <Class 25>	78,898,405 (6/1/2006)	8/28/2007	†
MILPH <Classes 16, 25, 26>	78,980,326 (6/8/2006)	8/21/2007	7/8/2008
MILPH <Class 14>	78,903,398 (6/8/2006)	8/21/2007	†
CHASING PURPOSE 'TIL IT MEETS EXISTENCE CP TIME EST 1999 <Class 25>	78,917,364 (6/26/2006)	4/1/2008	6/17/2008
SUPER GIMP <Classes 16, 25>	78,917,737 (6/27/2006)	9/25/2007	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
POCHA <Class 25>	78,919,432 (6/28/2006)	5/22/2007	2/5/2008
POCHO <Class 25>	78,919,434 (6/28/2006)	5/22/2007	2/5/2008
EL CARAJO INTERNATIONAL TAPAS & WINES <Class 43>	77,004,537 (9/21/2006)	11/20/2007	2/5/2008
CP TIME <Class 25>	77,019,230 (10/11/2006)	3/25/2008	6/10/2008
DAME UN CABRON <Class 32>	77,060,641 (12/8/2006)	10/23/2007	†
BAZZA A BAMF TEA! <Class 30>	77,063,697 (12/13/2006)	5/20/2008	†
MILF NEXT DOOR <Class 41>	77,064,757 (12/14/2006)	8/5/2008	10/21/2008
ROADHEAD INDUSTRIES NEED IT. WANT IT. GOT IT. <Class 25>	77,093,949 (1/29/2007)	1/22/2008	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
LONGCOCK'S <Class 33>	77,161,404 (4/20/2007)	6/17/2008	†
RED PUSSY <Class 32>	77,162,516 (4/21/2007)	8/26/2008	†
I'M RICK JAMES BITCH <Class 25>	77,207,411 (6/15/2007)	12/16/2008	†
HIMMEL ARSCH & ZWIRN <Classes 18, 21, 25, 32>	77,242,166 (7/30/2007)	3/17/2009	6/2/2009
TERDZ <Class 30>	77,258,747 (8/18/2007)	4/29/2008	9/23/2008
DAMN GIRL MAGAZINE <Class 41>	77,390,430 (2/6/2008)	1/27/2009	10/12/2010
TA-CABRON <Class 43>	77,410,171 (2/29/2008)	4/28/2009	4/6/2010
FUBAR <Class 5>	77,419,918 (3/12/2008)	3/10/2009	11/10/2009
PURPLE STUFF <Class 32>	77,446,644 (4/11/2008)	5/18/2010	8/3/2010
.XXX <Class 16>	77,510,626 (6/28/2008)	5/19/2009	4/20/2010

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PURPLE STUFF <Class 32>	77,520,464 (7/11/2008)	5/11/2010	7/27/2010
PURPLE STUFF <Class 32>	77,520,466 (7/11/2008)	5/11/2010	7/27/2010
AXE HOLE <Class 25>	77,522,972 (7/15/2008)	5/12/2009	†
BLONDE PUSSY <Class 32>	77,523,080 (7/15/2008)	3/10/2009	†
AXE HOLE <Class 25>	77,979,567 (7/15/2008)	5/12/2009	†
MERDE <Class 16>	77,537,063 (8/1/2008)	6/1/2010	8/17/2010
BIG EFFIN GARAGE <Class 42>	77,595,225 (10/17/2008)	4/5/2011	†
BIG F'N GARAGE <Class 42>	77,595,240 (10/17/2008)	3/29/2011	†
NASTY BITCH <Class 32>	77,616,001 (11/17/2008)	5/25/2010	9/27/2011
TOPA <Class 33>	77,637,758 (12/22/2008)	5/3/2011	12/27/2011

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SNATCH <Class 25>	77,639,364 (12/23/2008)	1/5/2010	†
COCKTALES <Class 41>	77,641,819 (12/30/2008)	6/21/2011	9/6/2011
SNATCH <Class 25>	77,665,554 (2/6/2009)	12/29/2009	3/16/2010
COCKSURE <Classes 9, 41>	77,778,633 (7/10/2009)	7/13/2010	9/28/2010
MBS COCKTALE COLLECTION <Class 25>	77,797,702 (8/5/2009)	3/30/2010	7/17/2012
PUSSY NATURAL ENERGY <Class 32>	77,817,308 (9/1/2009)	1/4/2011	12/4/2012
BLEAUMEI <Class 25>	77,841,081 (10/5/2009)	4/13/2010	†
COCKTANE <Class 32>	77,877,163 (11/20/2009)	7/27/2010	†
BEITZIM <Classes 14, 25>	77,890,751 (12/10/2009)	5/25/2010	8/10/2010
FRESH BALLS <Class 3>	77,897,974 (12/21/2009)	1/4/2011	3/22/2011

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
HTFU <Class 25>	77,902,017 (12/29/2009)	5/31/2011	3/13/2012
BOYS ARE STUPID, THROW ROCKS AT THEM <Classes 16, 18, 25>	77,934,946 (2/12/2010)	5/1/2012	7/17/2012
BOYS ARE STUPID, THROW ROCKS AT THEM <Class 41>	77,934,899 (2/12/2010)	5/1/2012	†
F CANCER <Class 25>	77,983,618 (3/9/2010)	5/31/2011	6/10/2014
CMTHRFCKNT <Class 41>	77,954,054 (3/9/2010)	3/8/2011	†
CMTHRFCKNT <Class 25>	77,954,169 (3/9/2010)	3/8/2011	†
F CANCER <Class 25>	77,954,532 (3/9/2010)	5/31/2011	†
CMTHRFCKNT <Class 9>	77,956,237 (3/11/2010)	3/8/2011	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BAMF <Class 12>	85,012,455 (4/13/2010)	12/20/2011	10/16/2012
DILLIGAF BY BOHICA BILL <Classes 25, 35>	85,020,964 (4/22/2010)	3/19/2013	6/4/2013
COCK RUB <Class 30>	85,050,620 (5/28/2010)	5/24/2011	12/11/2012
FUGGIN AWESOME <Class 41>	85,056,466 (6/7/2010)	10/8/2013	9/2/2014
WHITE ASS <Class 33>	85,100,568 (8/5/2010)	7/19/2011	†
FN GOLDEN <Class 41>	85,129,726 (9/15/2010)	12/6/2011	2/21/2012
IF WE TOUCH IT, IT'S FN GOLDEN <Class 41>	85,129,728 (9/15/2010)	12/6/2011	2/21/2012
F* WORD FRIDAY <Class 41>	85,133,005 (9/19/2010)	6/28/2011	9/13/2011
BUTTERLOADS <Class 41>	85,134,454 (9/21/2010)	9/20/2011	12/6/2011

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
ROCK THE F OUT <Class 42>	85,145,075 (10/5/2010)	10/4/2011	8/14/2012
DUBE HEMP <Class 32>	85,181,806 (11/20/2010)	7/31/2012	11/5/2013
HOTTER THAN A MOFO <Classes 29, 30>	85,237,185 (2/8/2011)	7/26/2011	7/29/2014
HOTTER THAN A MOFO <Class 30>	85,977,648 (2/8/2011)	7/26/2011	11/27/2012
69 LUNCH FOR TWO <Class 25>	85,282,477 (3/31/2011)	10/25/2011	6/19/2012
HAPPY TUGS <Class 41>	85,342,637 (6/9/2011)	5/14/2013	7/30/2013
SLOPPY POPPY <Class 33>	85,373,166 (7/16/2011)	2/7/2012	7/31/2012
SLOPPY BALLS <Class 43>	85,373,158 (7/16/2011)	2/7/2012	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
ROCK 'N' SANDWICHES R'N'R HOME OF THE PIZZA SANDWICH <Class 43>	85,415,963 (9/6/2011)	9/11/2012	†
SNACK BOX <Class 10>	85,458,774 (10/28/2011)	2/12/2013	4/30/2013
BOOTY <Class 10>	85,458,830 (10/28/2011)	2/12/2013	†
MUFF SPIDER <Class 10>	85,464,510 (11/4/2011)	2/12/2013	†
SLUTLOAD <Class 38>	85,484,399 (11/30/2011)	1/1/2013	3/19/2013
LAY PIPE <Class 25>	85,525,358 (1/25/2012)	5/7/2013	3/11/2014
A F S U <Class 25>	85,547,238 (2/20/2012)	1/1/2013	†
BLACK KANGO <Class 42>	85,619,830 (5/8/2012)	1/15/2013	9/10/2013
THE HANDIE <Class 10>	85,620,655 (5/9/2012)	5/21/2013	9/16/2014
PAWG <Class 41>	85,627,933 (5/17/2012)	10/23/2012	12/8/2015

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FOXY BOX <Class 44>	85,668,913 (7/4/2012)	1/22/2013	4/9/2013
FOXY BOX <Class 3>	85,668,920 (7/4/2012)	1/22/2013	†
BAKED BY A NEGRO <Class 30>	85,708,593 (8/21/2012)	8/13/2013	10/29/2013
THE ORIGINAL GANG BANGERS <Class 25>	85,723,051 (9/7/2012)	3/26/2013	6/11/2013
F'D UP <Classes 25, 28>	85,762,896 (10/24/2012)	9/3/2013	3/11/2014
BACKROOM FACIALS <Class 41>	85,768,581 (10/31/2012)	11/12/2013	1/28/2014
GIRL BONER <Class 41>	85,770,192 (11/2/2012)	6/17/2014	4/7/2015
FACIAL FEST <Class 41>	85,771,170 (11/5/2012)	11/12/2013	1/28/2014
CAMOTOES <Class 25>	85,775,183 (11/8/2012)	12/10/2013	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CANNABIS.CA <Classes 16, 44>	85,779,234 (11/14/2012)	6/13/2017	8/29/2017
FA'QUE <Class 33>	85,815,206 (1/3/2013)	6/24/2014	†
COOLIE HIGH CLOTHING COMPANY <Class 25>	85,834,638 (1/28/2013)	2/25/2014	7/15/2014
THAT'S SO GAY <Class 28>	85,876,216 (3/14/2013)	6/3/2014	9/30/2014
THAT'S SO GAY <Class 9>	85,876,233 (3/14/2013)	6/3/2014	†
COOCH <Class 9>	85,896,602 (4/5/2013)	10/1/2013	12/17/2013
#DATASS <Class 16>	85,915,438 (4/26/2013)	4/8/2014	6/24/2014
CRACKA AZZ SKATEBOARDS <Classes 25, 28>	85,927,818 (5/9/2013)	12/17/2013	8/19/2014
LEFT NUT BREWING CO. <Class 32>	85,935,569 (5/17/2013)	12/22/2015	11/14/2017

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FU-C <Class 36>	85,945,468 (5/29/2013)	6/3/2014	4/14/2015
THE MIDDLE FINGER PROJECT <Classes 9, 35, 41>	85,968,620 (6/24/2013)	9/2/2014	11/18/2014
#DATASS <Classes 22, 25>	86,034,915 (8/12/2013)	4/15/2014	12/30/2014
NUT SACK DOUBLE BROWN ALE <Class 32>	86,038,803 (8/15/2013)	12/15/2015	3/1/2016
HUGE WOOD <Class 41>	86,076,522 (9/27/2013)	9/30/2014	12/16/2014
EFFÜE <Class 25>	86,164,156 (1/13/2014)	2/17/2015	†
FLIPSTOP <Classes 9, 35, 42>	86,198,426 (2/20/2014)	9/19/2017	†
COCK CONTROL <Class 41>	86,270,103 (5/2/2014)	5/5/2015	†
EFFBOMB <Class 5>	86,356,940 (8/4/2014)	10/20/2015	8/22/2017

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DICK <Class 25>	86,380,071 (8/28/2014)	3/29/2016	6/14/2016
CHUCHA CAPONE'S <Classes 30, 32, 33, 43>	86,423,765 (10/14/2014)	5/17/2016	†
ARMAFUGGI NGEDDON <Class 25>	86,512,620 (1/23/2015)	12/29/2015	8/2/2016
FUGAZI <Class 9>	86,517,426 (1/28/2015)	3/15/2016	5/31/2016
WONDERFUL WORLD OF BONING <Class 41>	86,539,463 (2/19/2015)	1/19/2016	4/5/2016
COCK N' KITTEN <Class 3>	86,559,304 (3/10/2015)	2/16/2016	†
TERDS <Class 30>	86,589,075 (4/7/2015)	7/26/2016	†
EFFWORDS <Class 28>	86,627,159 (5/12/2015)	11/17/2015	4/19/2016
TURKEY DICK <Class 30>	86,648,220 (6/2/2015)	6/13/2017	†

Applied-For Word Mark Receiving § 1052(a) Refusal <Int'l Class>	**Applied-For Word Mark Serial No. (Application Date)**	**Publication Date**	**Registration Date**
KUM KLEAN NATURAL SOAPS <Class 3>	86,675,699 (6/26/2015)	2/2/2016	†

† The application was abandoned after publication.

Appendix 7
All Word-Mark Applications for Marks of More than One Letter Filed From 2003 Through 2015 That Identically Matched a Mark or Term the PTO Elsewhere Determined to Be Immoral or Scandalous But that Received No § 1052(a) Immoral-or-Scandalous Refusal

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
$#!+ <Classes 20, 25>	77,668,860 (2/12/2009)	1/5/2010	.
69 <Class 25>	78,981,098 (10/20/2004)	2/27/2007	.
69 <Classes 3, 10>	78,730,269 (10/10/2005)	6/6/2006	9/8/2009
69 <Class 25>	85,412,766 (9/1/2011)	2/7/2012	11/20/2012
69 <Class 25>	86,414,064 (10/3/2014)	3/17/2015	.
69 <Class 15>	78,502,810 (10/20/2004)	2/27/2007	.
A.N.A.L. <Class 25>	78,375,319 (2/27/2004)	1/4/2005	.
ASS <Class 9>	76,674,406 (3/22/2007)	10/14/2008	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
ASS <Class 9>	76,499,576 (3/21/2003)	1/6/2004	.
ASH-HOLE <Class 11>	86,745,394 (9/2/2015)	3/1/2016	1/3/2017
ASS <Class 25>	86,171,122 (1/21/2014)	6/3/2014	10/7/2014
BALL <Classes 18, 21, 25>	86,458,906 (11/19/2014)	9/1/2015	11/17/2015
BALL <Class 6>	85,090,087 (7/21/2010)	1/4/2011	3/22/2011
BALL <Class 30>	77,847,188 (10/13/2009)	3/27/2018	.
BALL <Classes 35, 39>	85,527,057 (1/27/2012)	7/10/2012	.
BALL <Class 40>	86,766,948 (9/24/2015)	3/8/2016	5/24/2016
BALL <Class 25>	85,966,576 (6/21/2013)	11/19/2013	.
BALL <Classes 40, 42>	85,853,514 (2/19/2013)	7/16/2013	10/1/2013
BALL <Class 6>	86,766,935 (9/24/2015)	3/8/2016	5/24/2016
BALL <Classes 40, 42>	85,853,519 (2/19/2013)	7/16/2013	10/1/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BALL <Class 14>	76,515,375 (4/24/2003)	12/30/2003	7/13/2004
BALL <Class 7>	76,621,307 (11/18/2004)	10/11/2005	5/9/2006
BALL <Class 9>	76,509,398 (4/25/2003)	12/2/2003	3/15/2005
BALL <Class 41>	77,391,723 (2/7/2008)	7/22/2008	10/7/2008
BALL <Class 25>	85,966,545 (6/21/2013)	11/19/2013	.
BALL <Classes 1, 31>	86,426,688 (10/17/2014)	5/19/2015	8/4/2015
BALLZACK <Class 9>	77,807,774 (8/19/2009)	6/29/2010	9/14/2010
BS <Class 25>	77,143,985 (3/29/2007)	10/2/2007	3/25/2008
BALLS <Class 35>	77,085,961 (1/18/2007)	7/3/2007	9/18/2007
BALLS <Class 16>	76,578,485 (3/1/2004)	11/30/2004	.
BALLS <Class 33>	77,777,661 (7/9/2009)	11/24/2009	4/26/2011
BALLZ <Class 16>	78,715,110 (9/17/2005)	12/19/2006	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BALLZ <Class 43>	86,327,244 (7/2/2014)	11/18/2014	.
BALLS <Classes 16, 41>	77,468,867 (5/8/2008)	4/14/2009	10/9/2012
BALZ <Class 3>	85,888,304 (3/27/2013)	9/3/2013	.
BALLS <Class 35>	86,240,435 (4/2/2014)	4/7/2015	.
BALLZEE <Class 28>	78,373,819 (2/25/2004)	9/27/2005	12/20/2005
BALZZ <Class 28>	85,111,176 (8/19/2010)	6/28/2011	.
BALLS <Class 9>	78,219,746 (2/27/2003)	2/24/2004	8/3/2004
BALLS <Class 41>	85,071,112 (6/24/2010)	6/7/2011	8/23/2011
B.A.M.F. <Class 25>	78,345,314 (12/24/2003)	6/27/2006	9/19/2006
BAMF <Class 25>	85,496,386 (12/15/2011)	9/24/2013	8/12/2014
B.A.M.F. <Class 13>	86,810,199 (11/5/2015)	4/12/2016	6/28/2016
BAMF <Class 9>	76,560,985 (11/3/2003)	7/27/2004	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BANG <Class 44>	86,569,409 (3/19/2015)	9/22/2015	12/8/2015
B·A·N·G <Class 28>	76,691,300 (7/14/2008)	12/9/2008	2/24/2009
BANG <Class 2>	85,633,227 (5/23/2012)	10/30/2012	.
BANG <Classes 9, 35, 38, 42, 45>	77,852,667 (10/20/2009)	3/30/2010	.
BANGG! <Class 25>	76,573,894 (2/4/2004)	11/16/2004	4/18/2006
BANG! <Class 3>	78,382,539 (3/11/2004)	1/25/2005	.
BANG <Class 5>	78,637,163 (5/25/2005)	2/28/2006	12/9/2008
BANG! <Class 16>	78,692,386 (8/15/2005)	5/2/2006	.
BANG <Class 9>	77,169,046 (4/30/2007)	4/13/2010	.
BANG <Class 32>	77,865,654 (11/5/2009)	10/19/2010	2/11/2014
B'ANG <Classes 9, 10, 16, 18, 22, 25, 40>	78,884,833 (5/16/2006)	2/19/2008	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BANG <Class 32>	77,822,181 (9/8/2009)	3/1/2011	5/17/2011
BANG <Class 3>	77,451,882 (4/18/2008)	9/9/2008	5/3/2011
BANG <Class 33>	76,587,708 (4/19/2004)	2/7/2006	5/2/2006
BANG <Class 28>	85,180,620 (11/18/2010)	4/5/2011	11/1/2011
BANG! <Class 20>	78,350,498 (1/12/2004)	10/26/2004	9/13/2005
BANG <Class 32>	77,247,665 (8/6/2007)	1/29/2008	5/19/2009
BANG <Class 16>	86,249,534 (4/11/2014)	7/22/2014	.
BANG! <Class 41>	86,980,268 (11/4/2015)	10/18/2016	1/3/2017
BANG <Class 41>	86,249,589 (4/11/2014)	7/22/2014	.
BANG <Class 35>	85,549,329 (2/22/2012)	7/10/2012	9/25/2012
BANG <Classes 9, 34, 35>	86,598,258 (4/15/2015)	9/22/2015	3/29/2016
BANG! <Class 41>	86,980,267 (11/4/2015)	10/18/2016	1/3/2017

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BANG <Classes 9, 35, 38, 42, 45>	77,852,338 (10/20/2009)	3/30/2010	.
BANG! <Classes 16, 28>	79,065,326 (9/24/2008)	6/2/2009	8/18/2009
BS <Class 35>	77,003,124 (9/20/2006)	6/26/2007	.
BASTARD <Class 32>	78,222,999 (3/7/2003)	7/13/2004	10/18/2005
BASTARD <Class 25>	79,975,041 (3/5/2007)	5/13/2008	7/29/2008
BASSTURD <Class 25>	85,657,509 (6/21/2012)	11/13/2012	10/8/2013
BEARD <Class 25>	85,626,166 (5/15/2012)	10/9/2012	.
BEARD <Class 3>	86,206,224 (2/27/2014)	12/30/2014	3/17/2015
BEAT IT! <Class 16>	77,605,721 (11/2/2008)	3/24/2009	.
BEAT IT <Class 25>	78,533,262 (12/15/2004)	9/13/2005	.
BEAT IT <Class 14>	78,533,232 (12/15/2004)	9/13/2005	.
BEAT IT! <Class 5>	78,451,686 (7/16/2004)	5/29/2007	8/14/2007

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BEAT IT <Class 3>	85,461,456 (11/1/2011)	2/28/2012	7/17/2012
BEATIT <Class 9>	86,766,706 (9/24/2015)	2/16/2016	5/3/2016
BEAVER <Classes 7, 12>	77,428,521 (3/21/2008)	4/28/2009	7/14/2009
BEAVER <Class 3>	85,821,724 (1/11/2013)	1/28/2014	4/15/2014
BEAVER <Class 30>	77,925,366 (2/1/2010)	8/24/2010	11/9/2010
BEEVER <Class 3>	79,070,269 (4/21/2009)	6/8/2010	8/24/2010
BEAVER <Class 28>	85,061,745 (6/14/2010)	11/9/2010	5/24/2011
BEAVER <Classes 12, 37>	77,691,841 (3/16/2009)	6/6/2017	
BEAVER <Class 16>	77,113,707 (2/22/2007)	7/21/2009	10/6/2009
BEAVER <Class 32>	85,016,445 (4/17/2010)	9/14/2010	3/6/2012
BEAVERBONG <Class 35>	76,514,155 (5/12/2003)	12/30/2003	1/4/2005
BIG COCKE <Class 25>	77,870,338 (11/11/2009)	2/15/2011	5/3/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BIG COQ <Class 33>	85,039,558 (5/15/2010)	10/19/2010	3/13/2012
BS <Class 33>	78,285,818 (8/11/2003)	9/21/2004	12/14/2004
BITCH <Class 32>	77,466,281 (5/5/2008)	9/30/2008	.
BITCH <Class 3>	78,888,670 (5/22/2006)	8/28/2007	3/25/2008
BITCH <Class 33>	85,683,977 (7/23/2012)	12/25/2012	.
BITCH <Class 36>	78,845,101 (3/24/2006)	11/7/2006	.
BITCH <Class 18>	85,227,441 (1/27/2011)	6/16/2015	9/29/2015
BITCH <Class 33>	78,821,582 (2/23/2006)	5/5/2009	7/21/2009
BITCH <Class 25>	77,842,390 (10/6/2009)	8/30/2011	6/4/2013
BIT@HES! <Class 16>	85,142,925 (10/1/2010)	3/15/2011	5/31/2011
BJ'S <Class 32>	85,363,576 (7/5/2011)	6/5/2012	9/15/2015
BJ'S <Class 33>	86,678,234 (6/29/2015)	11/17/2015	2/2/2016

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BJ'S <Classes 29, 30, 32>	86,709,014 (7/29/2015)	5/24/2016	.
BJ'S <Class 25>	85,025,280 (4/28/2010)	10/5/2010	.
BJ'S <Class 43>	85,314,987 (5/6/2011)	9/20/2011	12/6/2011
BJ'S <Class 32>	85,830,784 (1/23/2013)	4/16/2013	7/2/2013
BJ'S <Class 43>	77,103,211 (2/8/2007)	8/7/2007	10/23/2007
BJ'S <Class 32>	86,065,901 (9/16/2013)	1/21/2014	4/8/2014
BJ'S <Classes 35, 43>	77,451,370 (4/17/2008)	9/16/2008	8/3/2010
BLVCK <Class 34>	85,967,785 (6/24/2013)	5/17/2016	8/2/2016
BLVCK <Class 34>	86,036,156 (8/13/2013)	5/17/2016	8/2/2016
BLAC $ <Class 9>	85,077,829 (7/4/2010)	11/30/2010	.
BLACK <Classes 30, 35>	77,605,895 (11/3/2008)	3/24/2009	3/23/2010
BLK <Classes 35, 36>	85,555,020 (2/28/2012)	7/17/2012	5/28/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BLACK <Classes 35, 36, 39, 41, 42, 43, 44, 45>	77,661,119 (2/2/2009)	10/22/2013	6/10/2014
BLAC <Classes 16, 41>	86,173,621 (1/23/2014)	1/13/2015	3/31/2015
BLACK <Class 7>	76,676,013 (4/26/2007)	10/23/2007	1/8/2008
BLAK <Class 32>	78,771,559 (12/12/2005)	9/26/2006	10/30/2007
BLACCK <Classes 9, 25, 41>	78,730,094 (10/10/2005)	7/4/2006	.
BLACK <Class 33>	85,770,019 (11/2/2012)	10/15/2013	.
BLACK <Class 9>	76,528,872 (7/10/2003)	3/23/2004	9/19/2006
BLACK <Class 36>	78,275,043 (7/16/2003)	8/17/2004	11/9/2004
BLACK <Classes 6, 9, 18, 25>	79,100,176 (4/18/2011)	1/10/2012	3/27/2012
BLACK <Class 28>	77,445,692 (4/11/2008)	9/9/2008	11/25/2008
BLACK <Class 3>	77,461,542 (4/30/2008)	9/16/2008	1/19/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BLACK <Class 12>	86,098,721 (10/22/2013)	10/21/2014	8/4/2015
BLAK <Class 15>	77,534,383 (7/30/2008)	1/13/2009	12/1/2009
BLACK <Class 5>	77,671,586 (2/16/2009)	3/9/2010	5/25/2010
BLACK <Class 41>	78,943,168 (8/2/2006)	12/11/2007	2/26/2008
BLAK <Class 15>	77,648,248 (1/13/2009)	5/5/2009	4/13/2010
BLAAK <Classes 3, 18, 25>	79,060,127 (6/20/2008)	10/20/2009	1/5/2010
BLAK <Class 35>	85,670,649 (7/6/2012)	12/4/2012	2/19/2013
BLAX <Class 2>	78,334,573 (12/1/2003)	8/17/2004	6/6/2006
BLACKZ <Classes 29, 30, 31>	85,623,202 (5/11/2012)	12/18/2012	3/24/2015
BLACK'S <Class 43>	77,328,019 (11/13/2007)	4/29/2008	7/15/2008
BS <Class 20>	85,755,243 (10/16/2012)	10/15/2013	

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BLOW <Class 3>	86,021,130 (7/26/2013)	12/17/2013	.
BLO <Class 44>	77,040,010 (11/8/2006)	11/3/2009	1/19/2010
BLOW <Classes 35, 45>	86,233,571 (3/27/2014)	2/3/2015	.
BLOW <Class 5>	77,164,255 (4/24/2007)	10/16/2007	8/26/2008
BLOW <Class 41>	85,197,715 (12/14/2010)	6/14/2011	8/30/2011
BLO <Class 21>	77,527,717 (7/21/2008)	6/22/2010	9/7/2010
BLO <Class 3>	85,199,406 (12/16/2010)	10/11/2011	12/27/2011
BLO <Class 45>	86,570,376 (3/19/2015)	8/18/2015	11/3/2015
BLO <Classes 9, 41>	78,516,877 (11/15/2004)	10/11/2005	.
BLOW <Classes 11, 34>	85,817,921 (1/8/2013)	7/16/2013	2/11/2014
BLOW <Class 35>	86,618,883 (5/4/2015)	2/23/2016	7/11/2017
BLO <Class 25>	78,429,013 (6/2/2004)	5/10/2005	8/2/2005

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BLO <Class 4>	85,339,795 (6/7/2011)	10/25/2011	.
BLOW <Class 44>	76,510,122 (4/28/2003)	1/20/2004	11/2/2004
BLOW ME <Class 35>	77,932,786 (2/10/2010)	6/22/2010	.
BLOWN <Class 42>	77,502,087 (6/18/2008)	11/11/2008	.
BLOWN <Class 44>	85,465,489 (11/6/2011)	4/17/2012	.
BLUE BALL <Class 32>	85,944,552 (5/29/2013)	10/8/2013	.
BLU BALL <Class 7>	85,805,689 (12/18/2012)	5/14/2013	10/22/2013
BLUE BALLZ <Class 34>	86,561,999 (3/12/2015)	8/4/2015	10/20/2015
BLUE BALLS <Class 25>	86,368,818 (8/17/2014)	3/3/2015	5/19/2015
BLUBALLS <Class 33>	78,400,343 (4/12/2004)	10/4/2005	.
BS <Class 25>	85,055,249 (6/4/2010)	11/2/2010	5/10/2011
BONA <Classes 2, 3>	77,279,164 (9/13/2007)	3/4/2008	5/20/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BONA <Class 20>	77,490,258 (6/4/2008)	5/5/2009	7/21/2009
BONA <Class 28>	76,525,737 (6/27/2003)	11/11/2003	.
BONE <Class 16>	76,485,120 (1/24/2003)	9/9/2003	12/2/2003
BONE <Class 41>	85,464,436 (11/4/2011)	4/17/2012	7/3/2012
B.O.N.E. <Class 13>	85,233,249 (2/3/2011)	6/21/2011	4/24/2012
BONE <Class 28>	85,485,407 (12/1/2011)	5/15/2012	7/31/2012
BONE <Class 9>	77,123,072 (3/6/2007)	12/25/2007	7/8/2008
BONE <Class 9>	77,921,930 (1/27/2010)	6/15/2010	.
BO KNERR <Class 5>	86,662,909 (6/15/2015)	10/6/2015	.
BONER <Class 28>	77,952,998 (3/8/2010)	6/21/2011	7/3/2012
BONER <Class 28>	78,417,864 (5/13/2004)	12/12/2006	.
BONER <Classes 25, 28>	76,535,752 (8/11/2003)	5/11/2004	8/3/2004

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BONG <Class 33>	78,503,302 (10/20/2004)	8/22/2006	.
BONG <Class 43>	78,648,894 (6/12/2005)	2/28/2006	3/17/2009
BONG <Class 25>	86,436,695 (10/28/2014)	3/31/2015	.
BOOB <Class 10>	85,467,729 (11/8/2011)	5/7/2013	7/8/2014
BOOB <Classes 3, 5, 25, 35>	79,136,180 (7/10/2013)	7/7/2015	12/29/2015
BOOB <Class 25>	79,007,595 (10/25/2004)	6/10/2008	8/26/2008
BS <Class 42>	86,808,250 (11/3/2015)	4/5/2016	6/21/2016
BOY <Class 3>	86,983,198 (11/24/2015)	4/19/2016	11/7/2017
BOY <Class 3>	86,830,248 (11/24/2015)	4/19/2016	.
BOY <Class 3>	86,830,219 (11/24/2015)	4/19/2016	9/19/2017
BOY <Classes 14, 25>	85,946,830 (5/30/2013)	2/3/2015	4/21/2015
BOY <Class 9>	79,001,268 (11/12/2003)	3/14/2006	6/6/2006

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BOY <Class 28>	77,794,128 (7/31/2009)	2/2/2010	.
BOY <Class 18>	77,260,208 (8/21/2007)	2/17/2009	5/5/2009
BRASS BALLS <Class 28>	77,923,419 (1/29/2010)	12/7/2010	.
BRASS BALLS <Class 12>	78,938,035 (7/26/2006)	3/13/2007	.
BRASS BALLS <Class 30>	77,238,369 (7/25/2007)	2/26/2008	5/13/2008
BRASS BALLS <Class 30>	76,503,065 (3/28/2003)	11/11/2003	.
BRASS BALLS <Class 12>	77,345,602 (12/6/2007)	11/25/2008	2/10/2009
BS <Class 41>	86,437,148 (10/28/2014)	10/6/2015	12/22/2015
BS <Class 28>	78,842,363 (3/21/2006)	11/7/2006	1/23/2007
BS <Classes 16, 42>	79,021,553 (4/18/2005)	1/22/2008	4/8/2008
BS <Classes 14, 18>	79,046,082 (6/21/2007)	9/9/2008	11/25/2008
BS <Class 3>	86,709,988 (7/30/2015)	12/15/2015	3/1/2016

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BS <Class 10>	78,498,723 (10/12/2004)	2/21/2006	5/16/2006
B'S <Class 18>	78,598,167 (3/30/2005)	12/20/2005	3/14/2006
BS <Class 25>	77,787,885 (7/23/2009)	12/22/2009	.
BS <Class 26>	86,150,561 (12/22/2013)	8/19/2014	11/4/2014
BS <Class 25>	76,533,936 (7/31/2003)	3/23/2004	.
B.S. <Class 33>	85,362,554 (7/3/2011)	12/13/2011	2/28/2012
BS <Class 33>	78,276,117 (7/18/2003)	4/20/2004	1/25/2005
B.S. <Class 32>	86,169,547 (1/19/2014)	6/3/2014	.
BS <Class 25>	77,857,261 (10/26/2009)	7/20/2010	10/5/2010
BS <Class 9>	85,823,545 (1/15/2013)	6/11/2013	11/5/2013
BS <Class 35>	86,710,011 (7/30/2015)	6/21/2016	9/6/2016
B S <Class 11>	76,613,474 (9/27/2004)	9/6/2005	11/29/2005

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BS <Class 25>	78,255,205 (5/28/2003)	3/2/2004	5/25/2004
BS <Class 18>	78,540,598 (12/31/2004)	11/29/2005	2/21/2006
BS <Class 3>	77,949,810 (3/3/2010)	12/7/2010	10/18/2011
BS <Class 43>	85,469,125 (11/10/2011)	5/1/2012	7/2/2013
BS <Class 25>	78,540,604 (12/31/2004)	11/29/2005	2/21/2006
BS <Class 7>	79,140,045 (10/21/2013)	5/20/2014	8/5/2014
BS <Class 25>	76,533,935 (7/31/2003)	3/23/2004	11/9/2004
BS <Class 25>	78,915,654 (6/23/2006)	7/24/2007	
B:S <Class 25>	78,235,906 (4/9/2003)	12/16/2003	3/9/2004
BUD.TV <Class 38>	78,952,712 (8/15/2006)	7/24/2007	10/9/2007
BUD.TV <Class 35>	78,952,716 (8/15/2006)	7/24/2007	10/9/2007
BUD <Class 9>	86,555,400 (3/6/2015)	8/11/2015	

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
BUD <Class 35>	85,421,634 (9/13/2011)	2/21/2012	.
ÚBUD <Class 35>	86,783,463 (10/9/2015)	10/25/2016	1/10/2017
BUD <Class 21>	86,407,686 (9/26/2014)	3/3/2015	.
BS <Classes 20, 24>	76,528,727 (7/9/2003)	11/23/2004	12/27/2005
BUMBUM <Class 25>	78,578,912 (3/2/2005)	12/15/2009	.
BUTTCRACKER <Class 8>	86,379,954 (8/28/2014)	1/27/2015	.
BUTTHOLE <Class 34>	85,611,931 (4/30/2012)	10/2/2012	6/11/2013
CABRON <Classes 30, 33>	77,195,037 (5/31/2007)	4/28/2009	12/14/2010
CABRON <Classes 32, 33>	77,530,030 (7/23/2008)	1/3/2012	10/16/2012
CABRON <Class 32>	77,978,287 (12/7/2006)	10/9/2007	12/29/2009
CABRON <Class 32>	77,059,379 (12/7/2006)	10/9/2007	12/21/2010
CACHUÁ <Classes 3, 35, 44>	86,746,759 (9/3/2015)	1/3/2017	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CACHUÁ <Classes 3, 35, 44>	86,746,727 (9/3/2015)	1/3/2017	.
CAJONES <Class 32>	78,452,365 (7/17/2004)	9/13/2005	.
CAJONES <Class 28>	77,310,580 (10/23/2007)	3/25/2008	6/10/2008
CAK <Classes 35, 41>	85,850,796 (2/15/2013)	1/14/2014	4/1/2014
CANNABIS <Class 41>	85,865,340 (3/4/2013)	5/21/2013	1/28/2014
CANNABIS <Class 41>	85,427,784 (9/21/2011)	2/28/2012	.
CANNABIS <Class 35>	86,067,054 (9/17/2013)	4/15/2014	.
CANNABIS <Class 25>	86,066,960 (9/17/2013)	4/15/2014	.
CAZZO <Class 41>	79,006,168 (7/26/2004)	1/17/2006	4/11/2006
CHRIST <Class 16>	85,487,656 (12/5/2011)	1/15/2013	4/2/2013
CHRIST <Class 9>	79,157,403 (9/30/2014)	8/11/2015	10/27/2015
CHRIST <Classes 9, 11>	85,099,102 (8/3/2010)	7/26/2011	10/11/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CIRCLE JERKY <Class 29>	86,212,791 (3/6/2014)	8/18/2015	.
COÑO <Class 32>	78,769,624 (12/8/2005)	1/23/2007	.
KOCAINE <Class 25>	86,532,926 (2/12/2015)	6/30/2015	2/28/2017
COCAINE <Class 3>	78,820,405 (2/22/2006)	10/17/2006	.
COKAINE <Class 25>	79,029,937 (10/5/2006)	11/27/2007	2/12/2008
COCK <Class 5>	85,564,335 (3/8/2012)	7/31/2012	10/16/2012
COCKBLOCKER <Class 5>	86,640,395 (5/25/2015)	10/13/2015	.
COCKSOX <Class 25>	85,185,067 (11/24/2010)	1/24/2012	4/10/2012
COCKED & LOADED <Class 25>	77,051,851 (11/28/2006)	6/19/2007	.
COCKED & LOADED <Class 32>	85,146,710 (10/6/2010)	3/15/2011	5/31/2011
KOXX <Class 12>	85,172,333 (11/9/2010)	3/29/2011	6/14/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
COCKS <Classes 6, 16, 25>	76,488,319 (2/6/2003)	6/1/2004	8/24/2004
COCKSMAN <Classes 3, 25>	86,790,866 (10/16/2015)	3/22/2016	6/7/2016
COCKTAIL <Class 9>	85,537,563 (2/8/2012)	1/29/2013	.
COCKTAIL <Class 16>	85,104,253 (8/10/2010)	7/12/2011	.
COCKTAYL <Class 3>	78,954,935 (8/17/2006)	4/10/2007	1/26/2016
COCKTAIL <Class 3>	85,337,357 (6/3/2011)	11/15/2011	4/24/2012
COCKTAIL <Class 16>	77,066,765 (12/18/2006)	5/29/2007	.
COCKTAIL <Class 24>	76,595,921 (6/4/2004)	7/26/2005	.
COCKTAIL <Class 20>	76,595,923 (6/4/2004)	5/3/2005	.
COKE <Class 16>	78,264,374 (6/19/2003)	3/9/2004	6/1/2004
COKE <Class 32>	78,509,548 (11/2/2004)	4/11/2006	7/4/2006
COKE <Class 9>	78,264,308 (6/19/2003)	3/9/2004	6/1/2004

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
COKE <Class 20>	78,264,397 (6/19/2003)	3/23/2004	6/15/2004
COKE <Class 14>	78,264,357 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 32>	77,153,712 (4/11/2007)	9/18/2007	12/4/2007
COKE <Class 11>	78,264,318 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 21>	78,264,405 (6/19/2003)	3/23/2004	6/15/2004
COKE <Class 25>	78,264,410 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 12>	78,264,345 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 6>	78,264,301 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 28>	78,264,421 (6/19/2003)	3/23/2004	6/15/2004
COKE <Class 18>	78,264,382 (6/19/2003)	3/2/2004	5/25/2004
COKE <Class 4>	78,264,295 (6/19/2003)	3/2/2004	5/25/2004
COME <Class 43>	77,100,297 (2/6/2007)	8/7/2007	

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
COME <Class 16>	78,871,724 (4/27/2006)	6/26/2007	9/11/2007
COME <Class 16>	86,385,988 (9/4/2014)	2/3/2015	4/21/2015
COME TOGETHER <Class 20>	76,599,599 (6/25/2004)	6/14/2005	1/10/2006
COME TOGETHER <Class 35>	77,528,826 (7/22/2008)	2/10/2009	12/8/2009
COME TOGETHER <Class 16>	77,728,519 (5/4/2009)	9/22/2009	.
COME TOGETHER <Class 43>	77,728,527 (5/4/2009)	9/15/2009	.
COME TOGETHER <Class 45>	77,528,843 (7/22/2008)	2/3/2009	12/8/2009
CUM TOGETHER <Class 9>	76,528,502 (7/1/2003)	3/2/2004	5/25/2004
COME TOGETHER <Class 41>	77,528,838 (7/22/2008)	6/2/2009	12/8/2009
COME TOGETHER <Class 30>	77,728,524 (5/4/2009)	9/15/2009	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
COME TOGETHER <Class 42>	77,224,067 (7/7/2007)	12/18/2007	.
COME TOGETHER <Class 29>	77,728,522 (5/4/2009)	9/15/2009	.
COME TOGETHER <Class 9>	77,224,068 (7/7/2007)	12/18/2007	.
COME TOGETHER <Classes 25, 35>	78,599,352 (3/31/2005)	12/27/2005	.
COME TOGETHER <Class 38>	77,528,836 (7/22/2008)	2/3/2009	12/8/2009
COMETOGETHER <Class 35>	77,364,199 (1/4/2008)	1/6/2009	11/24/2009
COMFYBALLS <Class 25>	86,828,902 (11/23/2015)	5/24/2016	8/9/2016
COMING <Classes 38, 41, 42>	79,053,093 (3/20/2008)	8/5/2008	10/21/2008
COMING <Class 28>	77,739,067 (5/18/2009)	12/8/2009	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CONO <Classes 9, 16, 28, 41>	85,944,086 (5/28/2013)	5/6/2014	.
CONO <Class 11>	79,172,501 (7/30/2015)	5/24/2016	8/9/2016
CONO <Class 33>	78,274,387 (7/15/2003)	4/20/2004	.
CONO <Class 30>	78,830,074 (3/6/2006)	10/17/2006	1/2/2007
COOLIE <Class 30>	76,639,970 (6/2/2005)	3/14/2006	6/6/2006
KOOLIE <Class 28>	85,560,444 (3/5/2012)	7/24/2012	5/28/2013
CRACK <Classes 9, 38, 42>	86,542,432 (2/23/2015)	8/9/2016	.
CRACK <Class 43>	86,087,644 (10/9/2013)	2/18/2014	.
CRAC <Class 9>	85,456,685 (10/26/2011)	4/3/2012	.
CRACK <Class 32>	85,953,274 (6/7/2013)	5/13/2014	.
KRACK <Class 25>	78,785,877 (1/5/2006)	7/4/2006	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CRACK <Class 3>	77,916,042 (1/20/2010)	5/4/2010	3/1/2011
CRACKA <Class 25>	78,800,598 (1/26/2006)	4/10/2007	.
KRACKER <Class 41>	85,822,099 (1/14/2013)	6/11/2013	12/17/2013
CRACKER LIFE <Class 16>	85,517,045 (1/16/2012)	6/19/2012	9/4/2012
CRACKER LIFE <Class 25>	85,236,440 (2/8/2011)	6/14/2011	8/30/2011
CRAWCKERS <Class 30>	85,807,274 (12/20/2012)	5/7/2013	7/23/2013
CRAPP <Class 33>	77,713,885 (4/14/2009)	8/4/2009	.
CRAP <Class 9>	78,250,826 (5/16/2003)	2/10/2004	.
C.R.A.P. <Classes 36, 41>	86,688,324 (7/9/2015)	5/17/2016	9/27/2016
CRAP <Class 28>	85,689,315 (7/27/2012)	1/8/2013	3/26/2013
CRAP <Class 9>	77,816,249 (8/31/2009)	1/26/2010	4/13/2010
CRAQUE <Class 30>	86,392,848 (9/12/2014)	2/10/2015	4/28/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
CREAM PIE <Class 33>	85,370,835 (7/13/2011)	7/10/2012	1/8/2013
CULO <Class 24>	85,278,900 (3/28/2011)	9/6/2011	.
CULO <Class 16>	85,278,893 (3/28/2011)	9/16/2014	.
CULO <Class 25>	85,859,321 (2/25/2013)	6/14/2016	8/30/2016
CUMMING <Classes 35, 37>	77,009,830 (9/28/2006)	8/26/2008	7/21/2009
DP <Class 41>	77,358,073 (12/21/2007)	5/13/2008	7/29/2008
DP <Class 14>	77,823,283 (9/9/2009)	2/2/2010	4/20/2010
DAMN! <Class 25>	77,066,071 (12/18/2006)	7/10/2007	.
DAMN! <Class 25>	76,676,970 (5/16/2007)	9/23/2008	8/25/2009
DP <Class 33>	85,897,764 (4/8/2013)	8/27/2013	11/12/2013
DTF <Class 32>	85,938,946 (5/21/2013)	10/15/2013	.
DP <Class 18>	85,132,848 (9/18/2010)	3/8/2011	8/2/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DP <Class 1>	86,488,293 (12/22/2014)	6/9/2015	.
DP <Class 36>	77,479,628 (5/20/2008)	10/21/2008	1/6/2009
DP <Class 45>	77,808,603 (8/19/2009)	1/19/2010	.
DP <Class 9>	86,062,873 (9/12/2013)	4/22/2014	9/30/2014
DP <Class 41>	86,062,878 (9/12/2013)	4/22/2014	9/30/2014
DP <Class 25>	85,832,226 (1/25/2013)	6/11/2013	6/24/2014
DP <Class 28>	85,825,948 (1/17/2013)	6/11/2013	.
DP <Class 6>	86,416,318 (10/6/2014)	3/17/2015	.
DP <Class 25>	78,669,810 (7/13/2005)	3/28/2006	5/29/2007
DP <Class 38>	78,669,831 (7/13/2005)	3/28/2006	10/30/2007
DP <Class 38>	86,445,973 (11/5/2014)	12/30/2014	3/17/2015
DP <Class 9>	78,669,707 (7/13/2005)	3/28/2006	5/6/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DP <Class 28>	78,669,819 (7/13/2005)	10/10/2006	8/25/2009
DP <Class 41>	78,669,838 (7/13/2005)	3/28/2006	5/29/2007
DP <Class 16>	78,669,792 (7/13/2005)	3/28/2006	11/20/2007
DP <Class 18>	78,669,800 (7/13/2005)	5/22/2007	11/4/2008
DP <Classes 36, 37>	86,343,803 (7/21/2014)	12/9/2014	2/24/2015
DICK <Class 16>	86,259,681 (4/22/2014)	9/23/2014	12/9/2014
DICK <Class 25>	78,832,298 (3/8/2006)	11/14/2006	5/19/2009
DICK <Class 8>	79,022,510 (4/27/2005)	8/7/2007	10/23/2007
D I C K <Class 3>	78,860,488 (4/12/2006)	11/21/2006	.
DICK <Class 33>	85,635,032 (5/24/2012)	10/23/2012	.
DICKWEAR <Classes 18, 25>	78,475,683 (8/30/2004)	8/23/2005	.
DICK'S <Class 29>	86,343,301 (7/21/2014)	12/16/2014	3/3/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DIKS <Class 25>	78,509,844 (11/2/2004)	10/11/2005	.
DICK'S <Class 43>	86,343,046 (7/21/2014)	12/16/2014	3/3/2015
DICK'S <Class 35>	85,414,359 (9/2/2011)	2/28/2012	5/15/2012
DICKTIONARY <Class 28>	78,300,222 (9/15/2003)	5/11/2004	11/2/2004
DIKÉ <Class 25>	77,029,601 (10/26/2006)	6/19/2007	.
DP <Class 45>	77,550,165 (8/19/2008)	1/6/2009	.
DP <Class 17>	86,517,724 (1/29/2015)	6/16/2015	9/1/2015
DIRTY HOE <Class 33>	78,377,649 (3/3/2004)	9/13/2005	12/6/2005
DP <Class 16>	85,352,239 (6/21/2011)	11/8/2011	1/24/2012
DP <Class 35>	77,623,407 (11/30/2008)	9/22/2009	12/8/2009
DO ME <Class 10>	77,783,913 (7/17/2009)	12/15/2009	3/2/2010
DO.ME <Class 42>	77,492,190 (6/5/2008)	2/3/2009	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DO ME! <Class 21>	86,155,944 (1/2/2014)	5/13/2014	.
DP <Classes 30, 43>	85,526,804 (1/27/2012)	11/6/2012	1/22/2013
DP <Class 32>	78,855,002 (4/5/2006)	1/9/2007	4/22/2008
DP <Class 25>	85,826,606 (1/18/2013)	6/4/2013	4/8/2014
DP <Class 40>	86,200,747 (2/21/2014)	8/19/2014	11/4/2014
DOGGIE STYLE <Class 41>	78,459,917 (7/30/2004)	6/17/2014	.
DOGGIE STYLE <Class 32>	85,307,370 (4/28/2011)	9/13/2011	11/29/2011
DOGGIE STYLE <Classes 16, 35>	77,246,504 (8/3/2007)	1/22/2008	.
DOGGIE STYLE <Class 35>	77,806,220 (8/17/2009)	7/20/2010	11/29/2011
DOGGIE STYLE <Class 43>	78,407,627 (4/25/2004)	1/25/2005	11/29/2005
DOPE <Class 18>	77,862,126 (10/31/2009)	6/1/2010	.
DOPE <Class 14>	85,777,601 (11/13/2012)	2/26/2013	8/20/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DOPE <Class 34>	86,660,147 (6/11/2015)	1/31/2017	.
DOPE <Class 3>	85,846,893 (2/11/2013)	7/23/2013	.
DOPE <Class 25>	85,841,683 (2/5/2013)	7/2/2013	9/17/2013
DOPE <Class 35>	85,729,957 (9/15/2012)	2/19/2013	.
DOPE <Class 25>	85,375,315 (7/19/2011)	12/18/2012	6/10/2014
DOPE <Class 35>	86,083,846 (10/7/2013)	2/25/2014	5/13/2014
DOPE <Class 8>	86,686,117 (7/8/2015)	1/12/2016	3/29/2016
DOPE <Class 28>	85,763,811 (10/25/2012)	3/5/2013	5/21/2013
DOPE <Class 5>	85,107,525 (8/13/2010)	2/15/2011	.
DOPE <Classes 9, 25, 28, 35, 41>	85,926,376 (5/8/2013)	12/29/2015	.
DOPE <Class 25>	86,293,042 (5/28/2014)	10/21/2014	3/15/2016
DOPE <Class 34>	86,980,958 (6/11/2015)	1/31/2017	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DOPE <Class 34>	86,660,157 (6/11/2015)	1/31/2017	.
DOPE <Class 25>	85,773,190 (11/6/2012)	2/26/2013	12/3/2013
DOPE <Class 41>	85,846,862 (2/11/2013)	7/23/2013	10/8/2013
DP <Class 1>	77,364,537 (1/4/2008)	5/20/2008	8/5/2008
DP <Class 7>	85,956,334 (6/11/2013)	10/1/2013	12/17/2013
DP <Classes 9, 35, 38, 39, 42>	77,966,352 (3/23/2010)	2/8/2011	.
DP <Class 41>	76,484,581 (1/23/2003)	9/16/2003	12/9/2003
DP <Classes 2, 3>	77,233,254 (7/19/2007)	7/22/2008	.
DP <Class 35>	77,976,424 (12/20/2006)	12/25/2007	4/28/2009
PP PARKER POE <Class 45>	77,708,600 (4/7/2009)	8/4/2009	4/13/2010
DP <Class 7>	79,069,979 (3/5/2009)	9/15/2009	12/1/2009
DP <Class 0>	76,657,266 (3/22/2006)	6/26/2007	12/29/2009

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DP <Classes 9, 11>	79,152,520 (3/5/2014)	4/5/2016	6/21/2016
DP <Classes 16, 41, 45>	77,068,555 (12/20/2006)	12/25/2007	7/21/2009
DP <Class 9>	85,277,491 (3/25/2011)	11/1/2011	11/26/2013
DP <Class 29>	78,854,873 (4/5/2006)	11/14/2006	
DP <Class 11>	79,102,496 (8/26/2011)	5/8/2012	7/24/2012
DP <Class 25>	85,927,570 (5/9/2013)	4/8/2014	11/4/2014
PP <Class 10>	76,609,284 (8/30/2004)	9/18/2007	12/4/2007
DP <Classes 6, 9, 25, 28>	86,836,517 (12/2/2015)	5/30/2017	8/15/2017
<DP> <Class 9>	79,108,772 (1/3/2012)	3/19/2013	6/4/2013
DP <Class 25>	86,631,293 (5/15/2015)	8/18/2015	11/3/2015
DP <Class 2>	77,233,252 (7/19/2007)	7/22/2008	7/13/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DP <Class 25>	86,346,259 (7/23/2014)	12/2/2014	2/17/2015
DP <Classes 35, 40, 43>	78,854,897 (4/5/2006)	8/21/2007	.
DP <Classes 20, 24>	77,216,060 (6/26/2007)	9/16/2008	12/2/2008
DP <Class 9>	85,049,684 (5/27/2010)	10/26/2010	5/31/2011
DP <Class 5>	77,523,815 (7/16/2008)	5/19/2009	.
DP <Classes 9, 11>	77,424,527 (3/18/2008)	4/28/2009	.
DP <Class 5>	78,443,319 (6/29/2004)	11/1/2005	1/24/2006
DP <Classes 9, 11>	85,074,078 (6/29/2010)	11/30/2010	2/15/2011
DP <Class 20>	76,711,055 (3/26/2012)	8/14/2012	.
DP+ <Class 9>	85,168,832 (11/4/2010)	12/6/2011	9/25/2012
DP <Classes 8, 25>	85,363,433 (7/5/2011)	6/12/2012	8/28/2012
DP <Class 18>	78,626,336 (5/10/2005)	4/25/2006	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DP <Class 32>	78,854,953 (4/5/2006)	1/9/2007	4/22/2008
DP <Classes 1, 19>	79,024,196 (3/6/2006)	5/22/2007	8/7/2007
DP <Class 25>	85,750,806 (10/10/2012)	3/19/2013	6/4/2013
DTF <Class 0>	85,293,485 (4/12/2011)	7/5/2011	9/2/2014
DTF <Classes 12, 16, 17, 28>	86,009,765 (7/14/2013)	7/15/2014	.
DTF <Class 8>	77,222,281 (7/5/2007)	4/29/2008	.
DTF <Classes 6, 7, 8>	77,802,467 (8/12/2009)	6/1/2010	8/17/2010
DTF <Class 25>	85,056,754 (6/7/2010)	4/26/2011	.
DTF <Class 6>	77,202,312 (6/10/2007)	5/6/2008	.
DUMB ASS <Class 41>	85,466,394 (11/7/2011)	11/20/2012	.
DUMBASS <Classes 9, 28, 41>	77,758,157 (6/12/2009)	10/27/2009	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
DUMB ASS <Class 30>	85,103,820 (8/10/2010)	11/16/2010	2/1/2011
DUMBASS <Class 25>	78,874,761 (5/2/2006)	12/5/2006	10/23/2007
DUMBASS <Class 32>	77,756,279 (6/10/2009)	10/27/2009	.
DP <Class 5>	78,478,529 (9/3/2004)	8/23/2005	.
DP <Class 5>	78,976,670 (9/3/2004)	8/23/2005	4/18/2006
DP <Class 42>	78,478,535 (9/3/2004)	7/12/2005	.
DP <Class 17>	78,375,498 (2/27/2004)	11/1/2005	1/24/2006
EAT ME <Class 33>	85,522,147 (1/21/2012)	6/12/2012	.
EATME <Class 35>	85,743,052 (10/1/2012)	6/4/2013	8/19/2014
EAT ME! <Classes 25, 28>	76,514,544 (5/14/2003)	6/14/2005	.
EAT ME! <Classes 25, 29>	86,411,992 (10/1/2014)	3/17/2015	.
EAT ME! <Class 25>	85,141,044 (9/29/2010)	6/28/2011	9/13/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
EATME <Class 30>	85,334,122 (5/31/2011)	6/12/2012	8/28/2012
EAT ME! <Class 35>	85,338,987 (6/6/2011)	3/20/2012	6/5/2012
EAT ME <Class 25>	78,352,142 (1/14/2004)	5/16/2006	8/8/2006
EAT.ME <Class 42>	77,492,159 (6/5/2008)	1/13/2009	.
EAT ME <Classes 30, 35, 43>	86,856,753 (12/22/2015)	5/31/2016	8/16/2016
EAT ME! <Class 21>	85,141,034 (9/29/2010)	6/28/2011	9/13/2011
EAT ME! <Class 30>	85,141,087 (9/29/2010)	3/15/2011	5/31/2011
EFFING <Class 33>	77,490,182 (6/3/2008)	8/19/2008	.
EFFING <Class 25>	85,122,954 (9/3/2010)	2/14/2012	5/1/2012
EFF <Class 36>	77,620,650 (11/24/2008)	9/22/2009	12/8/2009
EFF <Class 35>	86,713,369 (8/3/2015)	2/16/2016	5/3/2016
ERECTION <Class 32>	77,007,890 (9/26/2006)	9/18/2007	10/28/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
ERECTUS <Classes 9, 14, 16, 25, 28, 38, 41, 42>	79,181,752 (11/10/2014)	7/4/2017	9/19/2017
F* <Class 35>	85,132,852 (9/18/2010)	2/1/2011	.
F-BOMB <Class 3>	86,122,070 (11/18/2013)	3/18/2014	.
F-BOMB <Class 9>	86,191,010 (2/11/2014)	6/17/2014	.
F-IT <Classes 25, 35>	79,130,169 (2/27/2013)	10/1/2013	12/17/2013
F K <Class 43>	86,515,910 (1/27/2015)	6/9/2015	8/25/2015
F-OFF! <Class 5>	78,297,653 (9/9/2003)	6/8/2004	.
F/U <Class 9>	86,266,549 (4/29/2014)	9/23/2014	.
F/U <Classes 9, 16, 25, 28, 41>	86,266,119 (4/29/2014)	9/23/2014	.
FA <Class 10>	79,030,106 (5/15/2006)	1/1/2008	3/18/2008
FA <Class 42>	86,249,672 (4/11/2014)	8/26/2014	3/24/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FA <Class 35>	85,970,204 (6/26/2013)	11/19/2013	6/17/2014
FA <Classes 16, 28, 35, 40, 41, 42>	79,097,702 (2/23/2011)	2/26/2013	5/14/2013
FA <Class 25>	78,306,525 (9/29/2003)	6/15/2004	.
FA <Class 25>	78,784,184 (1/3/2006)	4/24/2007	7/10/2007
FA <Classes 7, 9, 11>	79,055,885 (4/18/2008)	4/14/2009	6/30/2009
FA <Class 2>	77,736,095 (5/13/2009)	5/4/2010	.
FA <Class 35>	77,377,984 (1/22/2008)	6/3/2008	8/19/2008
FA <Class 6>	79,132,363 (5/29/2013)	3/18/2014	6/3/2014
FAÈ <Class 33>	77,093,194 (1/29/2007)	7/17/2007	10/2/2007
FK <Classes 12, 25>	85,514,888 (1/12/2012)	11/27/2012	2/12/2013
FK <Class 25>	86,189,858 (2/11/2014)	4/21/2015	7/7/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FAG <Classes 4, 7, 9, 12>	79,054,548 (7/25/2007)	10/27/2009	1/12/2010
FAG <Classes 7, 9, 12>	85,039,919 (5/17/2010)	12/13/2011	2/28/2012
PHAG <Class 25>	77,022,538 (10/17/2006)	6/3/2008	5/1/2012
FAG <Classes 4, 6, 7, 8, 9, 12, 17>	79,049,409 (5/30/2007)	6/9/2009	8/25/2009
FAIREEZ <Classes 9, 14, 16, 24, 25, 28, 41>	79,020,269 (5/2/2005)	8/1/2006	10/17/2006
FAIRY <Class 33>	77,183,926 (5/17/2007)	3/11/2008	9/30/2008
FAIRY <Class 10>	85,680,959 (7/18/2012)	12/25/2012	3/12/2013
FAK <Class 14>	85,322,250 (5/16/2011)	10/4/2011	8/21/2012
FAK <Class 7>	77,829,394 (9/18/2009)	2/23/2010	.
FK <Classes 3, 30, 33>	86,674,707 (6/25/2015)	12/22/2015	.
F.A.P. <Class 12>	85,607,284 (4/25/2012)	1/22/2013	4/9/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
F K <Class 44>	85,832,586 (1/25/2013)	6/18/2013	9/3/2013
FAT COQ <Class 33>	85,039,560 (5/15/2010)	10/19/2010	3/13/2012
FCUK <Class 18>	86,518,528 (1/29/2015)	12/8/2015	10/3/2017
FCUK <Classes 14, 28, 35>	78,239,593 (4/18/2003)	3/21/2006	6/13/2006
FYM <Class 41>	85,627,522 (5/16/2012)	10/16/2012	1/1/2013
FA <Class 42>	78,946,779 (8/7/2006)	3/20/2007	6/5/2007
FING <Class 25>	85,736,863 (9/24/2012)	7/2/2013	.
FING <Class 25>	77,673,462 (2/19/2009)	6/16/2009	.
FING <Class 25>	77,674,315 (2/19/2009)	6/16/2009	.
FA <Class 25>	77,494,994 (6/10/2008)	10/14/2008	.
FA <Class 37>	86,404,327 (9/24/2014)	2/17/2015	5/5/2015
FA <Classes 9, 15>	76,580,736 (3/12/2004)	3/1/2005	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
F-IT <Class 38>	78,663,973 (7/5/2005)	6/12/2007	8/28/2007
FK <Classes 9, 18>	86,287,082 (5/20/2014)	11/10/2015	.
FK <Class 25>	85,197,804 (12/14/2010)	3/8/2011	.
FK <Class 7>	76,672,245 (2/5/2007)	8/7/2007	10/23/2007
FK <Class 25>	85,687,857 (7/26/2012)	1/1/2013	3/19/2013
FK <Class 40>	77,309,147 (10/19/2007)	4/1/2008	.
FK <Class 7>	79,010,120 (10/26/2004)	4/25/2006	7/18/2006
FK <Class 25>	78,659,300 (6/27/2005)	6/27/2006	9/19/2006
FK <Class 11>	78,204,228 (1/16/2003)	5/4/2004	5/29/2007
FKD <Classes 18, 25, 28>	77,750,467 (6/2/2009)	12/8/2009	6/22/2010
FKD <Classes 18, 25, 28>	77,744,582 (5/26/2009)	11/10/2009	6/1/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FKS <Classes 14, 40, 42>	79,099,173 (3/9/2011)	4/3/2012	6/19/2012
FA-Q <Class 34>	86,548,888 (2/27/2015)	7/28/2015	10/13/2015
FK <Class 28>	86,708,753 (7/29/2015)	2/9/2016	4/26/2016
FAP <Class 35>	78,767,952 (12/6/2005)	2/27/2007	5/15/2007
FOCKER <Class 25>	77,584,755 (10/3/2008)	3/3/2009	.
FA <Class 9>	78,458,267 (7/28/2004)	6/28/2005	9/20/2005
FOOK <Class 45>	77,689,173 (3/12/2009)	5/4/2010	7/20/2010
FOOK <Classes 25, 35>	85,855,783 (2/21/2013)	7/16/2013	5/27/2014
FK <Class 25>	86,654,406 (6/8/2015)	11/10/2015	.
FORK YOU <Class 43>	85,699,701 (8/9/2012)	1/15/2013	.
FORK YOU! <Class 21>	86,123,291 (11/19/2013)	6/24/2014	9/9/2014
FK <Classes 18, 26>	78,951,982 (8/15/2006)	7/24/2007	10/9/2007

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FK <Class 25>	85,468,265 (11/9/2011)	10/23/2012	9/24/2013
FK <Class 7>	79,069,040 (3/23/2009)	2/23/2010	5/11/2010
FK <Classes 14, 16, 21>	85,979,873 (12/14/2012)	5/20/2014	8/5/2014
FU <Class 45>	86,689,300 (7/10/2015)	11/24/2015	.
FU <Class 25>	77,755,775 (6/9/2009)	2/26/2013	8/20/2013
F.U. <Class 33>	77,559,376 (8/29/2008)	1/20/2009	12/29/2009
FU <Class 41>	85,669,124 (7/5/2012)	6/18/2013	.
FUG <Class 25>	86,154,971 (12/31/2013)	11/18/2014	2/3/2015
FUG <Class 40>	86,368,070 (8/15/2014)	1/13/2015	3/31/2015
FUKU <Class 43>	86,754,659 (9/11/2015)	1/19/2016	4/5/2016
FUKU <Classes 6, 16, 21, 24, 25, 29, 30>	86,722,589 (8/12/2015)	6/28/2016	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
FUKU <Class 43>	86,561,752 (3/12/2015)	10/20/2015	1/5/2016
FUKU <Classes 9, 35>	86,566,398 (3/17/2015)	10/20/2015	.
FUKU <Class 43>	86,561,757 (3/12/2015)	10/20/2015	1/5/2016
FA <Class 35>	86,536,164 (2/16/2015)	6/23/2015	9/8/2015
FUT <Class 25>	85,095,832 (7/29/2010)	3/15/2011	.
GAY.COM <Classes 38, 41, 42, 45>	77,565,137 (9/8/2008)	10/5/2010	1/24/2012
GAY.COM <Classes 38, 41, 42, 45>	77,565,110 (9/8/2008)	10/19/2010	2/21/2012
GAY <Class 33>	85,792,086 (11/30/2012)	12/10/2013	2/25/2014
GET BLOWN <Class 35>	78,403,459 (4/16/2004)	2/1/2005	.
GET BLOWN! <Class 34>	76,660,179 (5/17/2006)	12/26/2006	.
GET OFF <Class 42>	78,207,990 (1/28/2003)	9/9/2003	4/24/2007

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
GET OFF <Class 2>	76,589,891 (5/3/2004)	3/15/2005	6/7/2005
GLORYHOLE <Class 41>	77,389,462 (2/5/2008)	6/10/2008	8/26/2008
GOOCH <Class 25>	78,311,828 (10/9/2003)	5/25/2004	.
GOOCH <Class 25>	78,221,612 (3/4/2003)	4/13/2004	.
GOOCH <Classes 18, 25>	85,645,159 (6/6/2012)	10/9/2012	8/20/2013
GREATHEAD <Class 32>	85,530,445 (1/31/2012)	6/26/2012	.
HAD <Class 14>	85,370,424 (7/13/2011)	12/6/2011	.
HAD <Class 20>	85,340,519 (6/7/2011)	7/10/2012	9/25/2012
HANDJOB <Class 28>	77,180,373 (5/14/2007)	11/6/2007	.
HARD-ON <Class 5>	77,297,066 (10/5/2007)	4/15/2008	9/9/2008
HARD-ON <Class 3>	78,972,653 (9/12/2006)	4/24/2007	.
HARD-ON <Class 3>	77,497,456 (6/12/2008)	11/4/2008	1/20/2009

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
HEAD <Class 3>	78,587,989 (3/15/2005)	7/4/2006	9/26/2006
HEAD <Class 43>	77,185,990 (5/21/2007)	11/6/2007	.
HEAD <Classes 9, 25, 28>	85,956,064 (6/11/2013)	10/29/2013	9/9/2014
HEAD <Classes 3, 4, 5, 35>	77,356,897 (12/20/2007)	6/30/2009	.
HEAD <Class 3>	79,073,551 (9/7/2009)	2/23/2010	5/11/2010
HEAD <Class 3>	79,000,605 (12/15/2003)	1/25/2005	4/19/2005
HEAD <Classes 9, 12, 14, 18, 25, 28>	77,759,877 (6/15/2009)	7/6/2010	9/21/2010
HEAD <Class 3>	76,675,295 (4/10/2007)	11/13/2007	1/29/2008
HEAD <Class 25>	86,451,153 (11/11/2014)	5/19/2015	3/22/2016
HEEB <Class 41>	78,250,619 (5/15/2003)	12/23/2003	6/29/2004
HEY DICK <Classes 9, 25>	85,832,228 (1/25/2013)	6/18/2013	9/3/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
HO <Class 25>	79,036,500 (10/2/2006)	3/18/2008	6/3/2008
HOMO <Class 25>	86,758,765 (9/16/2015)	3/8/2016	11/22/2016
HOTBOXX <Class 9>	77,813,956 (8/27/2009)	1/19/2010	9/7/2010
HOT BOX <Class 34>	86,263,851 (4/26/2014)	10/14/2014	.
HOT BOX <Class 30>	85,291,763 (4/11/2011)	8/23/2011	11/8/2011
HOT BOX <Class 28>	78,378,019 (3/3/2004)	12/7/2004	11/15/2005
HOTBOX <Class 11>	76,494,725 (2/24/2003)	12/2/2003	.
HOTBOXX <Class 6>	78,530,537 (12/10/2004)	12/20/2005	.
HOTBOX <Class 11>	86,568,047 (3/18/2015)	2/16/2016	5/3/2016
HOTBOX <Classes 38, 41, 42>	85,454,447 (10/24/2011)	2/28/2012	5/15/2012
HOT BOX <Class 32>	86,717,076 (8/6/2015)	11/17/2015	2/2/2016
HOT BOX <Classes 9, 28>	77,359,661 (12/26/2007)	6/8/2010	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
HOT BOX <Class 9>	78,639,603 (5/30/2005)	10/10/2006	.
HOTBOX <Class 41>	85,730,625 (9/17/2012)	2/19/2013	5/7/2013
HOT BOX <Class 33>	85,514,766 (1/12/2012)	5/29/2012	.
HOT BOX <Class 21>	86,307,420 (6/12/2014)	6/2/2015	.
! HOTBOX ! <Class 7>	86,286,911 (5/20/2014)	10/28/2014	1/13/2015
HOUSE OF DAVID <Class 45>	77,472,261 (5/12/2008)	10/14/2008	12/30/2008
HO <Class 16>	78,350,982 (1/13/2004)	11/23/2004	2/15/2005
HTFU <Class 25>	77,321,100 (11/5/2007)	4/15/2008	.
HUMP <Classes 37, 38, 42, 45>	86,274,913 (5/7/2014)	1/20/2015	.
HUNG <Class 41>	78,897,457 (5/31/2006)	1/9/2007	3/27/2007
HUNG <Class 21>	77,599,097 (10/23/2008)	3/3/2009	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
HUNG <Class 37>	86,596,039 (4/13/2015)	10/13/2015	12/29/2015
HUNG <Class 41>	77,594,801 (10/17/2008)	9/8/2009	3/30/2010
HUNG <Class 16>	77,594,807 (10/17/2008)	9/8/2009	.
HUNGO <Class 9>	86,701,993 (7/23/2015)	12/15/2015	3/1/2016
HUNG <Class 18>	77,599,060 (10/23/2008)	9/8/2009	.
HUNG <Class 9>	77,594,804 (10/17/2008)	3/3/2009	1/31/2012
HUNG LIKE A M.U.L.E <Class 25>	86,384,689 (9/3/2014)	1/27/2015	8/18/2015
HUSBAND * BEATER <Class 25>	78,353,517 (1/18/2004)	12/6/2005	2/28/2006
HUYA <Classes 8, 9>	77,071,589 (12/27/2006)	6/10/2008	12/2/2008
ICE LABS <Class 30>	77,037,384 (11/6/2006)	6/5/2007	.
JAP <Class 24>	86,840,326 (12/5/2015)	10/3/2017	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
JIZZ <Class 3>	85,225,675 (1/25/2011)	5/31/2011	.
JIZZ <Class 25>	79,102,880 (8/17/2011)	10/14/2014	12/30/2014
JOHNSON <Class 25>	78,840,466 (3/17/2006)	4/22/2008	10/14/2008
JOHNSON <Classes 8, 9>	85,593,619 (4/10/2012)	4/2/2013	6/18/2013
JJ <Class 17>	78,607,316 (4/12/2005)	9/19/2006	12/5/2006
JOHNSON <Class 9>	78,665,257 (7/7/2005)	7/18/2006	10/10/2006
JOHNSON <Class 15>	77,020,204 (10/12/2006)	10/30/2007	1/15/2008
JOHNSON <Classes 8, 9>	85,588,686 (4/4/2012)	4/2/2013	6/18/2013
KARMIC B.S. <Class 20>	85,070,267 (6/23/2010)	11/16/2010	.
LICK ME <Class 3>	77,299,891 (10/9/2007)	8/19/2008	.
LIQ ME <Class 30>	85,397,138 (8/12/2011)	1/17/2012	.
LIQUID CHRONIC <Class 9>	85,387,860 (8/3/2011)	8/14/2012	1/29/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
LIQUID CHRONIK <Class 33>	77,609,487 (11/7/2008)	11/20/2012	8/27/2013
LIQUID CHRONIC <Class 9>	77,168,307 (4/28/2007)	9/18/2007	.
LOVEBUTTER <Class 28>	85,064,154 (6/16/2010)	5/10/2011	.
LOVE BUTTER <Class 3>	77,082,693 (1/14/2007)	8/7/2007	10/23/2007
MF <Classes 11, 34>	85,300,496 (4/20/2011)	2/28/2012	5/15/2012
MF <Class 9>	85,377,843 (7/21/2011)	12/20/2011	10/16/2012
MF <Class 42>	85,377,836 (7/21/2011)	12/20/2011	10/16/2012
MF <Class 41>	85,377,839 (7/21/2011)	12/20/2011	10/16/2012
MAN WHORE <Class 25>	77,441,291 (4/7/2008)	9/22/2009	.
MANDINGO <Class 34>	78,220,051 (2/28/2003)	5/25/2004	8/17/2004
MANDINGO <Class 10>	85,101,345 (8/5/2010)	1/18/2011	4/5/2011

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
MANDINGO <Class 33>	85,247,291 (2/21/2011)	6/28/2011	9/13/2011
MF <Class 14>	77,618,195 (11/20/2008)	3/31/2009	6/16/2009
MARIA JUANA <Class 25>	77,490,509 (6/4/2008)	11/11/2008	1/27/2009
MARIJUANA <Class 25>	86,613,546 (4/29/2015)	4/12/2016	.
MF <Class 35>	77,102,392 (2/8/2007)	8/7/2007	10/23/2007
MASTERBAIT <Classes 25, 28>	77,713,220 (4/14/2009)	1/5/2010	3/23/2010
MASTER-BAITS <Class 28>	78,521,085 (11/22/2004)	9/27/2005	.
MF <Class 41>	77,554,558 (8/25/2008)	1/13/2009	3/31/2009
MDMA <Classes 18, 24, 26>	79,181,771 (7/27/2015)	11/15/2016	1/31/2017
MDMA <Classes 9, 38, 42>	78,212,997 (2/10/2003)	4/5/2005	6/28/2005
MDMA <Class 41>	86,351,406 (7/29/2014)	1/13/2015	3/31/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
M.D.M.A. <Class 25>	85,748,833 (10/9/2012)	3/19/2013	6/4/2013
ME VALE MADRE <Class 25>	77,700,746 (3/27/2009)	1/12/2010	3/30/2010
ME@T <Class 43>	77,665,452 (2/6/2009)	6/2/2009	.
MEAT WALLET <Classes 25, 41>	85,453,754 (10/21/2011)	6/5/2012	.
MF <Classes 6, 20>	86,285,153 (5/19/2014)	2/3/2015	7/11/2017
METH <Class 1>	79,021,033 (11/26/2005)	8/1/2006	10/17/2006
MF <Class 37>	78,631,255 (5/17/2005)	1/31/2006	2/13/2007
MF <Class 24>	76,598,511 (6/18/2004)	10/18/2005	1/10/2006
MF <Class 3>	77,261,780 (8/22/2007)	3/11/2008	2/17/2009
MF <Class 33>	85,266,640 (3/14/2011)	7/26/2011	1/10/2012
M.F. <Class 1>	79,174,113 (6/24/2015)	4/19/2016	7/5/2016
MF <Class 7>	86,405,378 (9/24/2014)	2/24/2015	11/10/2015

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
MF <Class 7>	78,770,602 (12/9/2005)	12/1/2009	2/16/2010
MF <Classes 6, 7, 40>	79,111,091 (12/7/2011)	12/11/2012	2/26/2013
MF <Class 34>	86,242,283 (4/4/2014)	8/19/2014	11/4/2014
MF <Class 3>	85,719,756 (9/4/2012)	2/5/2013	.
MF <Class 25>	86,401,476 (9/22/2014)	2/3/2015	.
MF <Class 30>	85,367,938 (7/11/2011)	1/8/2013	10/29/2013
MF <Classes 6, 7, 40>	79,111,094 (12/7/2011)	1/1/2013	3/19/2013
MF <Classes 16, 35, 38, 41>	78,847,824 (3/28/2006)	4/17/2007	9/23/2008
MF <Class 24>	79,128,495 (3/20/2013)	10/15/2013	12/31/2013
MF <Class 14>	78,622,925 (5/4/2005)	1/31/2006	4/25/2006
MF <Class 9>	85,316,230 (5/9/2011)	9/27/2011	12/13/2011
MF <Class 43>	86,134,042 (12/3/2013)	3/29/2016	1/17/2017

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
MF <Class 25>	85,336,759 (6/2/2011)	10/18/2011	1/3/2012
MIKE HOCK <Class 25>	86,371,057 (8/19/2014)	1/13/2015	10/27/2015
MIKE HOCK <Class 25>	78,689,689 (8/10/2005)	4/18/2006	9/16/2008
MILF GOLF <Class 25>	85,916,193 (4/26/2013)	12/3/2013	5/20/2014
MILK OF THE POPPY <Class 21>	85,200,475 (12/17/2010)	4/26/2011	9/24/2013
MILK OF THE POPPY <Class 25>	85,200,595 (12/17/2010)	4/26/2011	8/27/2013
MF <Class 31>	79,145,005 (1/27/2014)	1/20/2015	4/7/2015
MOFO <Class 28>	77,185,795 (5/21/2007)	11/20/2007	2/5/2008
MOFO <Class 41>	78,307,167 (9/30/2003)	11/9/2004	2/1/2005
MOFO <Class 41>	77,404,085 (2/22/2008)	1/12/2010	6/4/2013
MOFO <Class 12>	86,111,237 (11/6/2013)	3/11/2014	

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
MOFO <Class 33>	85,917,204 (4/29/2013)	11/5/2013	.
MOFOS <Classes 38, 41, 42>	85,392,457 (8/8/2011)	9/4/2012	11/20/2012
MOFOS.COM <Classes 38, 41, 42>	85,392,712 (8/8/2011)	9/4/2012	11/20/2012
MOLLY <Class 35>	77,584,029 (10/2/2008)	2/17/2009	5/5/2009
MOLLY <Class 7>	85,084,747 (7/14/2010)	10/12/2010	6/21/2011
MOLIE <Class 14>	86,733,545 (8/21/2015)	8/30/2016	11/15/2016
MOLLY <Class 38>	78,871,549 (4/27/2006)	9/19/2006	.
MOLLY <Class 5>	85,838,057 (1/31/2013)	2/17/2015	5/5/2015
MOLLY <Classes 30, 34>	86,237,505 (3/31/2014)	7/29/2014	.
MOLLY <Class 10>	85,113,183 (8/23/2010)	4/2/2013	9/10/2013
MOLLY <Class 35>	85,605,204 (4/23/2012)	3/5/2013	5/21/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
MF <Classes 7, 9>	79,144,044 (9/20/2013)	5/19/2015	8/4/2015
MONEY SHOT <Class 5>	78,953,082 (8/16/2006)	4/10/2007	6/26/2007
MONEY-SHOT <Class 32>	77,045,678 (11/16/2006)	7/3/2007	3/11/2008
MONEY SHOT <Class 41>	85,397,157 (8/12/2011)	11/1/2011	.
MF <Class 14>	77,602,447 (10/28/2008)	9/29/2009	.
MORPHINE <Class 25>	77,300,248 (10/10/2007)	3/25/2008	6/10/2008
MORPHINE <Class 3>	85,508,672 (1/4/2012)	5/29/2012	9/24/2013
ANNULLO TUI EFFIGIES <Class 25>	78,832,483 (3/8/2006)	10/17/2006	.
MF <Class 9>	85,136,400 (9/23/2010)	12/14/2010	3/1/2011
MUFF <Class 14>	85,048,326 (5/26/2010)	4/19/2011	2/21/2012
MF <Class 25>	76,509,883 (4/28/2003)	5/18/2004	7/26/2005
MF <Class 41>	85,583,764 (3/29/2012)	8/13/2013	10/29/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
NIG <Class 25>	85,939,012 (5/22/2013)	11/12/2013	1/28/2014
NOOKIE <Class 25>	85,762,826 (10/24/2012)	7/2/2013	9/17/2013
NOOKIE <Class 33>	85,792,318 (12/1/2012)	4/30/2013	.
NUGGETS <Class 25>	78,247,841 (5/9/2003)	12/13/2005	.
NUGGETS <Class 41>	77,781,752 (7/15/2009)	5/25/2010	8/10/2010
NUGGITZ <Class 35>	85,515,692 (1/13/2012)	5/15/2012	7/31/2012
NUT SAC <Class 29>	77,663,650 (2/4/2009)	4/6/2010	.
NUTSAC <Class 18>	77,668,333 (2/11/2009)	7/7/2009	9/22/2009
NUTSACK <Class 28>	78,419,717 (5/17/2004)	4/5/2005	.
KNUTTSAK <Class 25>	78,357,883 (1/27/2004)	11/9/2004	8/1/2006
NUTSACK <Class 3>	76,696,479 (3/24/2009)	7/21/2009	7/6/2010
N.U.T.S. <Class 16>	78,774,276 (12/15/2005)	8/8/2006	6/2/2009

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
N.U.T.S <Class 41>	77,037,949 (11/6/2006)	6/5/2007	8/21/2007
NUTZZ <Classes 25, 28, 35, 41>	78,377,092 (3/2/2004)	4/18/2006	
NUTS <Class 3>	78,741,646 (10/27/2005)	6/27/2006	5/22/2007
NUTS <Class 35>	85,018,513 (4/20/2010)	9/21/2010	12/7/2010
NUTS <Class 16>	78,278,861 (7/25/2003)	5/4/2004	4/4/2006
NUTS <Classes 8, 21>	79,148,132 (4/25/2014)	10/31/2017	1/16/2018
NUTS! <Class 9>	85,355,948 (6/24/2011)	12/6/2011	2/21/2012
NUTZ <Class 34>	86,451,391 (11/11/2014)	4/28/2015	7/14/2015
NUT'Z <Class 9>	79,097,031 (2/4/2011)	7/19/2011	10/4/2011
OINK! <Class 28>	85,725,399 (9/10/2012)	5/28/2013	4/8/2014
OINK.COM <Class 35>	85,137,460 (9/24/2010)	3/8/2011	5/24/2011
OINC <Class 41>	77,628,680 (12/8/2008)	2/2/2010	11/30/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
OINK <Classes 36, 42>	86,134,798 (12/4/2013)	4/15/2014	10/28/2014
OINK.COM <Class 35>	85,143,000 (10/1/2010)	3/8/2011	.
OINK <Classes 9, 35>	85,319,478 (5/12/2011)	10/11/2011	.
OINK <Class 42>	85,319,476 (5/12/2011)	10/11/2011	.
OINK.COM <Class 35>	85,142,994 (10/1/2010)	3/15/2011	.
OINK <Class 10>	78,422,012 (5/20/2004)	2/22/2005	3/28/2006
OINK <Classes 36, 42>	86,264,462 (4/28/2014)	7/15/2014	1/6/2015
OINK.COM <Class 35>	85,143,011 (10/1/2010)	3/8/2011	.
OINK! <Class 25>	78,459,962 (7/30/2004)	6/27/2006	9/19/2006
OINK <Classes 36, 42>	86,136,046 (12/5/2013)	4/15/2014	.
OMFG <Class 25>	77,607,951 (11/5/2008)	4/21/2009	2/9/2010
DP <Class 36>	85,508,563 (1/4/2012)	11/6/2012	1/22/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PANAMA RED <Class 30>	78,828,914 (3/3/2006)	10/10/2006	1/30/2007
PANAMA RED <Class 43>	78,829,136 (3/3/2006)	10/10/2006	9/18/2007
PEARL <Class 11>	77,585,174 (10/3/2008)	3/3/2009	.
PEARL <Class 1>	77,056,681 (12/4/2006)	8/4/2009	.
PEARL <Class 36>	76,713,490 (2/19/2013)	1/7/2014	4/14/2015
PEARL <Class 21>	86,059,120 (9/9/2013)	3/18/2014	6/3/2014
PEARL <Class 5>	77,738,363 (5/15/2009)	11/23/2010	4/22/2014
PEARL <Class 9>	86,023,971 (7/30/2013)	12/24/2013	3/11/2014
PERL <Class 9>	76,629,502 (1/27/2005)	9/19/2006	12/5/2006
PEARL <Class 9>	86,609,232 (4/24/2015)	8/2/2016	10/18/2016
PEARL <Classes 16, 41>	79,090,090 (6/30/2010)	7/30/2013	10/15/2013
PEARL <Class 31>	78,460,208 (8/2/2004)	10/11/2005	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Class 33>	85,562,392 (3/7/2012)	9/10/2013	11/26/2013
PEARL <Class 9>	77,268,724 (8/30/2007)	7/8/2008	12/9/2008
PEARL <Class 11>	77,794,596 (7/31/2009)	12/29/2009	7/20/2010
PEARL <Class 6>	79,124,069 (10/5/2012)	8/13/2013	10/29/2013
PEARL <Class 9>	78,896,066 (5/30/2006)	12/12/2006	10/16/2007
PEARL <Classes 11, 40>	77,666,230 (2/9/2009)	5/18/2010	10/19/2010
PEARL <Class 21>	78,411,799 (5/1/2004)	10/4/2005	12/27/2005
PEARL <Class 12>	86,980,681 (7/2/2015)	11/17/2015	12/6/2016
PEARL <Class 9>	79,116,517 (3/13/2012)	5/14/2013	7/30/2013
PEARL <Class 5>	77,738,367 (5/15/2009)	11/23/2010	4/22/2014
PEARL <Classes 35, 39>	79,097,571 (6/28/2010)	11/1/2011	1/17/2012
PEARL <Class 9>	86,982,089 (7/2/2015)	1/17/2017	5/16/2017

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Classes 25, 28>	78,717,985 (9/21/2005)	6/6/2006	.
PEARL <Class 28>	76,634,318 (3/25/2005)	12/13/2005	3/7/2006
PEARL <Class 35>	86,681,867 (7/2/2015)	11/17/2015	.
PEARL <Class 30>	77,937,998 (2/17/2010)	9/27/2011	.
PEARL <Class 42>	85,265,339 (3/12/2011)	8/16/2011	2/7/2012
PEARL <Class 35>	78,269,552 (7/2/2003)	8/3/2004	10/26/2004
PEARL <Class 9>	85,849,601 (2/14/2013)	7/9/2013	4/29/2014
PEARL <Classes 16, 41>	76,589,259 (4/29/2004)	4/19/2005	.
PEARL <Class 37>	86,681,873 (7/2/2015)	11/24/2015	.
PEARL <Classes 7, 9>	85,344,072 (6/12/2011)	5/8/2012	12/4/2012
PEARL <Class 10>	76,596,658 (6/7/2004)	10/11/2005	4/8/2008
PEARL <Class 9>	85,886,263 (3/26/2013)	2/11/2014	11/25/2014

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Class 43>	77,252,919 (8/10/2007)	2/12/2008	4/29/2008
PEARL <Class 39>	86,681,879 (7/2/2015)	11/24/2015	.
PEARL <Class 16>	86,467,547 (12/1/2014)	5/12/2015	.
PURL <Classes 9, 35>	78,957,989 (8/22/2006)	4/29/2008	9/29/2009
PEARL <Class 11>	85,048,943 (5/27/2010)	11/30/2010	2/15/2011
PEARL <Class 10>	77,132,134 (3/15/2007)	4/15/2008	.
PEARL <Class 45>	86,681,887 (7/2/2015)	11/24/2015	.
PEARL <Class 8>	85,734,818 (9/21/2012)	2/26/2013	2/11/2014
PEARL <Class 9>	86,681,861 (7/2/2015)	1/17/2017	.
PEARL <Class 10>	77,715,710 (4/16/2009)	2/16/2010	.
PEARL <Class 19>	78,591,198 (3/21/2005)	12/6/2005	2/28/2006
PEARL <Class 35>	77,615,016 (11/14/2008)	3/31/2009	3/30/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Class 31>	77,240,281 (7/27/2007)	1/29/2008	.
PEARL <Class 42>	86,681,886 (7/2/2015)	11/24/2015	.
PEARL <Classes 9, 42, 45>	85,422,980 (9/14/2011)	3/19/2013	7/8/2014
PEARL <Class 25>	79,150,341 (1/31/2014)	9/30/2014	12/16/2014
PEARL <Class 35>	78,268,316 (6/28/2003)	1/20/2004	4/13/2004
PEARL <Class 32>	77,723,495 (4/27/2009)	7/7/2009	12/22/2009
PEARL <Class 18>	85,028,275 (5/2/2010)	4/12/2011	.
PEARL <Class 1>	78,910,267 (6/16/2006)	7/17/2007	4/15/2008
PEARL <Class 10>	85,576,342 (3/21/2012)	8/28/2012	11/13/2012
PEARL <Classes 2, 16>	86,403,502 (9/23/2014)	11/1/2016	1/17/2017
PEARL <Class 7>	85,482,812 (11/29/2011)	6/12/2012	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PIRL <Classes 38, 42, 44>	77,621,636 (11/25/2008)	6/23/2009	4/6/2010
PEARL <Class 30>	86,401,494 (9/22/2014)	2/24/2015	5/12/2015
PEARL <Classes 9, 35>	86,611,401 (4/27/2015)	9/15/2015	.
PEARL <Class 33>	78,845,424 (3/24/2006)	2/13/2007	7/10/2007
PEARL <Class 5>	78,906,596 (6/13/2006)	7/17/2007	6/3/2008
PEARL <Classes 6, 19>	86,416,500 (10/7/2014)	3/10/2015	7/12/2016
PEARL <Class 5>	85,885,588 (3/25/2013)	8/13/2013	10/29/2013
PEARL <Class 9>	77,904,899 (1/5/2010)	5/18/2010	10/5/2010
PEARL <Class 42>	86,981,205 (7/2/2015)	11/24/2015	5/16/2017
PEARL <Class 41>	86,681,882 (7/2/2015)	11/24/2015	.
PEARL <Class 36>	76,699,574 (9/22/2009)	3/9/2010	5/25/2010
PEARL <Class 9>	77,815,721 (8/28/2009)	1/26/2010	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Classes 35, 37, 39, 40, 42, 45>	77,310,501 (10/22/2007)	4/1/2008	6/17/2008
PEARL <Class 9>	78,493,624 (10/3/2004)	8/23/2005	11/15/2005
PEARL <Class 10>	85,952,131 (6/6/2013)	12/31/2013	.
PEARL <Class 12>	86,681,866 (7/2/2015)	11/17/2015	.
PEARL <Class 20>	85,634,714 (5/24/2012)	4/30/2013	7/16/2013
PEARL <Class 37>	76,713,489 (2/19/2013)	1/7/2014	10/20/2015
PEARL <Class 10>	77,486,730 (5/29/2008)	8/12/2008	11/29/2011
PEARL.COM <Class 35>	85,596,105 (4/12/2012)	5/7/2013	4/8/2014
PURRRL <Class 8>	85,089,487 (7/21/2010)	12/28/2010	3/15/2011
PEARL <Class 7>	86,775,195 (10/1/2015)	3/8/2016	.
PEARL <Classes 35, 37, 39, 40, 42, 45>	77,310,507 (10/22/2007)	4/1/2008	6/17/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
PEARL <Class 11>	77,912,189 (1/14/2010)	8/17/2010	3/8/2011
PEARL <Class 36>	76,699,573 (9/22/2009)	3/9/2010	5/25/2010
PEARL NECKLACE <Class 32>	86,062,856 (9/12/2013)	2/24/2015	.
PECKERS <Class 6>	77,918,388 (1/22/2010)	6/8/2010	11/2/2010
PECKERS <Class 41>	77,182,251 (5/16/2007)	12/11/2007	.
PECKERS <Class 43>	77,403,731 (2/22/2008)	7/8/2008	.
PHUC <Class 25>	85,418,294 (9/8/2011)	3/20/2012	6/18/2013
PHUKIT <Class 25>	78,257,504 (6/3/2003)	12/28/2004	3/22/2005
PIE <Class 42>	86,229,409 (3/23/2014)	11/11/2014	1/27/2015
PIE <Class 9>	78,716,088 (9/19/2005)	1/12/2010	6/14/2011
PI <Class 41>	77,321,460 (11/5/2007)	7/8/2008	9/23/2008
PIE <Class 35>	76,614,590 (10/5/2004)	11/6/2007	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
P.I.E. <Class 35>	78,800,878 (1/27/2006)	9/19/2006	12/4/2007
PIE <Class 9>	85,439,233 (10/4/2011)	3/13/2012	.
PIE <Class 35>	78,577,149 (3/1/2005)	5/2/2006	7/25/2006
PIE <Classes 9, 43>	86,019,996 (7/25/2013)	5/6/2014	.
PIE <Class 41>	77,007,544 (9/26/2006)	6/17/2008	9/2/2008
PI=E <Classes 36, 41>	78,828,294 (3/3/2006)	4/3/2007	8/3/2010
PIE <Class 35>	77,171,066 (5/2/2007)	7/15/2008	9/30/2008
PYE <Class 9>	79,016,504 (7/26/2005)	5/1/2007	7/17/2007
PIE <Class 35>	86,227,702 (3/20/2014)	9/23/2014	12/9/2014
PINCHE <Class 25>	77,289,894 (9/26/2007)	2/26/2008	.
POKE <Classes 9, 38, 42, 45>	85,981,897 (12/21/2012)	5/7/2013	8/5/2014

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
POKE <Classes 35, 38, 42, 45>	78,920,328 (6/29/2006)	3/25/2008	.
POKE <Class 12>	85,014,483 (4/15/2010)	3/15/2011	11/6/2012
POKE <Class 38>	85,809,236 (12/21/2012)	5/7/2013	.
POKEHER <Class 25>	85,219,680 (1/18/2011)	5/31/2011	.
POON <Class 14>	86,443,589 (11/4/2014)	4/7/2015	6/23/2015
POON <Class 25>	77,151,170 (4/6/2007)	10/9/2007	12/25/2007
POON <Class 41>	77,081,161 (1/11/2007)	10/9/2007	12/25/2007
POOP <Class 25>	77,759,659 (6/15/2009)	10/27/2009	.
POOP <Class 34>	77,168,347 (4/28/2007)	12/4/2007	.
POOP <Class 16>	78,492,778 (10/1/2004)	9/13/2005	.
POOP! <Class 28>	86,050,014 (8/28/2013)	11/5/2013	.
POP SHOTS <Class 33>	85,541,875 (2/14/2012)	9/18/2012	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
POP SHOTZ <Class 28>	77,515,989 (7/7/2008)	12/2/2008	2/17/2009
POPSHOTS <Class 30>	78,413,644 (5/5/2004)	4/26/2005	.
POPSHOTS <Class 33>	85,612,706 (4/30/2012)	9/18/2012	.
PRICH <Classes 18, 25>	77,516,144 (7/7/2008)	12/2/2008	10/27/2009
PIE <Classes 35, 41>	86,627,587 (5/13/2015)	10/27/2015	1/12/2016
PULL-OUT <Class 25>	78,676,863 (7/23/2005)	4/11/2006	.
PUNANI <Class 25>	77,396,582 (2/14/2008)	1/6/2009	9/15/2009
PUSS <Class 25>	78,741,135 (10/26/2005)	6/27/2006	7/17/2007
PUSSY <Class 34>	86,758,246 (9/16/2015)	1/26/2016	.
PUSSY <Class 3>	85,262,140 (3/9/2011)	1/17/2012	4/3/2012
RACK <Class 25>	77,263,730 (8/24/2007)	2/17/2009	.
RACK <Class 41>	76,516,281 (5/22/2003)	1/20/2004	1/25/2005

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
RACK <Class 33>	85,463,590 (11/3/2011)	4/17/2012	.
WRACK <Class 9>	76,707,294 (4/18/2011)	9/6/2011	10/30/2012
RAK <Classes 1, 5>	77,186,360 (5/21/2007)	8/7/2007	.
RACK <Class 35>	77,942,725 (2/23/2010)	8/10/2010	10/26/2010
RAC <Class 42>	77,282,599 (9/18/2007)	3/11/2008	11/18/2008
RAC <Class 9>	77,537,110 (8/1/2008)	12/23/2008	.
RETARD <Class 1>	77,185,702 (5/21/2007)	10/23/2007	1/8/2008
RIDEHARD.COM <Class 45>	85,906,303 (4/17/2013)	4/15/2014	.
RIDE HARD <Class 9>	78,584,542 (3/10/2005)	11/8/2005	1/31/2006
RIDE HARD <Classes 16, 25>	78,559,467 (2/3/2005)	12/20/2005	7/11/2006
RIDE HARD <Class 14>	78,561,401 (2/5/2005)	11/1/2005	.
ROADHEAD <Class 28>	85,759,575 (10/22/2012)	4/2/2013	6/18/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
ROD <Classes 25, 45>	86,668,054 (6/19/2015)	11/10/2015	5/2/2017
ROD <Class 9>	77,954,644 (3/9/2010)	7/27/2010	10/12/2010
ROD'S <Class 30>	77,755,059 (6/9/2009)	3/9/2010	2/15/2011
ROD'S <Class 32>	86,726,980 (8/17/2015)	1/12/2016	5/2/2017
SAC <Class 9>	76,498,516 (3/18/2003)	11/18/2003	2/10/2004
SAKK <Class 27>	85,178,079 (11/16/2010)	4/26/2011	7/12/2011
SAC <Class 20>	78,491,844 (9/29/2004)	9/20/2005	12/13/2005
SAC <Class 41>	77,636,716 (12/19/2008)	4/7/2009	.
SAC <Class 25>	78,786,771 (1/6/2006)	4/10/2007	.
SACK <Class 45>	86,491,912 (12/29/2014)	5/26/2015	10/13/2015
SKRU <Class 25>	78,861,474 (4/13/2006)	11/28/2006	2/13/2007
SCREW <Class 33>	76,598 834 (6/23/2004)	7/25/2006	3/27/2007

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SCREW <Class 28>	77,784,088 (7/17/2009)	7/2/2013	.
SCREW <Class 16>	78,812,505 (2/10/2006)	7/31/2007	10/16/2007
SCRŪ <Class 28>	78,405,391 (4/21/2004)	2/8/2005	.
SCREW U <Class 41>	77,247,278 (8/4/2007)	2/12/2008	.
SCREW U <Class 8>	76,697,933 (6/16/2009)	1/19/2010	.
SCREW U. <Class 41>	78,264,856 (6/19/2003)	5/11/2004	.
SEX.LOL <Class 35>	86,629,038 (5/14/2015)	10/6/2015	.
SEX <Class 34>	76,512,616 (4/21/2003)	4/13/2004	7/6/2004
$€X <Class 36>	77,816,340 (8/31/2009)	2/2/2010	11/23/2010
S-EX <Class 3>	85,728,643 (9/13/2012)	2/19/2013	5/7/2013
SEXXX <Classes 32, 33>	77,516,519 (7/8/2008)	9/22/2009	.
SHIZNIT <Class 8>	86,525,149 (2/5/2015)	6/23/2015	4/26/2016

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SHOOT <Classes 25, 28>	78,896,654 (5/31/2006)	6/17/2008	9/2/2008
SHOOT <Classes 38, 41, 42, 44>	79,038,454 (11/14/2006)	5/13/2008	7/29/2008
SHOOT <Class 9>	79,184,395 (12/10/2015)	9/20/2016	2/27/2018
SHOOT! <Class 30>	77,292,920 (10/1/2007)	1/8/2008	.
SHOOT <Class 42>	86,283,613 (5/16/2014)	10/21/2014	7/18/2017
SHOVEABITCH.COM <Class 25>	77,104,125 (2/9/2007)	8/7/2007	.
SHOVEABITCH.COM <Class 41>	77,104,184 (2/9/2007)	8/7/2007	.
SHT <Classes 9, 20>	86,359,800 (8/7/2014)	9/29/2015	12/15/2015
SHT <Class 9>	79,116,574 (3/21/2012)	4/30/2013	7/16/2013
SHT <Class 9>	78,598,132 (3/30/2005)	12/27/2005	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
69 <Classes 6, 9, 12, 14, 16, 21, 24, 25, 26>	79,182,666 (10/30/2015)	5/3/2016	7/19/2016
SKEET <Class 11>	86,288,685 (5/22/2014)	10/14/2014	6/2/2015
SLOPPY SECONDS <Class 30>	86,295,160 (5/29/2014)	10/21/2014	.
SL, UT <Class 25>	85,103,853 (8/10/2010)	9/6/2011	11/22/2011
SL, UT <Classes 16, 21>	85,516,498 (1/13/2012)	8/21/2012	11/6/2012
S.L.U.T.S. <Class 16>	78,774,261 (12/15/2005)	8/29/2006	9/18/2007
SLUTS <Class 9>	85,653,958 (6/17/2012)	11/13/2012	1/29/2013
S.L.U.T.S. <Class 25>	77,209,355 (6/19/2007)	10/28/2008	1/13/2009
SNATCH <Class 41>	78,696,232 (8/19/2005)	5/9/2006	11/7/2006
SNATCH <Classes 9, 35, 42, 45>	86,206,331 (2/27/2014)	11/11/2014	.
SNACHE <Class 28>	85,360,840 (6/30/2011)	6/12/2012	8/28/2012

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SNATCH MAGNET <Class 41>	77,215,194 (6/26/2007)	12/4/2007	.
SHT <Class 33>	86,110,120 (11/5/2013)	4/1/2014	.
SOFA KING <Class 30>	86,826,008 (11/19/2015)	5/10/2016	7/26/2016
SPUNK <Class 45>	86,245,358 (4/8/2014)	8/26/2014	5/3/2016
SPUNK <Classes 25, 41>	77,723,181 (4/27/2009)	9/29/2009	4/6/2010
SPUNK <Class 5>	85,118,979 (8/30/2010)	2/15/2011	.
SPUNK <Class 5>	78,861,311 (4/13/2006)	6/12/2007	.
SPUNK <Class 1>	76,712,611 (10/11/2012)	3/26/2013	6/11/2013
SQURT! <Class 28>	85,695,123 (8/3/2012)	7/23/2013	5/20/2014
SQUIRT <Class 32>	78,354,144 (1/20/2004)	10/19/2004	1/11/2005
SQUIRT <Class 21>	76,576,624 (2/20/2004)	9/5/2006	.
SQUIRT <Class 4>	77,238,585 (7/25/2007)	7/1/2008	9/16/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SQUIRT <Classes 9, 42>	77,188,003 (5/23/2007)	10/9/2007	8/5/2008
SQUIRT <Class 32>	85,479,130 (11/22/2011)	5/8/2012	9/18/2012
SQUIRT <Class 5>	77,734,599 (5/12/2009)	4/20/2010	7/6/2010
SQUIRT <Class 30>	85,590,532 (4/5/2012)	11/6/2012	.
SQUIRT <Class 21>	76,603,613 (7/23/2004)	9/20/2005	12/13/2005
SQUIRT <Class 8>	85,277,061 (3/25/2011)	7/5/2011	9/20/2011
SQUIRT <Class 7>	78,486,110 (9/20/2004)	12/13/2005	.
SQUIRT <Class 30>	78,252,881 (5/21/2003)	10/18/2005	1/10/2006
SQUIRT <Classes 24, 28>	77,178,092 (5/10/2007)	2/26/2008	7/7/2009
SQUIRT <Class 25>	78,674,209 (7/20/2005)	4/11/2006	7/4/2006
STFU!!! <Class 33>	85,418,950 (9/9/2011)	1/17/2012	.
STFU <Class 13>	86,740,351 (8/28/2015)	1/19/2016	4/5/2016

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
STFU <Class 25>	85,226,902 (1/26/2011)	5/31/2011	.
STFU <Class 25>	77,794,617 (7/31/2009)	1/12/2010	.
STIFFY <Class 7>	76,688,811 (4/21/2008)	4/7/2009	6/23/2009
STIFFY <Class 5>	85,004,565 (4/1/2010)	8/24/2010	11/9/2010
STIFFY <Class 28>	85,473,834 (11/16/2011)	5/1/2012	2/5/2013
STIFFY <Class 9>	78,825,102 (2/28/2006)	6/12/2007	8/28/2007
STIFFY <Class 6>	78,296,231 (9/4/2003)	6/15/2004	6/7/2005
STIFFY <Class 8>	85,714,065 (8/27/2012)	2/19/2013	5/7/2013
STIFFY <Class 28>	85,443,682 (10/10/2011)	3/20/2012	12/11/2012
STIFFY <Class 28>	85,711,494 (8/23/2012)	2/18/2014	5/6/2014
STIFFY <Class 16>	77,218,039 (6/28/2007)	5/11/2010	9/11/2012
STIFFY <Class 8>	85,714,016 (8/27/2012)	2/19/2013	5/7/2013

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
STUFT <Class 16>	86,614,771 (4/29/2015)	9/15/2015	12/1/2015
STUFFED <Classes 35, 43>	85,540,872 (2/13/2012)	1/15/2013	4/2/2013
STUFT <Class 20>	85,735,699 (9/21/2012)	2/5/2013	4/23/2013
STUNT COCK <Class 25>	78,415,488 (5/8/2004)	7/5/2005	.
SUK <Class 10>	77,396,132 (2/13/2008)	7/29/2008	12/23/2008
SUCKIT. <Class 16>	77,296,697 (10/4/2007)	3/18/2008	3/23/2010
SUCK IT <Class 37>	77,163,940 (4/24/2007)	12/18/2007	.
SUCK IT <Class 33>	77,404,550 (2/23/2008)	9/9/2008	11/25/2008
SUX <Class 30>	78,674,371 (7/20/2005)	3/28/2006	.
SUX <Class 5>	78,674,413 (7/20/2005)	3/28/2006	.
SUXX <Class 33>	77,558,099 (8/28/2008)	8/18/2009	11/3/2009
SUPERWANG <Class 5>	85,962,120 (6/17/2013)	5/13/2014	7/29/2014

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
SWAMP ASS <Class 3>	86,657,500 (6/10/2015)	4/26/2016	.
SUYT <Class 25>	78,648,385 (6/10/2005)	2/21/2006	5/16/2006
TIT <Classes 11, 37>	85,497,106 (12/16/2011)	12/22/2015	10/11/2016
TERRIFIC TETAS <Class 25>	77,056,178 (12/4/2006)	6/26/2007	5/13/2008
THC <Class 5>	78,765,088 (12/1/2005)	8/8/2006	.
THC <Class 25>	86,562,672 (3/12/2015)	7/28/2015	11/29/2016
T.H.C. <Class 28>	86,464,911 (11/25/2014)	5/5/2015	7/21/2015
THC <Class 7>	79,018,422 (9/22/2005)	12/26/2006	7/13/2010
THE D <Class 30>	86,028,193 (8/4/2013)	12/31/2013	12/2/2014
THE D <Class 41>	85,634,349 (5/24/2012)	2/26/2013	5/14/2013
THE D <Class 41>	86,367,614 (8/15/2014)	3/24/2015	.
THE D <Classes 25, 28>	85,470,611 (11/11/2011)	5/15/2012	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
THE D <Classes 41, 43>	85,981,038 (11/11/2011)	5/15/2012	4/1/2014
THE D <Class 25>	85,654,302 (6/18/2012)	1/22/2013	4/9/2013
THE FLUFFER <Class 32>	86,766,202 (9/23/2015)	2/16/2016	5/3/2016
THC <Class 41>	86,526,331 (2/5/2015)	7/7/2015	9/22/2015
THE PECKERS <Class 41>	85,074,046 (6/29/2010)	11/23/2010	2/8/2011
THE SHIZNIT <Class 1>	77,954,655 (3/9/2010)	7/13/2010	.
THE SHOCKER <Class 25>	76,687,341 (3/4/2008)	6/10/2008	.
THE SHOCKER <Class 34>	86,451,373 (11/11/2014)	4/28/2015	7/14/2015
TIT <Class 25>	77,577,465 (9/24/2008)	2/17/2009	.
TITMOUSE <Class 41>	77,382,138 (1/28/2008)	6/10/2008	8/26/2008
TITZLING <Class 25>	85,496,065 (12/15/2011)	5/22/2012	9/30/2014
TITZLINGER <Class 25>	85,496,079 (12/15/2011)	5/22/2012	8/26/2014

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
TOTTIE <Class 25>	78,786,351 (1/6/2006)	3/13/2007	.
UCK <Class 25>	77,887,866 (12/7/2009)	4/27/2010	9/21/2010
UP AND COMING <Classes 14, 25>	77,557,115 (8/27/2008)	1/13/2009	6/8/2010
U.P. YOURS <Class 32>	86,580,969 (3/30/2015)	8/18/2015	11/3/2015
UP YOURS <Class 41>	85,424,057 (9/15/2011)	2/21/2012	5/8/2012
UP YOURS <Class 35>	86,158,873 (1/7/2014)	5/20/2014	.
UPYOURS <Class 38>	85,298,597 (4/19/2011)	9/20/2011	12/6/2011
VAGINA <Class 15>	85,726,658 (9/12/2012)	3/5/2013	5/21/2013
VELLHUNGWOOD CELLARS <Class 33>	78,665,764 (7/7/2005)	5/2/2006	.
WANG <Class 10>	76,549,614 (10/3/2003)	8/2/2005	10/25/2005
WEED <Classes 3, 28>	78,774,251 (12/15/2005)	2/5/2008	.

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
W.E.E.D. <Class 41>	85,218,400 (1/14/2011)	5/31/2011	.
WEED <Class 35>	78,272,765 (7/10/2003)	9/21/2004	12/14/2004
WEED <Class 16>	86,773,909 (9/30/2015)	10/4/2016	.
W.E.E.D. <Class 25>	85,688,696 (7/27/2012)	1/1/2013	10/20/2015
WEED <Class 34>	86,001,903 (7/3/2013)	10/28/2014	3/29/2016
WEED <Class 32>	77,519,631 (7/10/2008)	12/2/2008	.
WEED <Class 3>	86,607,024 (4/23/2015)	9/27/2016	.
WEED <Class 21>	86,588,785 (4/6/2015)	3/22/2016	4/25/2017
WETBOX <Class 34>	85,033,738 (5/9/2010)	3/22/2011	6/7/2011
WHORE <Class 3>	78,299,386 (9/11/2003)	6/8/2004	5/31/2005
WIENER <Class 7>	79,010,249 (2/24/2005)	6/13/2006	9/5/2006
WILLY <Classes 16, 41>	77,330,960 (11/15/2007)	4/22/2008	11/11/2008

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
WILLY <Class 31>	85,236,663 (2/8/2011)	7/12/2011	9/27/2011
WILLY <Class 37>	78,728,932 (10/7/2005)	6/20/2006	6/22/2010
WILLY <Class 3>	86,274,282 (5/7/2014)	1/6/2015	5/24/2016
WILLY <Class 32>	86,112,339 (11/6/2013)	4/15/2014	7/1/2014
WILLY <Class 30>	86,818,853 (11/12/2015)	8/2/2016	
WILSON <Class 8>	78,402,918 (4/16/2004)	8/9/2005	11/1/2005
WILSON <Classes 9, 18, 24, 25, 28>	77,168,844 (4/30/2007)	10/7/2008	12/23/2008
WILSON <Class 9>	86,415,613 (10/6/2014)	1/20/2015	4/7/2015
WILLSON <Class 9>	78,402,457 (4/15/2004)	6/14/2005	6/6/2006
WILSON <Classes 9, 16, 41>	77,167,686 (4/27/2007)	3/18/2008	6/3/2008
WILSON <Classes 9, 16, 28, 41, 45>	79,049,008 (10/24/2007)	7/6/2010	9/21/2010

Applied-For Word Mark <Int'l Class>	Applied-For Word Mark Serial No. (Application Date)	Publication Date	Registration Date
W JEANS <Class 25>	78,566,187 (2/12/2005)	11/8/2005	.
WILSON <Class 2>	78,418,878 (5/14/2004)	5/31/2005	8/23/2005
WOODY <Classes 14, 18>	85,247,124 (2/20/2011)	8/9/2011	10/25/2011
WOODY <Class 28>	76,581,549 (3/15/2004)	8/9/2005	11/1/2005
WOODY <Class 25>	86,272,718 (5/6/2014)	7/21/2015	10/6/2015
WOODY <Class 12>	76,495,726 (3/3/2003)	11/18/2003	2/10/2004
W DY <Classes 9, 16, 35, 41>	77,502,181 (6/18/2008)	11/11/2008	.
WOODY <Class 8>	77,219,517 (6/29/2007)	9/22/2009	12/8/2009
WOODY <Class 28>	77,161,903 (4/20/2007)	4/29/2008	7/15/2008
WOODEE <Class 28>	78,910,509 (6/16/2006)	11/13/2007	4/7/2009
WOODY <Class 21>	85,741,506 (9/28/2012)	3/5/2013	5/21/2013
WOODI <Class 21>	86,020,169 (7/25/2013)	10/29/2013	1/14/2014

Appendix 8
Trademark Applications Consisting of Variations on FUCK CANCER Filed From 2003 Through 2015 That Received a § 1052(a) Immoral-or-Scandalous Refusal

Variation Receiving § 1052(a) Refusal <Int'l Class>	**Serial No. (Application Date)**	**Publication Date**	**Registration Date**
FUCANCER <25>	76,615,171 (10/7/2004)	.	.
F CK CANCER F C <25>	77,437,332 (4/1/2008)	.	.
F CANCER <25>	77,562,888 (9/4/2008)	.	.
FCK CANCER <25>	77,728,361 (5/4/2009)	.	.
F CK CANCER <14,25>	77,805,554 (8/16/2009)	.	.
FUCK CANCER <25,40>	77,835,941 (9/27/2009)	.	.
F CK CANCER <25>	77,851,260 (10/18/2009)	.	.
F CANCER IN THE "A" <14,25>	77,916,465 (1/21/2010)	.	.

Variation Receiving § 1052(a) Refusal <Int'l Class>	Serial No. (Application Date)	Publication Date	Registration Date
F CANCER <25>	77,954,532 (3/9/2010)	5/31/2011	.
F CANCER <25>	77,983,618 (3/9/2010)	5/31/2011	6/10/2014
FCK CANCER FC <25>	78,959,914 (8/24/2006)	.	.
F K CANCER <25>	85,220,344 (1/18/2011)	.	.
FUCK CANCER <16>	85,237,359 (2/8/2011)	.	.
FUCK CANCER <14>	85,786,337 (11/24/2012)	.	.
P.H.U.C. CANCER (PLEASE HELP US CURE CANCER) <25>	85,855,531 (2/20/2013)	.	.
F K CANCER <25>	86,016,028 (7/22/2013)	.	.
FUCANCER <25>	86,038,364 (8/14/2013)	.	.

Variation Receiving § 1052(a) Refusal <Int'l Class>	Serial No. (Application Date)	Publication Date	Registration Date
FUKC CANCER <21,25>	86,181,814 (2/1/2014)	.	.
FUCK CANCER <25>	86,286,757 (5/20/2014)	.	.
F CK CANCER <42>	86,288,375 (5/21/2014)	.	.
FUCK CANCER <25>	86,290,011 (5/23/2014)	.	.
FU CANCER <14,25,35>	86,852,304 (12/17/2015)	.	.

No. 18-302

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
PETITIONER,

V.

ERIK BRUNETTI
RESPONDENT.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR THE CATO INSTITUTE, DKT LIBERTY PROJECT, AMERICANS FOR PROSPERITY, P.J. O'ROURKE, AND NADINE STROSSEN AS *AMICI CURIAE* SUPPORTING RESPONDENT

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QUESTION PRESENTED

Does the government get to decide what language is "scandalous"?

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INTEREST OF *AMICI CURIAE*[1]

The **Cato Institute** is a nonpartisan think tank dedicated to individual liberty, free markets, and limited government. Its Robert A. Levy Center for Constitutional Studies promotes the principles of constitutionalism that are the foundation of liberty. To those ends, Cato conducts conferences and publishes books, studies, and the annual *Cato Supreme Court Review*.

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Americans for Prosperity recruits, educates, and mobilizes citizens to build a culture of mutual benefit where people succeed by helping others improve their lives. AFP advocates policies that promote that culture, including free speech, criminal justice reform, and limited government. Vague laws governing expression are particularly antithetical to a culture of mutual benefit because they restrict expression while undermining the rule of law and expanding government power over the lives of private citizens.

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[1] Rule 37 statement: Both parties were notified of and consented to the filing of this brief. No party's counsel authored any of this brief; *amici* alone funded its preparation and submission.

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Nadine Strossen holds the John Marshall Harlan II Chair at New York Law School, was president of the ACLU from 1991 through 2008, and continues to serve on the ACLU's National Advisory Council. She also holds leadership positions in other organizations that focus on free speech issues, including the Foundation for Individual Rights in Education (FIRE). Strossen's writings defending the freedom for offensive expression include *Defending Pornography: Free Speech, Sex, and the Fight for Women's Rights* (1995) and *Speaking of Race, Speaking of Sex: Hate Speech, Civil Rights, and Civil Liberties* (1994). Her latest book is *HATE: Why We Should Resist It with Free Speech, Not Censorship* (2018). Her ideas on these topics have many times been deemed sufficiently scandalous to trigger boycotts, dis-invitations, and picketing, as well as death threats. To cite one memorable example, on April 12, 2005, while attempting to speak at an event honoring Justice Scalia, she was shouted down by protestors who were offended by some of his opinions and

her participation in the event.[2] Ironically, some of these protesters engaged in offensive expression themselves, without Justice Scalia or anyone else trying to suppress it. Strossen is proud to occupy a chair named after the justice who authored *Cohen v. California*, which upheld the right to engage in offensive and even vulgar expression, recognizing that this is "powerful medicine in a society as diverse . . . as ours" but explaining that "no other approach would comport with the premise of individual dignity and choice upon which our political system rests."

Amici are committed to preserving free expression and pushing people out of their comfort zones. We all say things that some people find scandalous—but it's not the government's role to make that judgment. *Amici* have previously filed briefs in this Court in many other First Amendment cases dealing with the freedom of speech, including *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015); and *Susan B. Anthony List v. Driehaus*, 134 S. Ct. 2334 (2014).

INTRODUCTION AND SUMMARY OF ARGUMENT

Here we go again. Just two years ago, the Court unanimously told the Patent and Trademark Office (PTO) that it can't punish trademarks just because some people find them "disparaging." *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017). Not having learned its lesson, the PTO now insists it can punish trademarks just because some people find them "scandalous."

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[2] *See, e.g.*, Petrox, *Scalia at NYU Law: When Libs and Free Speech Implode*, DailyKos, Apr. 12, 2005, https://bit.ly/2OlyeNg.

The PTO denied federal trademark registration for a clothing brand called "fuct," because that name sounds like a naughty word. *See* Pet. App. 1a. That verbal association ran afoul of a Lanham Act provision that bars federal registration for any mark that "[c]onsists of or comprises immoral . . . or scandalous matter." 15 U.S.C. § 1052(a). In practice, the provision is used to deny registration to marks that PTO examiners consider to be "vulgar." *See* Pet. App. 3a.

Denying federal trademark registration has real negative consequences. "Federal registration . . . confers important legal rights and benefits on trademark owners who register their marks." *Tam*, 137 S. Ct. at 1753 (cleaned up, but not in the sense of removing "bad" words). By the government's own admission, denying registration to "scandalous" marks "creates a practical disincentive to their use by rendering certain government benefits unavailable." Pet. Br. 33.

But the government argues that this disincentive should not be treated as a ban. Pet. Br. 40–41. This should come as some surprise to this Court, given that the Disparagement Clause, which provided exactly the same disincentive, was struck down for "offend[ing] a bedrock First Amendment principle: Speech may not be *banned* on the ground that it expresses ideas that offend." *Tam*, 137 S. Ct. at 1751 (emphasis added).

The Scandalous Marks Clause violates the First Amendment in the same way that the Disparagement Clause did. As the Court explained in *Tam*, "powerful messages can sometimes be conveyed in just a few words." *Id.* at 1760. By denying trademarks to words deemed "scandalous," the government is dictating permissible and impermissible vocabulary. And when our

freedom to articulate our ideas is curtailed, our freedom to express those ideas is also curtailed:

> Just as a healthy brain needs both its 'higher' and 'lower' parts, cerebral cortex and limbic systems, a healthy society needs its 'good' language and its 'bad.' We need irreproachably formal and unassailably decent speech, but we also need the dirty, the vulgar, the wonderful obscenities and oaths that can do for us what no other words can.

Melissa Mohr, *Holy Sh*t: A Brief History of Swearing* 15 (2013).

None of the supposed interests raised by the government can justify this abridgment of vocabulary. This case is not about where "vulgar" words will or won't appear in public places like billboards or broadcasts. A trademark does not grant universal advertising rights that supersede local sign codes or FCC regulations. The debate over the extent to which a government can limit words appearing in view of children can be left for a later day (and such regulations are likely better handled at the community level anyway).

Instead, this case is about whether brands can be punished *nationwide*, regardless of where they advertise and whom they choose to target for business, just because the government finds their name distasteful. Moral panic over "vulgar" language is nothing new. "In the Middle Ages, blasphemous oaths were used so frequently that authorities worried they might injure God himself, and religious writers pleaded, then threatened, in order to get people to stop swearing." *Id.* at 15. But its lengthy historical pedigree does not make the goal any more legitimate.

In 1971, attorney Mel Nimmer argued before this Court in defense of the right to wear a jacket reading "Fuck the draft." While preparing for his appearance, Nimmer "was convinced that he had to use that word, and not some euphemism, in his oral argument to make his point that its use could not be banned from all public discussion." William S. Cohen, *Looking Back at* Cohen v. California, 34 U.C.L.A. L. Rev. 1595, 1599 (1987). Lo and behold, Nimmer got away with saying the forbidden word in his very first answer, and the foundations of the building did not crack.

This brief is submitted in the spirit of Nimmer, and with the same intent. Although the words we use are unusual for a Supreme Court brief, here they are necessary. Just because a brand like Fuct might not fit the PTO dress code doesn't mean it has no place in American culture. The PTO's efforts to discourage profanity in American life are profoundly misguided.

> When used judiciously, swearing can be hilarious, poignant, and uncannily descriptive. . . . It engages the full expanse of the brain: left and right, high and low, ancient and modern. Shakespeare, no stranger to earthy imprecations himself, had Caliban speak for the entire human race when he said, "You taught me language, and my profit on't is, I know how to curse."

Steven Pinker, *The Stuff of Thought: Language as a Window into Human Nature* 372 (2007).

For these reasons, and those explained by the respondents, the Court should affirm the Federal Circuit, striking down the "scandalous marks" provision.

ARGUMENT

I. "VULGAR" LANGUAGE PLAYS AN IMPORTANT ROLE IN SOCIETY

A. Vulgar Language Is Necessary for Full and Authentic Expression

"In 1973, Yugoslav philologist Olga Penavin predicted that swearing would simply go extinct with the spread of socialism. In a socialist utopia, there would be no conflict, and thus no need for swearwords, she reasoned." Mohr, *supra*, at 254. Sadly for Dr. Penavin, however, the oft-predicted triumph of socialism is still running behind schedule. Society remains firmly fixed in the real world, a world in which conflict, passion, and high emotions are an inherent part of life. And so long as such a world exists, it will remain impossible to fully convey the full range of our thoughts and feelings without a vocabulary that includes swearing.

The government argues that eliminating "vulgar" words from speakers' vocabularies does nothing to hamper their ability to express any and all ideas. In that telling, "scandalous marks are ineligible for registration not because they are thought to convey offensive *ideas*, but because such marks reflect an offensive *mode* of expressing *whatever* idea the speaker wishes to convey." Pet. Br. 20. (cleaned up, so to speak).

This is akin to arguing that the government could ban most words of Latinate origin (such as *encounter*, *putrefy*, and *educate*) without any harm to expression, since those words each have Germanic equivalents (such as *meet*, *rot*, and *teach*). Such a ban would *obviously* hinder expression. As any author knows—and even many lawyers sense—expressing an idea well requires finding just the right word, and writing with a

truncated vocabulary is like conducting an orchestra with one hand tied behind your back.

The nomenclature that the PTO considers scandalous is no different. As Steven Pinker points out, a sentence like, "Will you pick up your dog's shit, and stop him from pissing on my roses!" would not mean the same thing if the profanity were replaced by politesse. In a sanitized version of the same sentence, "the emotional force of the speaker's reaction is no longer being conveyed." Pinker, *supra*, at 352. A rose by another name may smell as sweet—and dog "poop" still doesn't—but without the same visceral effect.

Artists and authors know the power of profanity. Take just one example. In a climactic scene of the film adaptation of Isaac Bashevis Singer's *Enemies: A Love Story*, a wife confronts the husband who betrayed her after she had hidden him from the Nazis:

> Fighting back tears of rage, she looks him in the eye and says slowly, "I saved your life. I took the last bite of food out of my mouth and gave it to you in the hayloft. I carried out your *shit*!" No other word could convey the depth of her fury at his ingratitude.

Pinker, *supra*, at 371.

The PTO's misguided belief that strong language can be replaced by euphemisms with no harm to expression is nothing new. In 1818, Englishman Thomas Bowdler took it upon himself to "improve" the language of Shakespeare by removing all the fun parts. As Bowdler explained in his preface, "[m]any words and expressions occur which are of so indecent a nature as to render it highly desirable that they should be erased . . . neither the vicious tastes of the age, nor

the most brilliant effusions of wit, can afford an excuse for profaneness or obscenity." Thomas Bowdler, *The Family Shakespeare* vii (1863). In 1833, American Noah Webster did the same to the Holy Bible, inserting "euphemisms, words and phrases which are not very offensive to delicacy." *See* Mohr, *supra*, at 195.

If this type of "cleaning up"[3] truly has no effect on the expression of ideas, then we should expect classic works to come out the other side of a Bowdlerist scrubbing none the worse for wear. But of course, any comparison shows that is not the case. Bowdlerization frequently dulls and waters down otherwise vivid language, making passages less poetic—and less faithful to the ideas the author wanted to convey. *Compare* 1 Kings 14:10 King James Version ("Therefore, behold, I will bring evil upon the house of Jeroboam, and will cut off from Jeroboam him that pisseth against the wall") *with* 1 Kings 14:10 New American Standard Bible ("therefore behold, I am bringing calamity on the house of Jeroboam, and will cut off from Jeroboam every male person") (discussed in Mohr, *supra*, at 81–82); *compare* "Out, damned spot!" *with* "Out, crimson spot!", Ross E. Davies, *How Not to Bowdlerize*, The Green Bag Almanac and Reader 235 (2009); *compare* "the bawdy hand of the dial is now upon the prick of noon" *with* "the hand of the dial is now upon the point of noon," Bowdler, *supra*, at 827. And inevitably, even those projects that begin by insisting they will target only offensive *words* will soon find that there are some *ideas* that cannot be expressed in an inoffensive way. Is there any polite way to say that a woman committed suicide? Of course not, so Bowdler's Ophelia drowns in

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[3] Not to be confused with "(cleaned up)." *See* Metzler, *Cleaning Up Quotations*, 18 J. of App. Practice & Process 143 (2017).

an unfortunate accident. *See* Simon Thomas, *What Did Bowdler Bowdlerize*, OxfordWord Blog (July 11, 2016), https://bit.ly/2JAqh84.

Besides being necessary for expressing emotional heights, scandalous words are indispensable when authors capture how real people converse. Writers often employ vulgar language to achieve a verisimilitude that would otherwise be impossible. When James Joyce first published *Ulysses* in 1922, the book came under fire for its frequent use of profanity. But in an opinion upholding the artistic merit of the book and allowing it to be published in this country, Judge John Woolsey explained, "The words which are criticized as dirty are old saxon words, known to almost all men and, I venture, to many women, and are such words as would be naturally and habitually used, I believe, by the types of folk whose life, physical and mental, Joyce is seeking to describe." *U.S. v. One Book Called "Ulysses"*, 5 F. Supp. 182, 183–84 (S.D.N.Y. 1933).

The fact is, if an author wants to write the way people talk, that author is going to have to include profanity. The average contemporary English speaker uses 80 to 90 swear words per day. Timothy Jay, *The Utility and Ubiquity of Taboo Words*, 4 Perspectives on Psychological Science, No. 2, 155 (2009).[4] One study found that across three different social settings, only four types of words were consistently used with the highest

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[4] This figure is even more impressive if we assume that those who work at the PTO are as sensitive as the government claims. *See* Pet. App. 33a ("At another point, the government indicated its interest is to shield its examiners from immoral or scandalous marks."). Since none of these examiners could possibly have the urge to sully their own lips, there must be some people out there swearing 180 times a day to make up the difference.

frequency: pronouns, articles, prepositions, and profanity. Mohr, *supra*, at 251.

Of course, curse words are not as routine as prepositions or pronouns, even if they are nearly as common. "Curse words are words we are not supposed to say; hence, curse words themselves are powerful." Timothy Jay, *Why We Curse: A Neuro-Psycho-Social Theory of Speech* 18 (1999) [hereinafter Jay, *Why We Curse*]. For this reason, their use can serve as a signal of trust and familiarity that no euphemism could achieve.

In his autobiographical novel *The Water Is Wide* (1972), author Pat Conroy recounts his experience as a white teacher at an all-black school in the deep south of the 1960s. As the book shows, "Conroy had to establish trust where there was none, and profanity helped him do it." Michael Adams, *In Praise of Profanity* 74 (2016). Conroy discovered that profanity, even the mild-but-shocking-to-schoolchildren "bullcrap," is a signal of authenticity. In everyday life, profanity is "an accident of just talking. Break down social barriers, attempt to build new relationships, and people talk the way they talk, neglecting self-censorship." *Id.* at 75.

Profanity is thus a powerful rhetorical device. By establishing a less formal connection with a listener, it can make an orator or author seem both more trustworthy and more persuasive. *See* Eric Rassin & Simone van der Heijden, *Appearing Credible? Swearing Helps!*, 11 Psychology, Crime & Law No. 2, 177 (2005) (finding that testimony containing words such as "God damn it," "shitty," "fucking," and "asshole" was perceived as more credible than otherwise identical testimony without swears); Cory Scherer & Brad Sagarin, *Indecent Influence: The Positive Effects of Obscenity on Persuasion*, 1 Social Influence 138 (2006).

The same principles hold true for titles of artistic works, which serve as a form of advertising and brand identity for artists and authors:

> In March 2011, three of the top-ten hit songs on the *Billboard* pop music chart had obscenities in their titles . . . . Cee Lo Green told various people off with 'Fuck You!,' Enrique Iglesias begged pardon for his rudeness in announcing 'Tonight (I'm Fucking You),' and Pink told listeners that they needn't be 'Fuckin' Perfect.'

Mohr, *supra*, at 246; *see also* Jon Pareles, *From Cee Lo Green to Pink, Speaking the Unspeakable*, N.Y. Times, Mar. 15, 2011 (noting the effectiveness of the taboo chorus in a market where "[p]op songs fight to be noticed in an arms race of sentiments, gimmicks, sonic manipulation and promotional strategies"). And such edgy strategies are not limited to hip-hop. In fact, "*New York Times* best-selling books have been ahead of the curve in this respect." Mohr, *supra*, at 247. Perusing the historical list of titles that made this list, one would find "Randall Kennedy's *Nigger* way back in 2003, followed by Harry Frankfurt's *On Bullshit* (2005), Justin Halpern's *Shit My Dad Says* (2009), and Adam Mansbach's *Go the Fuck to Sleep* (2011)." *Id.*[5]

And this brings us, finally, to brands themselves. The government attempts to distinguish brand names

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[5] Counsel of record is the father of two young boys and owns *Go the Fuck to Sleep*. He can attest to the profound truth of parenting conveyed by the narrator's profane imploring, which captures a state of mind every new parent experiences:

> The flowers doze low in the meadows
> And high on the mountains so steep.
> My life is a failure, I'm a shitty-ass parent.
> Stop fucking with me, please, and sleep.

from longer artistic works by arguing that trademarks are "simply source identifiers." Pet. Br. 44. But even the shortest brand name can pack an expressive punch and define an identity. When a clothing brand chooses a name like "FCUK," for example, this choice embraces "the risqué element, the apparent avoidance through mis-ordering, the in-your-face-ness of *fuck*, which they appear to sidestep but in fact highlight." Ruth Wajnryb, *Expletive Deleted: A Good Look at Bad Language* 187 (2005). In this way, "both profanity and its euphemisms help to manufacture the brand community." Adams, *supra*, at 71. Though it's certainly not what every brand wants, edgy and even vulgar language can perform an important signaling role.

Of course, all of these examples are not to suggest that that *every* use of profanity comes from a place of authenticity. Like any rhetorical device, profanity can be manipulated, with varying degrees of success.[6] Nor is profanity something that every speaker wants to be associated with. The point is that whether to use profanity is a *choice*—a meaningful choice—that changes not just the *mode* of expressing ideas but the *attitude* and *meaning* of the ideas themselves. As the psychologist Timothy Jay explains:

> How we use these curse words portrays our deep emotional investment in a personal identity which we use to experience the world, to differentiate ourselves from others, and to express our feelings and attitudes about others. The use

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[6] Like other rhetorical devices, profanity can be transparently put on as an affectation. When done clumsily, the effect is far less powerful—and more cringe-inducing. *See, e.g.*, Dan Merica, *Sh*t Talking Is Democrats' New Strategy*, CNN.com (April 24, 2017), https://cnn.it/2FlCCb5.

> of these words tells us who we are and how we fit in the world. We do not just utter curse words; curse words are part of our identities.

Jay, *Why We Curse* 82.

The choice of how we use these words, like all other expressive choices, is one that the First Amendment allows us to make without punishment.

B. Distaste for "Vulgar" Language Often Arises from Prejudice

Not only does punishing profanity harm expression, it also carries unjustified value judgments about class and culture. "*Vulgar* language makes a class distinction—it is that spoken by ordinary, uneducated folk. It has become a synonym for swearing because 'the common people' have through the centuries been thought to be more likely than others to employ profane or obscene language." Mohr, *supra*, at 11.

Much of the distaste for obscenity comes from a notion that peppering speech with colorful words belies a lack of education, a small vocabulary, or both. One 1890s English slang dictionary derisively defined "bloody" this way:

> [A]s it falls with wearisome reiteration every two or three seconds from the mouths of London roughs of the lowest type, no special meaning, much less a sanguinary one, can be attached to its use. In such a case it forms a convenient intensitive, sufficiently important as regards sound to satisfy those whose lack of language causes them to fall back upon a frequent use of words of this type.

"Bloody," *Slang and Its Analogues*, (Farmer & Henley, eds., 1890). The 1888 Oxford English Dictionary similarly editorialized that "bloody" was a word "constantly in the mouths of the lowest classes, but by respectable people considered a 'horrid' word." *See* Mohr, *supra*, at 212.

This conflation of swearing with mental laziness or ignorance has continued to the present. In the anti-swearing book *Cuss Control*, the author writes that:

> [T]he S word and several other obscenities have many applications. When we get mentally and verbally lazy, these words are always on call, sparing us the task of scanning our brain and downloading even the most simple noun or adjective. There seems to be no need to make the effort when talking intelligently is rarely a social requirement, and curse words are as common as bad grammar.

James V. O'Connor, *Cuss Control: The Complete Book on How to Curb Your Cursing* 18 (2000).

It is ironic that words which can be so versatile, with an entire encyclopedia devoted to the meanings of just the word "fuck," can be derided as used only by those with deficient vocabularies. *See generally* Jesse Sheidlower, *The F-Word* (2009). Indeed, "fuck," is so versatile and expressive a word that an entire scene of a prestige television drama was written with dialogue containing nothing but variations of it. *See* The Wire, *Old Cases* (HBO 2002); *see also* Jonathan Abrams, *An Oral History of* The Wire*'s Unforgettable 5-Minute F*ck' Scene*, Vulture (Feb. 13, 2018), https://bit.ly/2Sph1Yq.

Scenes like that give the lie to the notion that profanity is purely the domain of those with small vocabularies. "When things are so grim . . . ordinary words fail even the most seasoned detectives. It's not that [the detective characters] don't know more words—there just isn't anything else to say but *fuck*, or *Aw, fuck*, or *motherfuck*." Adams, *supra*, at 134.

In sum, stereotypes about those who use profanity are just that: stereotypes. In fact, studies have shown that using profanity is *positively* correlated with both intellect and honesty. *See, e.g.*, Kristin L. Jay & Timothy B. Jay, *Taboo Word Fluency and Knowledge of Slurs and General Pejoratives: Deconstructing the Poverty-of-Vocabulary Myth*, 52 Language Sciences 251 (2015); Gilad Feldman, et al., *Frankly, We Do Give a Damn: The Relationship Between Profanity and Honesty*, 8 Social Psycological & Personality Science 816 (2017); *see also* Dave Maclean, *Intelligent People Are More Likely to Swear, Study Shows*, The Independent, (Aug. 28, 2017), https://ind.pn/2jzdi6Y.

If there is an element of truth to the identification of obscenity with lower classes, it arises not from a lack of education but instead from the fact that obscenity in literature and music are the most effective words "for resisting 'the system' and the dominant culture that expects certain kinds of 'good' language and behavior." Mohr, *supra*, at 248. As the linguist Tony McEnery argued, "[b]roadly speaking, the discourse of power excludes bad language, the discourse of the disempowered includes it." Tony McEnery, *Swearing in English: Bad Language, Purity and Power from 1586 to the Present* 10 (2006). Or as Lenny Bruce put it even more pointedly: "If you can't say 'fuck,' you can't say 'fuck the government.'" *See Fuck* (ThinkFilm 2005).

If indeed profanity is used to a greater extent by the disempowered, this only further establishes that a ban aimed solely at profanity can never be truly "viewpoint neutral." The history of prejudicial attitudes behind anti-profanity campaigns is yet another reason to reject the idea that punishing profanity can ever serve a legitimate government interest.

C. Profane Language Is Beneficial for Science and Health

Discouraging profanity not only fails to further a legitimate interest, it also affirmatively *harms* the progress of science by placing an unnecessary taboo on a rich area of research. Put simply "we learn things about language, the mind, the brain, and society from profanity that we simply couldn't know if we pointed our microscopes elsewhere." Benjamin K. Bergen, *What the F: What Swearing Reveals About Our Language, Our Brains, and Ourselves* 223 (2016).

First, swear words have helped us to better understand our own brains and how we process language. Scientists have observed that patients with damage to the left hemisphere of their brain can lose "the ability to construct syntactically correct sentences[], while retaining the ability to curse." Jay, *Why We Curse* 33.

Why would this be? Language is typically said to originate from the brain's left hemisphere, which is associated with "calculation, analytic thinking, and verbal reasoning." *Id.* at 35. An expletive, however, is one of the few pieces of language that contains its whole meaning in a single word, without needing to be combined with others in a complex syntax. A dirty joke or pun, on the other hand—much as we like "dad jokes"—

requires syntax. The left-hemisphere-damaged patients could achieve the former, but not the latter. Thus, these studies of swearers led researchers to realize that *holistic* speech—singular words and phrases that contain a set meaning and pack an emotional punch—actually comes from the right hemisphere, which also controls "visualization, musical abilities, spatial reasoning, and holistic processing." *Id.*[7] In this way, "understanding how and why we swear has helped us to reverse-engineer the structure of the brain." Emma Byrne, *Swearing Is Good for You: The Amazing Science of Bad Language* 29 (2018).

This phenomenon means that in some cases, curse words become the last link between loved ones and a friend or family member dealing with cognitive loss. One early researcher

> described patients who uttered 'god bless' when frustrated or 'damn' when a family member did not arrive at the hospital on time. However, the patient could not construct sentences with curse words on demand. While a brain-damaged patient cannot construct sentences, he or she can utter meaningful emotional statements learned in childhood. Hence, curse words remain accessible as implicit knowledge when other avenues for communication become unavailable.

Jay, *Why We Curse* 87.

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[7] This understanding of the brain is supported by the case of a man with damage to his *right* hemisphere. After his injury he could still speak in fluent sentences, but "he was unable to sing familiar songs or recite nursery rhymes, and he couldn't spontaneously swear." Bergen, *supra*, at 90. In other words, he had been rendered into the model PTO employee.

Placing a taboo on curse words, reinforced by government policies establishing those words as undesired, only adds unneeded harm and embarrassment for patients and families in this situation. When Charles Baudelaire was hospitalized after a stroke in 1866, for example, he barely spoke except to utter the phrase "cré nom," short for "sacré nom de Dieu." He repeated this phrase so often that the nuns who served as his caretakers threw him out of the hospital, "so unforgivably offended . . . that they could explain Baudelaire's outbursts only as the result of satanic possession." Mohr, *supra*, at 3.

In addition to neuroscientists, linguists have also long marveled at the unique properties of profanity. Swearwords are some of the most versatile words in any language. "Geoffrey Hughes categorizes swearing into eight classes, while Tony McEnery finds sixteen." Mohr, *supra*, at 214. Swear words are also grammatical wonders. English has prefixes and suffixes galore, but how many words can be placed in the *middle* of other words? "[O]nly profane words (or near facsimiles) can be 'infixed' into other words in English," in such classic examples "as the *fucking* in *un-fucking-believable*." Bergen, *supra*, at 6.

Further, swears are the only adjectives that can modify the mood of an *entire* sentence. Steven Pinker provides this example:

Interviewer:	Why is British food so bad?
John Cleese:	Because we had a bloody empire to run, you see?

Pinker, supra, at 361.

If "bloody" were a normal adjective, it would be modifying the noun "empire." Yet "Cleese was not casting aspersions on the empire on which the sun never set; he was expressing mock exasperation with the interviewer's question." *Id.* Expletives thus have the unique ability to break the fourth wall of the sentences that contain them. Like characters in a play choosing to talk about the play they are in rather than their fellow characters, "[e]xpletives indicate that something is lamentable about an entire state of affairs, not the entity named by the noun." *Id.*

Not only is swearing of interest to researchers, it has been shown to have practical benefits as a scientifically proven painkiller. *See* Richard Stephens, *et al., Swearing as a Response to Pain—Effect of Daily Swearing Frequency*, 12 J. of Pain, Issue 12, 1274 (2011) (finding that those who yelled swear words such as "fuck!" could endure submerging their hands in painfully cold water for 40 seconds longer, on average, than those who attempted to suffer with dignity). Instead of discouraging profanity, perhaps the government should instead be *promoting* it as the only proven painkiller with no risk of dangerous side-effects.

Finally, swearing is practically useful for the simple reason that it can serve as an emotional outlet for settling conflicts that might otherwise turn physical. "It has been said that he who was the first to abuse his fellow-man instead of knocking out his brains without a word, laid thereby the basis of civilization." John Hughlings Jackson, *Selected Writings of John Hughlings Jackson, Vol. 2* 179 (1958).

In early 16th Century Scotland, royals would pit poets against each other in comedic insult battles

called "flyting." "Flyting was very much like the freestyle battles of today, in which rappers compete to insult each other in the most creative ways." Mohr, *supra*, at 155. A few "flyting" lines have been preserved for posterity, including Walter Kennedy's dismissal of William Dunbar as a "Skaldit skaitbird and common skamelar, / Wanfukkit funling that Natour maid ane yrle" (Rough translation: "diseased vulture and common parasite, / weakly conceived foundling that Nature made a dwarf"). *Id.* From antient flyting to modern rap, "this kind of organized obscenity has evolved over and over in society—it must represent a fairly universal human urge." *Id.* at 248. To the extent this urge has found an outlet in playful insults, profanity is crucial in civilized society, as "an important safety valve, allowing people to express negative emotions without resorting to physical violence." *Id.* at 255.

Official attempts to discourage profanity ignore the role such words play in our lives. Profanity is a means to express and define ourselves, to cope, to joke, and to mock. Profanity is an integral part of the human condition. Indeed, a language stripped of profanity isn't a recognizable language at all. "[D]espite the variation across time and space, it's safe to say that most languages, probably all, have emotionally laden words that may not be used in polite conversation." Pinker, *supra*, at 330.[8] The choice to use those words, in good company or otherwise, isn't the government's to make.

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[8] "Perhaps the most extreme example is Djirbal, an Aboriginal language of Australia, in which *every* word is taboo when spoken in the presence of mothers-in-law and certain cousins. Speakers have to use an entirely different vocabulary (though the same grammar) when those relatives are around." Pinker, *supra*, at 330. And you thought your Thanksgiving dinner was tense.

II. THE GOVERNMENT CANNOT OBJECTIVELY DETERMINE WHAT LANGUAGE IS "SCANDALOUS"

When the government creates a scheme approving of some speech and disapproving of other speech, it must at the very least "articulate some sensible basis for distinguishing what may come in from what must stay out." *Minn. Voters Alliance v. Mansky*, 138 S. Ct. 1876, 1888 (2018). A standard runs afoul of the First Amendment if it "introduces confusing line-drawing problems," because such a standard creates "the potential for erratic application." *Id.* at 1889–90. So when government employees apply a speech code, their "discretion must be guided by objective, workable standards." *Id.* at 1891. The PTO's "scandalous marks" provision does not come close to meeting this requirement.

A. There Can Be No Single Standard for Offensiveness in a Pluralistic Society

The test used by the PTO to determine whether a mark is immoral or scandalous is whether a "substantial composite of the general public" would find the mark "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation." Pet. App. 29a–30a.

Putting aside the vagueness of the term "substantial composite," (which, we are told, is "not *necessarily* a majority," *see* Pet. App. 66a n.11 (emphasis added)), how does the government expect to know public tastes at all? Remarkably, it has apparently never actually asked us. Even the FCC, which deals with this problem more often than the PTO, has never taken a single

survey. "As far as anyone can tell, the FCC hasn't actually done the legwork to find out what people really think about words—what's profane, in the present culture, in the present time." Bergen, *supra*, at 10.

But a single survey would not solve the more fundamental problem, which is that there cannot be one consensus standard of "scandalous language" in a heterogeneous society. Just look at the nations that actually *have* attempted such surveys. In New Zealand, for example, the Broadcasting Standards Authority conducts a regular survey asking whether citizens would find certain words always acceptable on radio and television, never acceptable, or acceptable in only some contexts. The results show a wide range of opinions. In other words, no matter how a government chooses to categorize any given word, it will always go against the values of a significant portion of the population. For example, the most recent survey found that 15 percent of the population viewed the word "God" as never acceptable for broadcast television, while 15 percent—probably not the same 15 percent—found "fuck" to *always* be acceptable. *See* N.Z. Broad. Standards Auth., *Language That May Offend in Broadcasting*, June 2018, https://bit.ly/2CuLdY3. That same study found that offensive standards vary across ages. For example, while only 18 percent of those 25–34 found "Jesus Christ" to be unacceptable in a TV drama, 36 percent of those 65 and over still found it unacceptable. *Id.* And on several words, the society was as evenly divided as could be, with a virtual 50/50 split on the question whether "mother fucker," "chink," or "faggot," were sometimes acceptable. *Id.* This lack of consensus is not peculiar to New Zealand. A similar study in Great Britain likewise "shows rampant disagreement." Bergen, *supra*, at 13 (citing Andrea Millwood-Hargrave,

Delete Expletives?, Ofcom (Dec. 2000), https://bit.ly/2Fr3PZF).

As scholars have noted, "[t]his diversity of opinion prompts a host of second-order questions." Bergen, *supra*, at 12. For example, "suppose there's a word that a minority subgroup of the population finds profane, and say it's a term of abuse. . . . In such a case, which matters more, the opinions of the population in aggregate or those of people in the relevant subgroup? How do you decide?" *Id.* Suppose a similar split appeared in attitudes about a particular word based on class or education. What should be the standard for a government censor evaluating offensiveness? The standards of the middle class? Of the most educated? Once again, there is no answer in the statute. Nor is there any answer that could be fair to society as a whole.[9]

As an added wrinkle, "[a] trademark is scandalous or immoral in context of the relevant marketplace for the applicant's goods or services identified in the application." Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L.J. 321, 334 (2015) (citations omitted). If examiners took this aspect of the test literally, they would in some cases have to familiarize themselves with the norms of other nations. But attitudes toward profanity vary just as much *across*

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[9] Those who consider themselves of a more refined class will seize on any difference in vocabulary to differentiate themselves and label the alternative "vulgar." "In Britain . . . *toilet* is vulgar in the original sense of the term—it has class connotations, employed by people of the middle class on down. *Loo* is the word used by upper-class Brits. . . . [W]hen Prince William and Kate Middleton broke up briefly in 2007, the British press blamed it on Kate's mother's use of the word *toilet*." Mohr, *supra*, at 202.

nations as they do *within* them. In France, for example, the mainstream culture's attitude toward profanity is so relaxed that *Le Monde* can quote the Prime Minister referring to a situation as "foutu" (fucked) with no real scandal. *See* Bastien Bonnefous, *Manuel Valls Droit dans Ses Bottes Face à Sa Majorité*, Le Monde (Sep. 15, 2014), https://lemde.fr/2U1zCtQ.[10]

The answer to these dilemmas is that the government should get out of the business of defining what is offensive or scandalous. It is simply impossible to find one cultural "spectrum" or "ranking" of offensive words that everyone will agree on even within a single country. While religious oaths are popularly understood to have been supplanted by sexual and excretory language as the more offensive terms, there are many for whom the old order still reigns. One scholar interviewed a modern-day member of an evangelical group at Oxford University who explained "It's offensive to God, basically, to take His name in vain. . . . I find that kind of swearing more offensive, probably, than the 'F-word' or whatever." Mohr, *supra*, at 257.

"Profanity isn't fixed. It's variable, it's context-sensitive, and it's relative. It's the product of cultural attitudes toward specific words, attitudes that can differ radically from person to person and from culture to culture." Bergen, *supra*, at 221. When the government tries to create one standard for a whole country, such

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[10] In the U.S., perhaps uniquely, the offensiveness of a politician dropping an F-bomb depends on his or her political party. *Compare* Nick Carbone, *Our Ten Favorite Joe Biden Moments: The 'BFD'*, Time.com (Nov. 19, 2012), https://bit.ly/2HyqTt2, *with* Lloyd Grove, *John Boehner's F-Bomb at Harry Reid Plunges D.C. Incivility to New Low*, The Daily Beast (Jan. 3, 2013), https://bit.ly/2SBuKrn.

a project inevitably involves telling a significant portion of that country that their standards are wrong and out of step with the official orthodox standards of the U.S. government. There is no reason the government should involve itself in such a project.

B. The Lines Censors Draw Are Often Biased, Irrational, or Naïve

There is strong evidence that when censors have the power to make subjective decisions over what is "scandalous," biases in favor of majority groups and powerful groups naturally arise.

This problem is not limited to government. When Rhett Butler left Scarlett O'Hara with the line "frankly my dear, I don't give a damn," in the film *Gone with the Wind* (MGM 1939), the movie evaded a fine for the word "damn" only because of a recent change in the Screen Code that excepted profanity in direct quotations from literary works. Mohr, *supra*, at 232. But that same code, hypocritically, "did not forbid or discourage the use of racial epithets such as *nigger*." *Id.* The original film script included the repeated use of that slur, which was removed from the script only "when the film's African American actors refused to say the word and hundreds of letters poured in objecting to its use." *Id.* Speech codes can reveal standards that seem not just backwards, but morally offensive.

More recently, the documentary *This Film Is Not Yet Rated* (IFC Films 2006) undertook a survey of MPAA ratings and found that movies with scenes involving gay sex were much more likely to incur an "NC-17" rating than movies with comparable scenes of straight sex, and that scenes emphasizing female sexual pleasure were rated more harshly than scenes of

male pleasure. Whether intentional or not, vague standards such as "scandalous to the community" invite this type of biased treatment. They especially risk special punishment for the expression of minority groups that are seen as outside the norm.

Censors in all fields routinely distinguish based on whether a "scandalous" word is spelled out or partially "hidden" through missing or rearranged letters. Yet studies have shown that this distinction does nothing to actually affect the reader's experience.

> One clever study had people read sentences with either profane words (like *This custard tastes like shit*) or censored versions (like *This custard tastes like s#!t*). After reading the sentences, participants performed a memory task to see whether they remembered exactly what they had seen. They would see one of the two sentences, with *s#!t* or *shit*, and had to say if this was the exact sentence they saw before. When *shit* replaced *s#!t*, most people had no idea.

Bergen, *supra*, at 218.

Similar alterations have in the past done nothing but marred artistic works, such as when Norman Mailer was convinced by his publisher to use "fug" throughout the *The Naked and the Dead* (1948).[11] Yet the PTO has demonstrated adherence to this fallacy, approving the trademark of the clothing brand FCUK while denying the trademark for the brand at issue in

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[11] On one (possibly apocryphal) occasion, this supposedly prompted a socialite to approach Mailer at a party by saying "So you're the young man who can't spell fuck." Mohr, *supra*, at 228.

this case, Fuct. *See* Pet. App. 40a. Of course, any consumer who reads the word FCUK "realize[s] the misordering [of letters] only after *fuck* has registered." Wajnryb, *supra*, at 187. The PTO cannot seriously argue that the fig leaf of misordering makes any real change, yet decisions on which brands make the cut can seemingly turn on such meaningless differences.

Further, although censors may be trained to spot "obvious" profanity, they are often oblivious to double-entendre or codewords. "[W]hen Matt Stone and Trey Parker made their feature-length *South Park* film . . . the title was originally *South Park: All Hell Breaks Loose*, but the MPAA categorically rejected the word *Hell*, so the film was retitled with a plausibly more offensive double entendre: *South Park: Bigger, Longer and Uncut*." Bergen, *supra*, at 220.

Shakespeare himself took delight in wordplay by means of homophones, suggesting to his audience various naughty words without ever having to outright say them. *See, e.g.*, Twelfth Night act 2, scene 5 (Malvolio: "By my life this is my lady's hand. These be her very C's, her U's and [sounds like "N"] her T's and thus makes she her great P's."). Shakespeare's subtle spelling game slipped past the watchful Bowdler, who printed it unaltered. Bowdler, *supra*, at 73.

PTO examiners have in some cases shown similar naiveté when it comes to approving and denying marks, such as one examiner who considered "Cum Together" to be acceptable because it's merely a parody of the Beatles. See Carpenter & Garner, *supra*, at 351.

Conversely, in some cases, government censors have been *over*-eager to find a naughty word when a mark was likely intended to be innocuous. In initially

rejecting a wine brand called "White Ass," the PTO examiner overlooked the fact that the wine's logo "included ears and a tail on the 'A' in the mark." Carpenter & Garner, *supra*, at 353. Only after this was pointed out on appeal was the rejection reversed. *Id.* In looking fastidiously for vulgarity just to prove how much they dislike it, enterprising censors resemble the woman who once complimented the dictionary author Samuel Johnson for excluding vulgarities. Johnson allegedly replied to her "No, Madam, I hope I have not daubed my fingers. I find, however, that you have been looking for them." Sheidlower, *supra*, at xxix.

Finally, and most troubling of all, different examiners have reached different conclusions on marks containing the same word, demonstrating the utter lack of guidance in this area. *See, e.g.*, Carpenter & Garner, *supra*, at 354 (noting that the PTO granted a mark for "Bonerwear" but denied a mark for "Boner Bats"). *See also* Pet. App. 39a–40a (noting that the PTO had been similarly inconsistent in deciding whether to grant trademarks containing words like "fugly," "cocaine," "BS," "turd," and "MILF"); Carpenter & Garner, *supra*, at 357 (finding further inconsistency for marks containing "anal," "ass," "cock," "fag," "penis," "slut," and "whore"). Despite the inconsistent rulings by PTO examiners, their decisions to reject marks for being "scandalous" are rarely reversed. *See id.* at 345 (noting that the lack of success on appeal "may be . . . because the lack of clear legal standards for examiners makes it too difficult for applicants to overcome refusals.").

"In sum, the various ways we react to profanity by trying to limit it are grossly ineffectual. They generally don't decrease how much it's used, and even when they do, new words spring up in their place." Bergen, *supra*,

at 220. The ineffective and inconsistent application of the PTO's vague standards alone makes the "scandalous marks" provision unconstitutional.

CONCLUSION

It is precisely in the sterile environment of government agencies where profanity might seem the most offensive and worthless. After all, in swearing as in all else, context is everything. "What makes a dirty joke inappropriate or unfunny depends on the joke and the context (the office versus the local pub). . . . [O]ffensiveness and humor depend on cultural contexts." Jay, *Why We Curse* 19. But it is exactly this context-dependency that can make examiners and other officials lose sight of the fact that transgressive and risqué language has its necessary place.

The government's attempt to define and punish scandalousness is both misguided and unconstitutional, so the Court should affirm the Federal Circuit.

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No. 18-302

IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

AMICUS CURIAE BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF RESPONDENT

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The undersigned amicus curiae respectfully submits this brief in support of Respondent Erik Brunetti, and urges affirmance of the decision below in *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017).[1]

INTERESTS OF THE *AMICUS CURIAE*

Amicus curiae the International Trademark Association ("INTA") is a not-for-profit global organization dedicated to the support and advancement of trademarks and related intellectual property. Founded in 1878, INTA has more than 7,200 member organizations from 191 countries. Its members include trademark and brand owners, as well as law firms and other professionals who regularly assist in the creation, registration, protection, and enforcement of trademarks. All INTA members share the goal of promoting an understanding of the essential role that trademarks play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation following invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has

1. Pursuant to Supreme Court Rule 37.6, this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel for a party. No party or counsel for a party, nor any other person or entity other than *amicus curiae*, its members, and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.3(a), both Petitioner and Respondent have provided written consent to INTA's filing of this brief.

been instrumental in making recommendations and providing assistance to legislators in connection with major trademark and related legislation. INTA also has participated as *amicus curiae* in numerous cases in this Court and other courts across the country involving significant Lanham Act issues.[2] Moreover, INTA's members are frequent participants in litigations, both

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2. Cases in which INTA has filed amicus briefs include: *Mission Product Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 397 (petition for certiorari granted Oct. 26, 2018); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 568 U.S. ___ (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *Shammas v. Focarino*, 784 F.3d 219 (4th Cir. 2015); *Ferring B.V. v. Watson Labs., Inc.-Fla.*, 764 F.3d 1382 (3d Cir. 2014); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A.*, Inc., 654 F.3d 958 (9th Cir. 2011); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158 (9th Cir. 2011); *Chloe v. Queen Bee of Beverly Hills, LLC*, 616 F.3d 158 (2d Cir. 2010); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559 (5th Cir. 2005).

in courts and in administrative proceedings before the United States Patent and Trademark Office ("PTO") and the Trademark Trial and Appeal Board ("TTAB"), with respect to the Lanham Act. INTA and its members have a deep and powerful interest in the development of clear, consistent, and equitable principles of trademark law, and in fair and consistent rules on the registration of trademarks.

This case presents an issue of core concern to INTA and its members: What trademarks are and are not registrable under the Lanham Act. Brand owners invest significant time, effort, and expense in developing and clearing trademarks for federal registration. Such registration adds important procedural protections and remedies to the substantive trademark rights that are conferred by common law. In deciding whether to invest in developing and clearing a mark that will obtain federal registration, trademark owners need clear guidance about what the PTO will and will not allow. Trademark owners also need the First Amendment freedom to choose a wide range of marks, responding over time to evolving consumer tastes without fear that their efforts will founder on the unpredictable, archaic, and unconstitutional "immoral ... or scandalous" provision of Section 2(a) of the Lanham Act ("immoral or scandalous provision"). 15 U.S.C. § 1052(a).

SUMMARY OF ARGUMENT

The immoral or scandalous provision in Section 2(a) of the Lanham Act regulates the registration of trademarks. Trademarks—including marks that include or consist of offensive terms, like the FUCT mark at issue in this case—are commercial speech because their entire

purpose is to propose commercial transactions. They tell consumers, "Come buy this branded car, or shirt, or smartphone, or ride on this airline or visit this theme park. This brand name, this logo, this slogan, all assure you up front that you are getting goods and services from a particular source that promises you things of a certain nature and quality."

Trademark law protects only the commercial aspects of trademarks. It does not also protect any expressive components. Appropriately, trademarks have been treated as commercial speech long before the spotlight shone upon them by this case. For these reasons, trademarks are commercial speech, and intermediate scrutiny applies to Section 2(a).

Strict scrutiny would apply only if the government were fully restricting speech, which is not the case here. Federal trademark registration offers many benefits, including conferring prima facie evidence of the validity of the registered mark and preventing the importation into the United States of articles bearing a counterfeit mark, among others. Trademarks still can exist in the market and be protected under common law, even if registration under the Lanham Act is denied. As a result, the government action involved in this case is not a full restriction. Intermediate scrutiny is thus the appropriate standard of review. This is especially so given that intermediate scrutiny leaves Congress and individual trademark owners the ability to effectively police infringement.

Under the intermediate scrutiny test that applies to commercial speech, as articulated by the Court in

Central Hudson Gas & Electric Corp. v. Public Service Commission of New York, 447 U.S. 557 (1980), the immoral or scandalous provision is unconstitutional. This four-part test asks whether (1) the speech concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) the regulation is not more extensive than necessary. Although the government meets the first prong, it fails the remaining three.

With respect to the second factor, the government's only stated interests relate to protecting the public from immoral and scandalous speech, promoting the orderly flow of commerce, and avoiding any appearance of government approval through registration of such marks. The Court already has ruled that the purported government interest in protecting the public is inadequate, so the first interest cannot be deemed substantial. Nor can the government's interest in promoting the orderly flow of commerce be deemed a substantial interest, since trademarks serve only to identify a brand through its source indicator. Just because customers may find "immoral" or "scandalous" marks to be shocking does not minimize the strength of the marks as source indicators. Further, as the Court recently held in *Tam*, 137 S. Ct. at 1760, trademarks are not government speech. The government therefore has no interest, substantial or otherwise, in dissociating itself from the trademarks it registers.

With respect to the third factor, the government fails to demonstrate that the provision is capable of advancing any of its purported interests. The provision cannot protect public sensibilities since the public is exposed to offensive content in many other contexts besides trademarks. Nor

can the government interest of protecting the orderly flow of commerce be advanced through the provision; the provision does not and cannot prohibit the use of scandalous or immoral trademarks in commerce because the denial of registration does not prevent the use of the marks at issue in commerce. Finally, even if trademark registrations were deemed a form of government speech, there is no support for the argument that the general public would associate trademarks with the government. Thus, the provision would not further the government's interest in disconnecting itself from trademarks of which it does not approve.

Moreover, the immoral or scandalous provision of Section 2(a) of the Lanham Act is so inherently vague, and has been so inconsistently applied that the government cannot credibly argue that the provision directly advances any interests it may have. The statutory language consists only of the bare words "immoral" and "scandalous," leaving the PTO with little, if any, guidance and resulting in wildly inconsistent PTO actions. As a result, nearly identical marks containing the same provocative terms have been approved in some cases and rejected in others.

With respect to the fourth factor, the government has not demonstrated, and cannot demonstrate, that the provision is narrowly tailored to further its interests. Primarily, the provision is facially overbroad, reaching some trademarks that are innocuous and only potentially offensive. The very process by which PTO examiners review trademark applications for "immoral ... or scandalous" language is extremely subjective, leaving determinations about morality and scandalousness in the hands of the individual examiners who have varying

beliefs about the subjects. Such erratic application of this provision confirms that the provision has not been carefully tailored.

Because the government fails three out of the four prongs under the intermediate scrutiny analysis, the immoral or scandalous provision is unconstitutional and should be invalidated. For similar reasons, the provision is also unconstitutional as void for vagueness.

The government likewise cannot justify this unconstitutional statute by labeling it as part of the spending power. This approach would allow the government to impose conditions on the receipt of federal funds. Trademark registration does not implicate Congress's powers to spend or control government funds or property and therefore does not relate to the government's spending power.

ARGUMENT

I. Section 2(a) Cannot Survive Intermediate Scrutiny, Which Is The Appropriate Standard Of Review

The threshold issue is what standard of review applies to Section 2(a) for purposes of assessing its constitutionality: Is the provision a complete limitation on expressive speech, carrying independent political or cultural viewpoints and significance, such that it should be subject to strict scrutiny? Or is the provision a regulation on commercial speech, *i.e.* "speech proposing a commercial transaction," *Cent. Hudson*, 447 U.S. at 562, that would deny registration but still allow common law trademark protection, thereby warranting the less rigorous standard of intermediate scrutiny?

INTA believes strongly that trademarks are commercial speech, on which Section 2(a) does not impose a complete restriction. INTA thus urges the Court to clarify that intermediate scrutiny is the correct framework, not strict scrutiny as the Federal Circuit held. INTA further urges the Court to confirm the result below—that is, to hold that the "immoral ... or scandalous" restriction of Section 2(a) fails intermediate scrutiny.

A. Intermediate Scrutiny Is The Appropriate Standard Of Review

1. Trademarks Are Commercial Speech, Restrictions On Which Are Subject To Intermediate Scrutiny

Trademarks are quintessential commercial speech. In federal law, they are defined as commercial designations used to "identify and distinguish" goods. 15 U.S.C. § 1127. In the real world, trademarks do the same thing: They are brand names, logos, slogans, and other designations that quickly tell a consumer that a product or service comes from Company A rather than Company B. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 191 n.1 (1985) ("The Lanham Act defines a trademark to include 'any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.'") (citation omitted). Consumers know that the Crest toothpaste brand from Procter & Gamble can be counted on for oral hygiene; that under McDonalds' Golden Arches they will always find a Big Mac hamburger with reliable taste and quality; that the Nike swoosh is a reliable promise of

high-quality fitness gear and apparel; and that an Apple computer product can be counted on for sleek design and high performance. Any American consumer could instantly provide many more such examples. Simply put, trademarks are what enable consumers to "identify [the] goods and services that they wish to purchase, as well as those they want to avoid." *See Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (citations omitted).

The Lanham Act generally does not create substantive trademark rights. Rather, the Lanham Act provides a system of federal registration and enforcement for trademark rights that arise at common law. *See Tam*, 137 S. Ct. at 1751-52 ("[w]ithout federal registration, a valid trademark may still be used in commerce [and] may still be enforceable") (citation omitted). The advantages of federal registration include, but are not limited to: (1) conferring federal jurisdiction over infringement disputes without any required amount in controversy; (2) the availability of statutory damages for certain infringements in federal court; (3) prima facie evidence of the validity of the registered mark, of the registration of the mark, and of the registrant's exclusive right to use the mark; (4) the opportunity for a mark to become "incontestable," and to provide conclusive evidence of the registrant's exclusive right to use the mark; (5) constructive notice of a claim of ownership; (6) "constructive use date" as of the filing date of the application; and (7) prevention of the importation into the United States of articles bearing a counterfeit mark. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 19:9 (5th ed. 2019) ("McCarthy"). This Court should confirm the principle, well-settled even before *Tam*, that trademarks inherently are commercial speech. *See Friedman v. Rogers*, 440 U.S.

1, 11 (1979) ("the trade name is used as part of a proposal of a commercial transaction" and the use of a trade name "is a form of commercial speech and nothing more") (citations omitted); *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535-36, (1987) (regulation of the use of trademarks involves commercial speech, even if there are expressive components to the speech). Indeed, "[t]he power of the federal government to provide for trademark registration comes only under its 'Commerce Power.'" 1 McCarthy § 5:3.

The correctness of intermediate scrutiny as the appropriate standard is reinforced by the settled rule that, even when a trademark includes content with some expressive character, registration under the Lanham Act protects only the mark's source-identifying function. In *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, the petitioner sought to incorporate under the name "Golden Gate Olympic Association," to promote the "Gay Olympic Games," which the lower courts concluded infringed on the tra lemark rights of the U.S. Olympic Committee ("USOC"). *S.F. Arts*, 483 U.S. at 525. (Federal protection for those rights arose not under the Lanham Act but under the analogous provisions of Section 110 of the Amateur Sports Act—for present purposes, a distinction without a difference.) The petitioner argued that the statute suppressed political speech because "its use of the word 'Olympic' was intended to convey a political statement about the status of homosexuals in society." *Id.* at 535. The Court disagreed; it ruled that any expressive uses associated with "Gay Olympic Games" did not transform the exercise of rights under the Amateur Sports Act into regulation of expressive speech. *See id.* at 536. Instead, "[b]y prohibiting the use of one word for

particular [trademark] purposes, neither Congress nor the USOC has prohibited the [petitioner] from conveying its message," as evidenced by the fact that the petitioner still held its athletic event under the names "Gay Games I" and "Gay Games II." *See id.* Thus, the provision restricted "only the manner in which the [petitioner] may convey its message." *Id.*

Similarly, Section 2(a) of the Lanham Act does not regulate any expressive message of a trademark, only the registration of the trademark itself. *See Cent. Hudson*, 447 U.S. at 562 n.5 (according "full First Amendment protection to [commercial speech that includes expressive elements] . . . would blur further the line the Court has sought to draw in commercial speech cases"); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474 (1989) (strict scrutiny applies only to that commercial speech which is "inextricably intertwined" with expressive speech; where "there is nothing whatever 'inextricable' about the noncommercial aspects," strict scrutiny is not warranted).

Indeed, trademark law protects only those elements in a mark that have brand significance. For example, "merely descriptive" words are not registrable unless, through use in commerce, they take on a new, secondary meaning—as identifiers of source. 15 U.S.C. §§ 1052(e)-(f); *Park 'N Fly*, 469 U.S. at 194 ("A 'merely descriptive' mark ... may be registered only if the registrant shows that it has acquired secondary meaning."). To the extent an expressive component of a mark is deceptive, the PTO can refuse registration on that basis consistent with constitutional principles. *See, e.g., Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983) ("In light of the greater potential for deception . . . content-based

restrictions on commercial speech may be permissible.") (citations omitted); *In re Budge Mfg. Co.*, 857 F.2d 773 (Fed. Cir. 1988), *aff'g* 8 U.S.P.Q.2d 1790 (T.T.A.B. 1987) (LOVEE LAMB mark held deceptive for automobile seat covers not made of lambskin but rather of "simulated sheepskin."); *In re Bacardi & Co.*, 48 U.S.P.Q.2d 1031, 1035 (T.T.A.B. 1998) (refusing registration of HAVANA CLUB mark for non-Cuban rum on the ground that the mark is primarily geographically deceptively misdescriptive).

For all of these reasons, trademarks are commercial speech, and restrictions like those at issue here should receive intermediate scrutiny. As discussed in Section I(B) below, the restriction on "immoral" and "scandalous" marks fails intermediate scrutiny and the Court should confirm its invalidation on that basis.

2. Strict Scrutiny Is Not Warranted Here

Because Section 2(a) does not suppress speech, but only denies registration of certain types of trademarks, strict scrutiny is not appropriate here.

As described above, the Lanham Act generally does not confer substantive trademark rights. In fact, "[w]ithout federal registration, a valid trademark may still be used in commerce" and "can be enforced against would-be infringers in several ways." *Tam*, 137 S. Ct. at 1752 (citations omitted).[3] The denial of the registration

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3. Regardless of federal registration, a trademark still can be protected and enforced under Section 43(a) of the Lanham Act, which gives rise to an actionable claim for use of "*any* word, term, name, symbol, or device, or *any* combination thereof, or

therefore does not prevent Mr. Brunetti from using the term "fuct," either generally or as a mark. This confirms that intermediate scrutiny is the First Amendment standard to be applied. *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007) (where the "risk [of the government's interference with protected speech] is inconsequential . . . strict scrutiny is unwarranted"). Because the trademark system presents little or no risk of the suppression of speech—particularly the suppression of speech at the core of the First Amendment, such as political speech—there is no basis in precedent or policy for applying strict scrutiny here.

Strict scrutiny historically has been reserved for regulations that "pose such inherent dangers to free expression, or present such potential for censorship or manipulation, as to justify application of the most exacting level of First Amendment scrutiny." *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 661–62 (1994) (applying intermediate scrutiny to must-carry provisions of Cable Television Consumer Protection and Competition Act of 1992). Here, Section 2(a) does not pose an "inherent danger[] to free expression" because it does not suppress use of "immoral ... or scandalous" trademarks.

INTA acknowledges that there is arguably a content-based aspect to the PTO's refusal to register a purportedly "immoral" or "scandalous" mark. *See Sorrell v. IMS*

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any false designation of origin, false or misleading description of fact, or false or misleading representation of fact." 15 U.S.C. 1125(a)(1) (emphasis added). Accordingly, Section 43(a) remains a viable cause of action against infringers of immoral or scandalous marks, regardless of those marks' ability to be registered under Section 2(a).

Health Inc., 564 U.S. 564, 566-67 (2011) (content-based regulations on commercial speech involve "a regulation of speech because of disagreement with the message it conveys.") (citations omitted). Registration would be permitted but for the PTO's judgment that the substantive message of the mark crosses a boundary. Still, the refusal ultimately is only a restriction on the manner by which the applicant can propose a commercial transaction—not a restriction on the proposal itself. The applicant is allowed to speak the offensive content; it just cannot tell the market that its mark is federally registered (such as by displaying the ® symbol next to its mark). Intermediate scrutiny therefore is the appropriate test. *See Cent. Hudson*, 447 U.S. at 562 n.5 (rejecting application of "full panoply of First Amendment protections" to expressive speech "made only in the context of commercial transactions").[4] Of course, anything that fails intermediate scrutiny will also fail strict scrutiny, so the choice of standards, while analytically important, is not outcome-determinative here. *See Sorrell*, 564 U.S. at 571 ("[T]he outcome is the same whether a special commercial speech inquiry or a stricter form of judicial scrutiny is applied.") (citations omitted).

Strict scrutiny exists to protect the ability to engage in core speech, such as political expression, *McIntyre v. Ohio Elections Comm'n*, 514 U.S. 334 (1995) (Ohio's statutory prohibition against distribution of any anonymous campaign literature failed strict scrutiny and violated the First Amendment); the ability to protest, *Texas v.*

4. In *Sorrell*, the Court held that heightened scrutiny applied to content-based regulations on commercial speech. 564 U.S. at 566. Unlike as in *Sorrell*, the regulation here imposes no more than an incidental burden on speech, for the reasons discussed above.

Johnson, 491 U.S. 397 (1989) (conviction for burning the American flag is inconsistent with the First Amendment); and freedom of the press, *Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221 (1987) (state sales tax regime that taxed general interest magazines but exempted newspapers and religious, professional, trade, and sports journals violated First Amendment's freedom of press guarantee). It does not apply here.

B. Section 2(a) Cannot Survive Intermediate Scrutiny

As a regulation of commercial speech, Section 2(a) is reviewed according to the intermediate scrutiny framework established in *Central Hudson*. This four-part test asks whether (1) the speech concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) the regulation is "not more extensive than necessary to serve that interest." *Cent. Hudson*, 447 U.S. at 566. INTA acknowledges that the immoral or scandalous provision passes muster under the first prong of the *Central Hudson* test: The trademarks here relate to lawful activity, and the proposed restriction on them is not based on any assertion that they are misleading. *See In re Brunetti*, 877 F.3d 1330, 1350 (Fed. Cir. 2017). Rather, the immoral or scandalous provision "is concerned with whether a mark is offensive, scandalous, or vulgar." *Id.* But the government has not shown, and cannot show, that Section 2(a) satisfies the remaining prongs under *Central Hudson*. *See Sorrell*, 564 U.S. at 571-72 ("Under a commercial speech inquiry, it is the State's burden to justify its content-based law as consistent with the First Amendment.") (citations omitted).

1. The Government Does Not Have A Substantial Interest In Prohibiting The Registration Of "Immoral" Or "Scandalous" Trademarks

The government appears to assert three possible interests in restricting the registration of "immoral" or "scandalous" marks: (a) protection of public order and morality; (b) protection of the orderly flow of commerce; and (c) the proposition that trademarks are a form of government rather than private speech. None of these arguments has any merit.

a. The Government Has No Substantial Interest In Protecting Public Order And Morality Through The Trademark Registration System

The government argues that its interest in not registering immoral and scandalous marks is to protect "the sensibilities of the public." Brief for Petitioner at 32-33, *Iancu v. Brunetti*, No. 18-302 (Jan. 4, 2019) ("Government Brief"). That argument does not pass constitutional muster. As this Court has held, a purported government interest in protecting the public from offensive speech is not an adequate basis for restricting speech. *Tam*, 137 S. Ct. at 1751 (it is a "bedrock First Amendment principle" that "[s]peech may not be banned on the ground that it expresses ideas that offend"); *see also id.* at 1767 (Kennedy, J., concurring) ("the Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed"). Indeed, "the public expression of ideas may not be prohibited merely because the ideas

are themselves offensive to some of their hearers." *Id.* at 1763 (Alito, J., concurring) (quoting *Street v. New York*, 394 U.S. 576, 592 (1969) and collecting cases); *id.* at 1767 (Kennedy, J., concurring) (citing Justice Alito's opinion at 1773-64); *see also Johnson*, 491 U.S. at 414 ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

b. Protecting The Orderly Flow Of Commerce Is Not A Legitimate Governmental Interest In This Context

The government further asserts an interest in ensuring the orderly flow of commerce, but this too is without merit. According to the government, scandalous marks disrupt the marketplace, "making commercial transactions less efficient." Government Brief at 34. The argument fails for two reasons.

First, the argument is counterfactual by any measure. The Victorian era ended long ago. Yet the government's brief seems to imagine a world in which decorous matrons are bringing commerce to a halt by collapsing in store aisles at the sight of a provocative brand name. That is simply not the world where trademark owners and their customers actually live. It is well-settled that imagined disturbances to public order cannot support restrictions on protected speech. *See Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 508 (1969) ("undifferentiated fear or apprehension of disturbance is not enough to overcome the right to freedom of expression").

Second, as the government acknowledges, the "predominant function" of a trademark is not to maintain public order in the marketplace, but simply to allow customers to easily identify and distinguish the source of goods or services. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000). Even if some customers do actually find "immoral ... or scandalous" marks to be shocking, that does not mean the marks are any less strong as source indicators. Common sense actually suggests the opposite: "marks with shock value can bring tremendous attention to a brand." B. Iverson, *Matal v. Tam*: What's New and What to Watch in Registration of Disparaging, Immoral, and Scandalous Trademarks, IP Watch Dog (Sept. 28, 2018), http://www.ipwatchdog.com/2018/09/28/matal-v-tam-turns-disparaging-immoral-scandalous-trademarks/id=101469/ (noting that brands like Dirty Dick's Crab House and French Connection UK, which uses FCUK on clothing, have leveraged this "shock value" in their advertising to bring more attention to their brands); *see also* DIRTY DICKS, Reg. No. 2,087,524 (registered for restaurant services); FCUK, Reg. No. 5,301,912 (registered for clothing). Far from interrupting the flow of commerce, such marks have succeeded in drawing attention to their brands and becoming powerful source indicators, thereby supporting efficient commerce.

c. Restrictions On Trademark Registrations Cannot Be Overcome By Mischaracterizing Trademarks As The Appearance Of Government Speech

Nor can the "immoral" or "scandalous" restrictions be justified by characterizing trademarks as the equivalent

of government speech. *See* Government Brief at 34 (arguing that "the government has a legitimate interest in avoiding not just the 'reality,' but also the 'appearance,' of government approval of vulgar speech"). Trademarks originate with the private parties that create them. Through the federal trademark system, the government is not speaking, but simply providing an administrative system for registration and enforcement. *See Tam*, 137 S. Ct. at 1760 ("Trademarks are private, not government, speech.").

Moreover, the government should not attempt to speak on behalf of all consumers by deciding, on the basis of the immoral or scandalous provision, which marks should enjoy the benefit of registration. In our time-honored capitalist system, picking winners and losers among trademarked goods and services is a decision for consumers themselves. If a trademark is offensive to the public, consumers may respond by not purchasing the product or service. In turn, any product or service that cannot support itself in the market will be unable to sustain federal registration, since marks that are not in use lose their right to a trademark registration. *See United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) ("the right to a particular mark grows out of its use, not its mere adoption"); 15 U.S.C. § 1051 (mark cannot be registered unless it is used in commerce); 15 U.S.C. § 1058 (registrations will be cancelled if registrant fails to file an affidavit confirming the mark remains in use in commerce).

2. Even If The Government Had A Substantial Interest, The Immoral Or Scandalous Provision Does Not Advance That Interest

The immoral or scandalous provision of Section 2(a) of the Lanham Act does not advance any substantial interest the government may have here. This prong of *Central Hudson* requires the government to "demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree." *Edenfield v. Fane*, 507 U.S. 761, 770-771 (1993). If the government "provides only ineffective or remote support for [its] purpose," the regulation may not be sustained. *Cent. Hudson*, 447 U.S. at 564.

None of the government's purported interests are "alleviated" by the immoral or scandalous provision. First, the provision is incapable of advancing the government interest of protecting public order and morality; the public is exposed to offensive content in many other contexts besides trademarks. Copyright law, for example, supports registration of all sorts of vulgar materials that may be considered offensive under the Lanham Act. *See Brunetti*, 877 F.3d at 1357 ("No doubt many works registered with the Copyright Office offend a substantial composite of the general public."); *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) (upholding copyright on pornographic film "Behind the Green Door" against an obscenity-based challenge; "[t]here is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work" (quoting *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973))).

Nor can the government interest of protecting the orderly flow of commerce be advanced through Section 2(a). Scandalous and immoral trademarks still can be used in commerce, and still can be protected against infringement, even absent federal registration.

Finally, if the government's objective is to avoid giving imprimatur to these marks, then Section 2(a) does not achieve such an interest. Even if trademark registrations were deemed a government imprimatur—which they are not, *Tam*, 137 S. Ct. at 1760—they would mean little to the general public who knows "no more about trademark registrations than a man walking down the street in a strange city knows about legal title to the land and buildings he passes." *Application of Nat'l Distillers & Chem. Corp.*, 297 F.2d 941, 949 (C.C.P.A.1962) (Rich, J. concurring); *see also Tam*, 137 S. Ct. at 1760 ("there is no evidence that the public associates the contents of trademarks with the Federal Government").

Moreover, because the terms "immoral" and "scandalous" are so inherently vague and inconsistently applied, Section 2(a) cannot possibly advance any government interest. *See Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 190, (1999) (where "regulatory regime is so pierced by exemptions and inconsistencies," it does not materially advance government interest). This inherent vagueness is a fatal constitutional flaw. The statutory text itself provides no guidance as to what either word means in this context. That lack of guidance cannot be cured by reference to any settled general meaning in the law, for neither "immoral" nor "scandalous" has any such generally accepted meaning. BLACK'S LAW DICTIONARY, for example,

simply refers to Section 2(a): It defines "scandalous subject matter" as a "word, phrase, symbol or graphic depiction that the U.S. Patent and Trademark Office may refuse to register because it is shockingly offensive to social mores." *Scandalous Subject Matter*, BLACK'S LAW DICTIONARY (10th ed. 2014). It also notes that, "[a]though the Lanham Act uses the phrase 'immoral, deceptive, or scandalous subject matter,' courts have not distinguished 'scandalous' from 'immoral.'" *Id.*; *see also Immoral*, BLACK'S LAW DICTIONARY (10th ed. 2014) (defining immoral as "[i]nconsistent with what is right, honest, and commendable," "[i]nimical to the general welfare," and "[n]ot following accepted standards of sexual behavior").[5]

Compounding the confusion, "immoral" and "scandalous" have been treated as interchangeable despite the basic principle of statutory interpretation that different words be given different meanings. *See, e.g.*, *Henson v. Santander Consumer USA Inc.*, 137 S. Ct. 1718, 1723 (2017) (when interpreting statutes, Court presumes differences in language convey differences

5. A useful contrast can be drawn to obscenity, where there is at least a settled framework for considering the issue. *See Miller v. California*, 413 U.S. 15, 24 (1973) (noting that state statutes designed to regulate obscene materials must be carefully limited and articulating a three-part standard for the trier of fact: "(a) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value)" (internal citations and quotation marks omitted). Section 2(a) of the Lanham Act casts a net far wider than prohibiting registration of only obscene marks.

in meaning); *Vonage Holdings Corp. v. F.C.C.*, 489 F.3d 1232, 1240 (D.C. Cir. 2007) ("we have repeatedly held that, '[w]here different terms are used in a single piece of legislation, the court must presume that Congress intended the terms to have different meanings'") (citation omitted). The PTO seems to have thrown up its hands: It generally applies the bar on "immoral" or "scandalous" marks as a unitary provision, without attempting to give independent significance to each word. Trademark Manual of Examining Procedure § 1203.01 (8th Ed. Oct. 2018) ("TMEP") (placing immoral matter and scandalous matter in the same category); *In re Brunetti*, 877 F.3d at 1336 (citing Gilson LaLonde & Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476, 1489 (2011) ("U.S. courts and the Board have not distinguished between 'immoral' and 'scandalous' and have focused on whether marks are scandalous or offensive rather than contrary to some accepted standard of morality.") (citation omitted)).

Not surprisingly, given the vagueness of the statute on its face, the PTO's efforts to develop a framework can fairly be described as simply a long list of words and concepts, one piled on the other, but all lacking in clarity. The PTO asks whether "a substantial composite of the general public" would find the mark scandalous, which it defines as "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (alterations omitted) (quoting *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)). Alternatively, "the PTO may prove scandalousness by establishing that a mark is 'vulgar.'" *Id.* (citing *In re*

Boulevard Entm't, Inc., 334 F.3d 1336, 1340 (Fed. Cir. 2003)). Vulgar marks are those "lacking in taste, indelicate, [and] morally crude." *In re Brunetti*, 877 F.3d at 1336. The PTO must make its determination as to whether a mark is scandalous "in the context of contemporary attitudes" and "in the context of the marketplace as applied to only the goods described in the application." *Fox*, 702 F.3d at 635 (internal quotation marks and alterations omitted).

How a lone PTO examiner is supposed to measure "a substantial composite of the general public," or assess these various standards of decency and disgrace, is never articulated, nor could it be. It is no surprise, then, that "the Trademark Trial and Appeal Board has itself noted the vague and subjective nature of the scandalous inquiry." *In re Brunetti*, 877 F.3d at 1354 (citing *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) ("the guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one" (internal quotations and citations omitted))).

The real-world experience of INTA members confirms that the statute is a meaningless mess that cannot be rescued from its First Amendment failings:

- Nearly identical marks have been approved by one examining attorney and rejected as scandalous or immoral by another. *Compare, e.g.*, GOT MILF, Reg. No. 5,451,844 (registered for women's lifestyle blogs), *with* FROM SOCCER MOM TO MILF, App. Ser. No. 77/686,422 (filed Mar. 9, 2009) (application for self-help books for women refused

on grounds that mark was immoral or scandalous); CUM TOGETHER, Reg. No. 2,844,606 (registered for adult content but later expired for failure to renew) *with* YOU CUM LIKE A GIRL, App. Ser. No. 78/682,282 (filed Aug. 6, 2005) (application for tank tops and lingerie refused on grounds that mark was immoral or scandalous); and BOX-O-COCKS, Reg. No. 5,605,526 (registered for online novelty store), *with* COCK IN SOCK, App. Ser. No. 86/612,223 (filed Apr. 28, 2015) (application for adult sexual aid refused on grounds that mark was immoral or scandalous).

- Further examples are legion. *Compare, e.g.*, DICK-TEEZ, Reg. No. 5,351,420 (registered for clothing), *with* DICK SOCK, App. Ser. No. 86/459,649 (filed Nov. 20, 2014) (application for t-shirts refused on grounds that mark was immoral or scandalous); and BUZZED BEAVER, Reg. No. 4,812,818 (registered for liqueurs), *with* BEAVER SHOT, App. Ser. No. 85/619,824 (filed May 8, 2012) (application for energy drinks refused on grounds that mark was immoral or scandalous).

- As the Federal Circuit noted in *In re Brunetti*, the PTO has even been inconsistent with marks that reference the indisputably vulgar term "fuck," like the mark at issue here. 877 F.3d at 1354. The PTO registered the mark FCUK, Reg. No. 5,301,912 (registered for clothing), but rejected the marks FUCT, App. Ser. No. 85/310,960 (filed May 3, 2011) (for clothing) and F**K PROJECT, App. Ser. No. 79/141,996 (filed Oct. 18, 2013) (for leather goods), as scandalous.

- Derivatives of "fuck" likewise have met inexplicably different fates. It allowed the registration of MUTHA EFFIN BINGO, Reg. No. 4,183,272 (registered for restaurant services but later expired for failure to renew), and IF WE TOUCH IT, IT'S FN GOLDEN, Reg. No. 4,100,978 (registered for film production but later expired for failure to renew), but not F ALL F'S APPAREL FOR THE F'N ANGRY, App. Ser. No. 78/420,315 (filed May 17, 2004) (for clothing).

Countless words are innocuous in some contexts and provocative (sexually or otherwise) in other contexts. Ass, balls, beaver, boob, cock, dick, hump, or pussy are but a few examples. Yet the lines between an innocent usage, a permissible double entendre, and a usage so provocative as to be denied registration are so vague that they may as well be invisible. It is difficult to avoid the conclusion that examiners and their supervisors are simply left to make their own subjective determinations as to whether a mark is "immoral ... or scandalous." This total lack of authoritative construction of the statute is the opposite of constitutional. *See Dombrowski v. Pfister*, 380 U.S. 479, 490-91 (1965) (fatal vagueness can be avoided by "authoritative constructions [that] sufficiently illuminat[e] the contours of [the] otherwise vague prohibition.").[6]

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6. INTA acknowledges that individual PTO examiners are supposed to consult with their supervisors before determining that a proposed mark is immoral or scandalous. *See* TMEP § 1203.01. As demonstrated by the examples of inconsistent results noted above, this consultation process does nothing to solve the inherent subjectivity of the PTO's decision of whether a particular mark is impermissibly scandalous or immoral.

Accordingly, even if the Court assumes that the protection of the general public and the channels of commerce are legitimate purposes in the *Central Hudson* analysis, Section 2(a) plainly fails to advance those purported interests.

3. The Immoral Or Scandalous Provision Is Not Narrowly Tailored To Achieve The Desired Objective

Section 2(a) also fails the final *Central Hudson* prong, which commands that the restriction on speech be "no[] more extensive than necessary to serve the interests that support it." *Greater New Orleans Broad. Ass'n*, 527 U.S. at 188. Section 2(a) is facially overbroad: As noted above, the statutory language sweeps broadly enough to prevent registration of an enormous number of words that merely have a *potentially* sexual, excretory, or otherwise offensive meaning in a given context.

The PTO's approach to determining immorality or scandalousness does nothing to cure the overbreadth, nor could it. As noted above, PTO examiners and supervisors essentially are left to their own devices: In a word, the process is subjective. Determinations of immorality and scandalousness are very different from other determinations that examiners must make, in areas where their training and the objective nature of the evidence will control. *See e.g.*, 15 U.S.C. § 1052(a) (refusal of mark on basis of deceptiveness); 15 U.S.C. § 1052(d) (refusal of mark on basis of likelihood of confusion); 15 U.S.C. § 1052(e)(1) (refusal of mark that is merely descriptive); 15 U.S.C. § 1052(e)(2) (refusal of mark on basis of geographic significance).

The analysis required by the immoral or scandalous provision of Section 2(a), in contrast, does not fall within any civil servant's expertise. Whether a trademark is so "immoral" or "scandalous" that it should be disadvantaged in the marketplace is instead best decided by consumers voting with their wallets. As the Court has stated, "[a]t the heart of the First Amendment lies the principle that each person should decide for himself or herself the ideas and beliefs deserving of expression. . . . Our political system and cultural life rest upon this ideal." *Turner Broad. Sys., Inc.*, 512 U.S. at 641.

Given the "highly subjective" nature of the immoral or scandalous provision, the government fails the requirement under *Central Hudson* that any limitation on commercial speech be narrowly tailored. Importantly, invalidation of the immoral or scandalous provision in Section 2(a) does not deprive the government of all authority in this area. Congress still would be free to enact restrictions on trademark registration that are carefully targeted to address the few categories of speech where First Amendment protection is weakest or nonexistent. *See Ashcroft v. Free Speech Coalition*, 535 U.S. 234, 245-46 (2002) ("The freedom of speech has its limits; it does not embrace certain categories of speech, including defamation, incitement, obscenity, and pornography produced with real children.").

II. The Immoral Or Scandalous Provision Also Is Void For Vagueness

The vagueness of the immoral or scandalous provision in Section 2(a) also warrants a ruling that the provision is unconstitutionally vague. The Court has made clear that

a regulation of speech "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 871-72 (1997) (statute criminalizing transmission of "indecent" or "patently offensive" information over the internet to minors facially unconstitutional under the First Amendment) (citations omitted); *see also F.C.C. v. Fox Television Stations, Inc.*, 567 U.S. 239, 253-54 (2012) ("When speech is involved, rigorous adherence to [due process concerns] is necessary to ensure that ambiguity does not chill protected speech."). Indeed, "this requirement of clarity in regulation . . . requires the invalidation of laws that are impermissibly vague." *Fox Television Stations*, 567 U.S. at 253.

The test is simple: Where a statute fails to provide "a person of ordinary intelligence [with] fair notice of what is prohibited, or is so standardless that it authorizes or encourages seriously discriminatory enforcement," it is void for vagueness. *United States v. Williams*, 553 U.S. 285, 304 (2008). That the immoral or scandalous provision fails this test, just as it fails intermediate scrutiny, is plain from the discussion in Section I above.

This vagueness has severe consequences in the real world, especially for small business owners. A recent law review article confirmed that small businesses are disproportionately harmed by the current regime. *See* Carpenter & Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L. J. 321 (2015). The authors conducted an in-depth review of trademark applications for marks containing the words "bitch," "pothead," "shit," "slut" and "whore." They found that, with the exception of "shit," the PTO had

inconsistently registered marks containing each of these terms as a primary feature. *Id.* at 359. Small businesses, unlike large brand owners, often lack the resources to pursue an extended trademark prosecution, much less the arduous appeals process. *See id.* at 364 (noting that small business applicants frequently subjected to rejection under the immoral or scandalous provision were *pro se* and unlikely to respond to refusals). Frequently, an applicant abandons its trademark application once the examining attorney issues an office action rejecting a mark on "immoral ... or scandalous" grounds. *Id.* at 347 (noting that there was no response to office actions in 80% of rejections studied).

The Carpenter and Garner study underscores the practical need to strike down this unconstitutional law. As it currently stands, the immoral or scandalous provision leaves trademark owners to guess whether an investment in developing a particular mark is worthwhile, and disproportionately affects small business owners. By striking the provision, this Court will help to put businesses of all sizes on a level playing field.

III. The Trademark Registration System Is Not A Government Subsidy That Entitles The Government To Engage In Viewpoint Discrimination

A. Trademark Registration Does Not Implicate Congress's Powers To Spend Or Control Government Property

The Constitution's Spending Clause gives Congress broad discretion to tax and spend for the "general Welfare," including funding particular state or private

programs and activities. *See Agency for Int'l Development v. Alliance for Open Society Int'l, Inc.*, 570 U.S. 205, 213 (2013). The Court has recognized that Congress may impose conditions on the receipt of federal funds, even if such conditions "affect the recipient's exercise of its First Amendment rights," but may not "seek to leverage funding to regulate speech outside the contours of the program itself." *Id.* at 214-15. Although deciding how to categorize a particular restriction may be challenging, as in *Tam*, "no difficult question is presented" here because the trademark registration system does not implicate the Spending Clause. *See Tam*, 137 S. Ct.at 1761 (Alito, J., concurring).

As Justice Alito's plurality opinion in *Tam* recognized, the Court's cases upholding the constitutionality of government programs that impose restrictions on speech have involved either direct cash subsidies or the equivalent. *See, e.g., United States v. Am. Library Ass'n, Inc.*, 539 U.S. 194 (2003) (conditioning funding for libraries on the installation of filtering software did not violate First Amendment); *Nat'l Endowment for Arts v. Finley*, 524 U.S. 569 (1998) (statute requiring National Endowment for the Arts to consider, among other things, "general standards of decency and respect," in judging grant applications did not violate First Amendment); *Rust v. Sullivan*, 500 U.S. 173 (1991) (upholding as constitutional regulations prohibiting recipients of family planning funds from engaging in abortion-related services); *see also In re Brunetti*, 877 F.3d at 1345 ("[t]he Supreme Court has never extended the subsidy doctrine to situations not involving financial benefits" (quoting *Autor v. Pritzker*, 740 F.3d 176, 183 (D.C. Cir. 2014)).

In contrast, the trademark registration system "is nothing like the programs at issue in" the Court's government subsidy cases. *See Tam*, 137 S. Ct. at 1761 (Alito, J., concurring). As the Court's plurality decision in *Tam* correctly recognized, the trademark registration system actually involves the opposite of a government subsidy, namely the payment of money to the federal government, rather than by the federal government. *See id.*; *In re Brunetti*, 877 F.3d at 1344. In particular, an applicant must pay the U.S. Patent and Trademark Office an initial fee of $225-$600 when the application is filed, and once the registration issues the owner must pay an additional fee of $300-$500 every ten years to maintain it. *Tam*, 137 S. Ct. at 1761 (Alito, J., concurring). Since 1991, the fees paid by applicants and registrants have fully funded the direct operating expenses associated with the federal trademark registration system. *See id.*; *In re Brunetti*, 877 F.3d at 1344 (citing 35 U.S.C. § 42(c)(1)).

Because the trademark registration system does not implicate the federal government's power to spend or control government property, the Spending Clause cannot justify the rejection of supposedly "immoral ... or scandalous" trademarks under Section 2(a) of the Lanham Act.

B. Under The Government's Position, Any Government Registration Program, Including That For Copyrights, Would Provide The Government With Censorship Rights

The Government argues vainly, as it did in *Tam*, that the government subsidy cases are "not limited to circumstances involving the direct provision of government

money or control over physical property." Government Brief at 41. In support of this argument, it asserts that Justice Alito's plurality opinion in *Tam*, analyzing the Court's decisions in *Davenport v. Washington Ed. Ass'n*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Ed. Ass'n*, 555 U.S. 353 (2009), confirmed that the Federal Circuit erred "in treating precedents related to government programs as limited to Spending Clause legislation or physical property." Government Brief at 43. The Government's reliance on the plurality decision in *Tam* is mistaken, for several reasons.

First, the plurality in *Tam* expressly concluded that *Davenport* and *Ysursa* provided no support for the Government's position because they are wholly irrelevant to the trademark registration system. *Tam*, 137 S. Ct. at 1762 (Alito, J., concurring). As Justice Alito explained in *Tam*, those two decisions involved "a special area of First Amendment case law" that is "far removed" from the trademark registration system and no more relevant than are the government subsidy cases. *Tam*, 137 S. Ct. at 1761-62, 1762 n.15 (Alito, J., concurring). In particular, they involved situations where a state government provided unions with a significant non-cash benefit (the right to have public employers collect agency fees from employees and remit those fees to the union) but refrained from providing an even greater benefit (the right to collect dues for use in connection with election or political action committee activities), thus choosing to promote some activities but not others. *Id.* at 1762. No such non-cash benefit is at issue with respect to the trademark registration system, where the activities in question are funded by the applicants and registration owners. *In re Brunetti*, 877 F.3d at 1344.

Moreover, as the Court noted in both *Davenport* and *Ysursa*, unions have no constitutional right under the First Amendment in government assistance for the collection of fees for election or political activities. *See* 551 U.S. at 189-90; 555 U.S. at 359. That is very different from the situation here, where First Amendment rights are unambiguously implicated. *See Tam*, 137 S. Ct. at 1760 (finding trademarks are private speech and thus subject to First Amendment protection).

Second, setting aside *Davenport* and *Ysursa*, the Government's argument that the Spending Clause applies to registration systems even where there is no direct government spending ignores the fact that virtually every government service, including other government registration schemes such as the federal copyright registration system, involves the expenditure of government funds. *Id.* at 1761. As the Court noted in *Tam*, there is no principled basis for treating copyrights differently from trademarks. *Id.* at 1760, *aff'g In re Tam*, 808 F.3d 1321, 1346 (Fed. Cir. 2015) (noting that "[c]opyright registration has identical accoutrements" to trademark registration). Thus, under the Government's approach, every registration system, including the copyright system, also would be subject to government censorship.

That is not the law. As the Court expressly recognized in *Agency for International Development*, even where the government *is* expending resources, which even the Government does not argue is the case here, Congressional authority under the Spending Clause is not unlimited and does not justify every government restriction on First Amendment rights. *See* 570 U.S. at 214. Because

the Government's argument recognizes no limitation on government censorship, it is untenable and should be rejected here just as it was in *Tam*.

CONCLUSION

For the foregoing reasons, the Court should affirm on the basis that trademarks are commercial speech, that governmental regulations thereof are subject to intermediate scrutiny, and that the immoral or scandalous provision of Section 2(a) of the Lanham Act is unconstitutional by that standard.

March 25, 2019

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IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter." The question presented is as follows:

Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

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STATEMENT OF INTEREST OF *AMICUS CURIAE*

This amicus curiae brief is submitted on behalf of the New York Intellectual Property Law Association ("the NYIPLA"). The NYIPLA is a professional membership association of approximately 1,000 attorneys in the New York City metropolitan area whose interests and practices lie in the areas of patent, trademark, copyright, trade secret, and other intellectual property law.[1]

The NYIPLA's members include a diverse array of attorneys specializing in trademark law, including in-house counsel for businesses that own, license, enforce, and challenge trademarks, as well as attorneys in private practice who advise a wide array of clients on trademark matters, including trademark licensing, and procurement of trademark registrations through the U.S. Patent and Trademark Office ("USPTO"). Many of the NYIPLA's member attorneys participate actively in trademark litigation, representing both owners and alleged infringers. The NYIPLA, its members, and the clients of its members, share an interest in having reasonably clear and predictable standards governing the registration of trademarks.

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1. Consent of all parties has been provided for the NYIPLA to file this brief. Petitioner and Respondent provided consent to the filing of this *amicus curiae* brief in support of neither party in communications dated February 19, 2019 and February 12, 2019 respectively. No party's counsel authored this brief in whole or in part. No party, or party's counsel, contributed money that was intended to fund the preparation or submission of this brief. No person other than amicus curiae, its members, or its counsel contributed money that was intended to fund the preparation or submission of this brief.

The arguments in this brief were approved on February 25, 2019 by an absolute majority of the total number of officers and members of the Board of the NYIPLA (including such officers and Board members who did not vote for any reason including recusal), but do not necessarily reflect the views of a majority of the members of the NYIPLA or of the firms or other entities with which those members are associated.

After reasonable investigation, the NYIPLA believes that no member of the Board or Amicus Briefs Committee who voted to prepare this brief on its behalf, or any attorney in the law firm or corporation of such a Board or Committee member, or attorney who aided in preparing this brief, represents either party to this litigation. Some Committee or Board members or attorneys in their respective law firms or corporations may represent entities that have an interest in other matters which may be affected by the outcome of this litigation.

SUMMARY OF ARGUMENT

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter" (the "scandalous provision"). The scandalous provision prohibits the registration of trademarks that "give offense" or, as articulated in the test employed by USPTO examining attorneys, trademarks that a "substantial composite of the general public [would find] *offensive* to the conscious or moral feelings." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (emphasis added).

At issue here is whether the scandalous provision of Section 2(a) is constitutional or whether it is facially invalid under the Free Speech Clause of the First Amendment. NYIPLA respectfully submits this *amicus* brief to address two important trademark-related issues inherent in this Court's determination of the merits of the question presented.

First, NYIPLA submits that Section 2(a)'s scandalous provision restricts registration based on viewpoint, because the inclusion of potentially offensive content in a publicly used mark is a form of viewpoint expression.

In *Matal v. Tam*, 137 S. Ct. 1744 (2017), this Court held that Section 2(a)'s provision refusing registration of disparaging marks was invalid under the First Amendment. Justice Alito, in the portion of his opinion joined by Chief Justice Roberts, Justice Thomas, and Justice Breyer, stated that "giving offense is a viewpoint." 137 S. Ct. at 1763. Similarly, Justice Kennedy's concurrence, which was joined by Justice Ginsburg, Justice Sotomayor, and Justice Kagan, distinguished from other content-based speech burdens those "based on viewpoint, *including a regulation that targets speech for its offensiveness*", stating that the latter "remains of serious concern even in the commercial context." 137 S. Ct. at 1767 (emphasis added). Section 2(a)'s prohibition on registration of scandalous trademarks similarly targets marks for their perceived offensiveness and therefore restricts speech on the basis of viewpoint under the reasoning of *Tam* and this Court's First Amendment precedents.

Second, NYIPLA submits that, just as marks that are not registered can be protected, marks denied registration

under the immoral or scandalous provision of Section 2(a) remain enforceable under Section 43(a) of the Lanham Act if other requirements for protection under the common law are met. While *Tam* acknowledged that "even if a trademark is not federally registered, it may still be enforceable under § 43(a) of the Lanham Act," *Tam* did not resolve the issue of whether marks deemed *unregistrable* under the disparagement provision of Section 2(a) remain enforceable. In *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1995), this Court stated that Section 43(a) of the Lanham Act "protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are, for the most part, applicable in determining whether an unregistered mark is entitled to protection under § 43(a)" (citation omitted). Some courts have read this statement to imply that an entity whose trademark application is denied under Section 2(a) may not invoke Section 43(a) to enforce its mark because the mark has been deemed "unregistrable" matter. *See, e.g., In re Tam*, 808 F.3d 1321, 1344 n.11 (Fed. Cir. 2015) (en banc), *aff'd on other grounds, Matal v. Tam*, 137 S. Ct. 1744 (2017).

The Lanham Act and *Two Pesos* do not support this interpretation. In the event that this Court upholds the constitutionality of the scandalous provision, NYIPLA respectfully requests that the Court clarify that its statements in *Two Pesos* should not be read to preclude the owners of common law marks from availing themselves of Section 43(a) even if the USPTO denied an application for the mark at issue based on the scandalous provision.

BACKGROUND

I. IN THE U.S. PATENT AND TRADEMARK OFFICE

Erik Brunetti, the director and founder of the clothing brand "FUCT," filed a trademark application with the USPTO to register FUCT in connection with "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; children's and infant's apparel, namely jumpers overall sleepwear, pajamas, rompers, and one-piece garments."

In January 2013, the USPTO issued a final rejection of the application on the grounds that, under Section 2(a), the mark consisted of immoral or scandalous matter. Thereafter, Brunetti requested reconsideration of the final rejection, and also appealed to the Trademark Trial and Appeal Board ("TTAB"). The USPTO denied the request for reconsideration and the TTAB affirmed the USPTO's final rejection reasoning:

> It is abundantly clear that the Trademark Trial and Appeal Board is not the appropriate forum for re-evaluating the impacts of any evolving First Amendment jurisprudence within Article III courts upon determinations under Section 2(a) of the Lanham Act, or for answering the Constitutional arguments of legal commentators or blog critics.

In re Brunetti, Serial No. 85/310,960, 12 (T.T.A.B. August 1, 2014).

II. IN THE FEDERAL CIRCUIT

In September 2014, Brunetti appealed the TTAB's decision directly to the Court of Appeals for the Federal Circuit ("Federal Circuit"). *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017). The Federal Circuit affirmed the TTAB's decision, finding that there was substantial evidence supporting the TTAB's holding that the FUCT mark "comprise[d] immoral or scandalous matter." *Id* at 1337. The court also concluded "that § 2(a)'s bar on registering immoral or scandalous marks is an unconstitutional restriction of free speech" and therefore "reverse[d] the Board's holding that Mr. Brunetti's mark is unregistrable." *Id* at 1357.

Following this Court's decision in *Tam*, the Federal Circuit requested additional briefing on *Tam*'s effect on the *Brunetti* case. In its brief, the government contended that "*Tam* does not resolve the constitutionality of §2(a)'s bar on registering immoral or scandalous marks because the disparagement provision implicates viewpoint discrimination, whereas the immoral provision is viewpoint neutral." *Id.* at 1341.

The Federal Circuit questioned the government's position on "the viewpoint neutrality of the immoral or scandalous provision," but found that it "need not resolve that issue" because "[i]ndependent of whether the immoral or scandalous provision is viewpoint discriminatory . . . the provision impermissibly discriminates based on content in violation of the First Amendment." *Id.* at 1341.

Following the decision, the government filed a petition for rehearing *en banc*, which the Federal Circuit denied on

April 12, 2018. Thereafter, the government filed a petition for writ of certiorari to this Court which was granted on January 4, 2019.

ARGUMENT

I. SECTION 2(A)'S "SCANDALOUS" PROVISION TARGETS SPEECH BASED ON VIEWPOINT

Like the disparagement provision held unconstitutional in *Tam*, Section 2(a)'s scandalous provision restricts speech based on viewpoint and, as a result, is presumptively unconstitutional.

A. Viewpoint Discrimination Is An Egregious Form Of Content Discrimination

Regulation of speech that is targeted at specific subject matter is content-based regulation even if the regulation does not discriminate among viewpoints within that subject matter. *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015). It is well settled that "[t]he First Amendment's hostility to content-based regulation extends not only to restrictions on particular viewpoints, but also to prohibition of public discussion of an entire topic." *Consolidated Edison Co. v. Public Service Comm'n*, 447 U.S. 530, 537 (1980).

Government discrimination among viewpoints is a "more blatant" and "egregious form of content discrimination." *Reed*, 135 S. Ct. at 2230 (citing *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995)). The government must abstain from regulating speech when the specific motivating ideology, or the

opinion or perspective of the speaker, is the rationale for the restriction. *Perry Ed. Assn.* v. *Perry Local Educators' Assn.*, 460 U.S. 37, 46 (1983).

A law that discriminates based on viewpoint is presumptively unconstitutional. *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (citing *Rosenberger*, 515 U.S. at 829-30). In that connection, laws which discriminate based on content - - including laws that discriminate based on viewpoint - - are subject to strict scrutiny and, as a result, "may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed*, 135 S. Ct. at 2226.

This Court has uniformly declared unconstitutional those laws that discriminate based on viewpoint. *Goods News Club v. Milford Cent. Sch.*, 533 U.S. 98, 120 (2001) ("When [the school district] denied [a Club] access to the school's limited public forum on the ground that the Club was religious in nature, it discriminated against the Club because of its religious viewpoint in violation of the Free Speech Clause of the First Amendment."); *Lamb's Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 394 (1993) ("... the First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others.").

B. The "Scandalous" Provision Discriminates Based On Viewpoint

Section 2(a)'s scandalous provision prohibits the registration of trademarks that "[c]onsist of or comprise immoral, deceptive, or scandalous matter." 15 U.S.C. § 1052(a). To demonstrate that a trademark consists of, or

otherwise comprises, immoral or scandalous matter, the U.S. Patent and Trademark Office must show that the trademark is:

> . . . shocking to the sense of truth, decency, or propriety; disgraceful; *offensive*; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.

In re Mavety Media Grp. Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (citing *In re Riverbank Canning Co.*, 25 C.C.P.A. 1028 (CCPA 1938) (emphasis added)).

In *Tam*, this Court held that Section 2(a)'s prohibition on "disparage[ing]" trademarks was an unconstitutional restriction on speech. All eight Justices saw the provision as restricting speech based on "viewpoint" under this Court's First Amendment precedents. *Tam*, 137 S. Ct. at 1766 (Alito, J.,); *id.* at 1767 (Kennedy, J., concurring). As Justice Kennedy noted, a "law found to discriminate based on viewpoint is an 'egregious form of content discrimination,' which is 'presumptively unconstitutional.'" *Id.* at 1766 (quoting *Rosenberger*, 515 U.S. at 829-30 (1995)).

As Justice Alito pointed out, Section 2(a)'s "disparage" provision "evenhandedly prohibits disparagement of all groups" and in that sense was not discriminatory. *Id.* at 1763. Nevertheless, both concurring opinions in *Tam* recognized that whether a trademark "gives offense" *is itself a viewpoint*. *Id.* at 1763 ("But in the sense relevant here, that is viewpoint discrimination: *Giving offense is a viewpoint.*") (emphasis added); *Id.* at 1766 (with respect to the disparagement clause, "[t]he law thus reflects the Government's disapproval of a subset of messages *it finds*

offensive. This is the essence of viewpoint discrimination.") (emphasis added).

Like the "disparage" provision, Section 2(a)'s "scandalous" provision denies registration to marks that give offense. In fact, the test employed by the USPTO for determining whether a mark is scandalous is whether, from the viewpoint of members of the public, a trademark "gives offense:"

> from the standpoint of not necessarily a majority, but a substantial composite of the general public.

In re Fox, 702 F.3d at 635 (citing *Mavety*, 33 F.3d at 1371).

So, if from the point of view of a substantial composite of the public, a trademark is offensive, the USPTO chooses the viewpoint of one segment of the public over the other. This is the very essence of viewpoint discrimination:

> . . . the test for viewpoint discrimination is whether . . . the government has singled out a subset of messages for disfavor based on the views expressed.

Tam, 137 S. Ct. at 1766 (citing *Cornelius v. NAACP Legal Defense & Ed. Fund, Inc.*, 473 U.S. 788, 806 (1985)).

Like the disparage provision at issue in *Tam*, the scandalous provision discriminates based on viewpoint. This is because it authorizes the government to "single out" a subset of messages - - that is, offensive trademarks - - and to express its disfavor of such trademarks by barring

them from federal trademark registration merely because an offensive viewpoint is conveyed by the trademark.

This conclusion is entirely consistent with one of the bedrock First Amendment principles: the government may not restrict or otherwise prohibit the expression of an idea because society finds it offensive. *Texas v. Johnson*, 491 U.S. 397, 414 (1989). The problem with such a restriction or prohibition was best summarized by Justice Harlan:

> For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual.

Cohen v. California, 403 U.S. 15, 26 (1971).

II. IF THE COURT FINDS THE "SCANDALOUS" PROVISION OF SECTION 2(A) TO BE CONSTITUTIONAL, THIS COURT SHOULD CLARIFY WHETHER AN APPLICANT WHO HAS BEEN DENIED FEDERAL REGISTRATION ON THE BASIS OF THAT PROVISION IN SECTION 2(A) MAY NEVERTHELESS INVOKE PROTECTION UNDER SECTION 43(A)

Section 43(a) of the Lanham Act is clear that a plaintiff need not have a registration to bring a civil action based on another's use of a confusingly similar mark. *See Wal-*

Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000). Specifically, Section 43(a) permits a civil action to be brought by "any person who believes that he or she is or is likely to be damaged by" the actions of another "who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin" which "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S.C. § 1125(a).

In the opinion below, the Federal Circuit did not address whether the owner of a mark that has been rejected by the USPTO on scandalous grounds under Section 2(a) is entitled to invoke the protections of Section 43(a). *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017). The Federal Circuit's opinion in *Tam* suggests that the law is not clear regarding Section 43(a)'s protection of marks deemed unregistrable under Section 2(a). *In re Tam*, 808 F.3d at 1344 n.11 (Fed. Cir. 2015). Judge Moore's *en banc* opinion notes that "the government has not pointed to a single case where the common-law holder of a disparaging mark was able to enforce that mark, nor could [the Federal Circuit] find one." *Id.* at 1344.

This Court in *Tam* generally discussed the Section 43(a) issue in the context of disparaging marks. The *Tam* Court ultimately did not decide "whether respondent could bring suit under § 43(a) if his application for federal registration had been lawfully denied under the disparagement clause." *Tam*, 137 S. Ct. at 1752 n.1.

Judge Moore's footnote in the Federal Circuit's *Tam* decision suggests that the dearth of case law tends to support the conclusion that Section 43(a) is only available for marks that are registrable under Section 2. *See* 308 F.3d at 1344 n.11 (citing *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1995); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987); *Renna v. Cty. of Union*, 88 F. Supp. 3d 310, 320 (D.N.J. 2014)). Thus, Judge Moore's footnote raises a question as to whether registrable matter under Section 2(a) is a prerequisite for Lanham Act protection of an unregistered mark. *See id.* In other words, if "any word, term, name, symbol or device" as described in Section 43(a) is deemed not entitled to registration because it is scandalous, can the owner nevertheless enforce its common law rights against others using similar marks that are likely to cause consumer confusion, mistake or deception, or does the unregistrable status deprive the owner of the potential Section 43(a) claim?

Nothing in the statute or case law prevents the owner of a mark that has been rejected on Section 2(a) scandalous grounds from availing itself of Section 43(a). If the Court deems the scandalous provision of Section 2(a) to be constitutional, NYIPLA believes it is important for the Court to clarify that, if the USPTO denies registration under that provision of Section 2(a), such denial should not, in and of itself, preclude a claim under Section 43(a) if a mark is otherwise protectable and enforceable under common law.

A. The Legislative History Supports That Section 43(a) Was Intended To Apply Broadly Even To Marks Not Entitled To Federal Trademark Registration

Section 43(a) provides individuals with a federal cause of action to enforce common law trademark rights arising under unregistered marks, *see, e.g., Patsy's Italian Rest. v. Banas*, 658 F.3d 254, 267 (2d Cir. 2011) and serves the primary function of deterring consumer confusion. *See EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos Inc.*, 228 F.3d 56, 61 (2d Cir. 2000). In 1988, Congress amended Section 43(a) to "codify the law laid down by [the] Federal courts," 134 Cong. Rec. S5864-02 (May 13, 1988) (statement of Sen. Grassley), which "had expanded the [S]ection beyond its original language in 1946," *Two Pesos*, 505 U.S. at 783 (Stevens, J., concurring). *See also, e.g., Warner Bros. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981) (noting that Section 43(a) "should be interpreted and applied broadly so as to effectuate its remedial purpose"). In so doing, and in line with the federal courts' then trend to permit "a broad class of suitors . . . likely to be injured by such wrong" to enforce their trademarks without registration, Congress' intention was to "create, in essence, a federal law of unfair competition." *Two Pesos*, 505 U.S. at 783 (Stevens, J., concurring) (quoting The United States Trademark Ass'n Trademark Review Comm. Report and Recommendations to USTA President and Board of Directors, 77 Trademark Rep. 375, 426 (1987)).

Given this expansive purpose of Section 43(a), it follows that independent of federal registration, a trademark owner should be permitted to prevent and

enjoin "any word, term, name, symbol or device" or "any false designation of origin likely to cause confusion" as to source or origin. 15 U.S.C. § 1125(a); *see also* 134 Cong. Rec. S5864-02 (May 13, 1988) (amending Section 43(a) from creating liability for "a" false designation of origin to creating liability for "any" false designation of origin). Whether the USPTO has denied an application on the basis that the mark "may be scandalous" is irrelevant to the analysis of whether the mark owner is able to utilize Section 43(a) to prevent a defendant's use of a mark that is likely to cause consumer confusion, mistake or deception as to source or origin of it goods. As a result, the Court should clarify that Section 43(a) may be invoked by the owner of any otherwise enforceable common law mark regardless of whether that mark was deemed unregistrable by the USPTO.

B. This Court's Statement In *Two Pesos* Does Not Preclude Availability Of Section 43(a) To Marks Refused Under Section 2(a)

To support its suggestion that Section 43(a) may not be available to an owner of a mark that the USPTO has deemed disparaging, the Federal Circuit in *Tam* relied on a statement from this Court in *Two Pesos*. *Tam*, 808 F.3d at 1344 n.11. In *Two Pesos*, this Court recognized that "it is common ground that §43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." 505 U.S. at 768; *Wal-Mart Stores, Inc.*, 529 U.S. at 210 (quoting the same phrase from *Two Pesos*). Other courts have also interpreted *Two Pesos* in a similar

fashion as the Federal Circuit. *See Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 128 (2d Cir. 2009) (citing *Two Pesos* for the proposition that "Section 43(a) of the Lanham Act protects unregistered trademarks as long *as the mark could qualify for registration* under the Lanham Act." (emphasis added)).

The Court in *Two Pesos* was not considering Section 2(a) or the other bars to registration in Section 2. Nor did the Court even address the registrability of the restaurant trade dress at issue in that case. Instead, the issue determined was whether the trade dress could be protected as inherently distinctive or whether secondary meaning was required. The NYIPLA respectfully submits that this passage from *Two Pesos* does not support using Section 2(a) to limit Section 43(a), but rather concerns only the issue of the overriding concern of the initial phrase in Section 2 to the effect that to qualify for protection, trademarks must distinguish the mark owner's goods from the goods of others. The use of "qualifying" in the quote "§43(a) protects *qualifying* unregistered trademarks" relates only to whether the mark operates as a trademark, i.e., whether it is capable of distinguishing the source of goods or services. *See id.* at 768. This interpretation is consistent with limits in the quoted statement from *Two Pesos*, which refer to "general principles" for registration that are applicable "for the most part" in determining whether an unregistered mark is entitled to Section 43(a) protection. *Cf. In re City of Houston*, 731 F.3d 1326, 1331 (Fed. Cir. 2013) ("We note that Houston has other means to prevent 'pirates and cheats' from using its city seal to deceive the public, [notwithstanding its rejection for federal registration under § 2(b)]. . . . Other legal protections under the Lanham Act may exist as well. *See*

15 U.S.C. § 1125."); *Bros. of Wheel M.C. Exec. Council, Inc. v. Mollohan*, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) ("As noted earlier, the flag contained within the plaintiff's mark does not violate USPTO guidelines [under § 2(b), but] even if it did, unregistered marks are protected under Section 43(a).").

While the Court in *Two Pesos* generally discussed Section 2 and Section 43(a), it did so only in the context of assessing requirements for establishing distinctiveness – that is, the mark's ability to distinguish the goods of the owner from those of others. The Court was asked to decide only whether a plaintiff with unregistered trade dress for its restaurant could sue a potential infringer for infringement under Section 43(a) if plaintiff's trade dress was found to be inherently distinctive but without secondary meaning. *See id.* at 765. The jury and the lower courts found that the trade dress was not descriptive, was inherently distinctive, and that it was not functional and those findings were not before the Court. The only issue was whether the jury's finding that the trade dress had no secondary meaning disqualified the trade dress from protection under Section 43(a), when the jury also found that the trade dress was inherently distinctive. The Court held that trade dress that is "inherently distinctive" is protectable without secondary meaning, because that trade dress is "capable of distinguishing the goods of the users of these marks." *Id.* at 772.

Clearly, a mark may well be capable of distinguishing the source of goods or services even if the mark conveys a message that "may be scandalous." Importantly, there is no language or suggestion in either *Two Pesos* or the legislative history of Section 43(a) that tethers Section

43(a) to any determination by the USPTO unrelated to the ability of the mark to function as a trademark. *See* 100 Cong. Rec. S16973 (Oct. 20, 1988). Rather, Section 43(a) serves to provide a brand owner who has not received a federal registration the ability to enforce its trademark against another who is using a mark likely to cause confusion. *See Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (finding that "the descriptive nature of a literary title does not mean [ ] that such a title cannot receive protection under § 43(a)"); *Orient Exp. Trading Co. v. Federated Dep't Stores, Inc.*, 842 F.2d 650, 654 (2d Cir. 1988) ("Even if appellants' registered marks are cancelled, . . . the use of the [disputed] name . . . could still be protected from unfair competition under section 43(a) of the Lanham Act."); *Walt-W. Enters. v. Gannett Co.*, 695 F.2d 1050, 1054 n.6 (7th Cir. 1982) ("Although trade names . . . are not registrable under the Lanham Act, an action for trade name infringement is nonetheless proper under 15 U.S.C. § 1125(a)." (citation omitted)).

C. The Purpose Of Section 43(a) Supports That *Two Pesos* Should Not Limit Section 43(a)'s Availability By "Registrability" Under Section 2(a)

"The purpose of [Section 43(a) of the Lanham Act] is to prevent consumer confusion regarding a product's source and to enable those that fashion a product to differentiate it from others on the market." *EMI Catalogue P'ship*, 228 F.3d at 61 (internal quotation marks omitted). On the other hand, the purpose of Section 2(a) is not to address consumer confusion, but rather to codify a statutory prerogative to refuse federal registration to certain marks such as those whose "meaning may be disparaging to *a*

substantial composite of the referenced group." *In re Lebanese Arak Corp.*, 94 U.S.Q.P.2d 1215, 1217 (T.T.A.B. 2010) (emphasis added). "Whether marks comprise immoral or scandalous subject matter hinges on the expressive, not source-identifying, nature of trademarks." *In re Brunetti*, 877 F.3d at 1349. This test for whether a mark is scandalous is thus made against a factual record of the mark's meaning to a composite group of persons, without regard to the mark's ability to distinguish the applicant's goods from those of others and thereby serve as a source identifier. The preamble of Section 2 states "[n] o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration unless," 15 U.S.C. § 1052, and thus reflects Congress' intent and purpose that a mark which may in fact distinguish the owner's goods from goods of others may nevertheless be refused for reasons wholly unrelated to the mark's ability to distinguish and identify source.

The NYIPLA believes that when placed in this context and as necessarily limited by the issues decided in *Two Pesos*, the proper reading of *Two Pesos* is that Section 43(a) and Section 2 both preclude the protection of non-distinctive marks. And because the scandalous clause of Section 2(a), in particular, is not at all designed to address distinctiveness, the fact that a particular mark may be "scandalous" to certain persons should not vitiate its owner's ability to protect its distinctive designation and sue for unfair competition under Section 43(a) to protect its mark and prevent consumer confusion.

CONCLUSION

For the above stated reasons, the NYIPLA respectfully requests that the Court: (1) following *Tam*, conclude that the Lanham Act's prohibition on registration of trademarks that are immoral or scandalous discriminates based on viewpoint and, as a result, is presumptively unconstitutional; and (2) should the Court declare Section 2(a)'s immoral or scandalous provision constitutional, also confirm the availability of Section 43(a) for an applicant whose mark has been so denied under Section 2(a).

Respectfully submitted,

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No. 18-302

In the
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF AMICUS CURIAE OF PACIFIC LEGAL FOUNDATION IN SUPPORT OF RESPONDENT

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides that the government shall not refuse a trademark registration on account of the mark's nature unless the mark comprises "immoral . . . or scandalous matter." The question presented is whether the scandalous-marks provision of the Lanham Act is facially invalid under the First Amendment.

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INTEREST OF AMICUS CURIAE[1]

Pacific Legal Foundation (PLF) is a public interest legal foundation established in 1973 to litigate cases that advance the principles of limited government and individual liberty. Toward those ends, PLF has participated as amicus curiae in many cases involving the speech rights of entrepreneurs and businesses. PLF attorneys have also published extensively on the need for full First Amendment protection for commercial speech. This case is important to PLF because it threatens the freedom of speech of individual entrepreneurs and commercial enterprises.

INTRODUCTION AND SUMMARY OF ARGUMENT

Erik Brunetti is a designer and artist, and since 1990 has owned the clothing brand "FUCT." *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017). Mr. Brunetti's brand was founded as, and remains, a provocative streetwear brand known for its anti-establishment celebration of freedom of expression. Samuel Hine, *How O.G. Streetwear Brand FUCT Took a Free Speech Case All the Way to the Supreme Court*, GQ Magazine (Jan. 30, 2019).[2] While it is a homonym for a common curse word," "FUCT" has also come to be an acronym for "Friends yoU Can't Trust." *See id.*; *In re Brunetti*, 877 F.3d at 1339.

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[1] No counsel for any party authored this brief in whole or in part, and no person or entity other than amicus curiae funded its preparation or submission. Counsel for both parties granted consent to the filing of this amicus curiae brief.

[2] *Available at* https://www.gq.com/story/fuct-erik-brunetti-supreme-court-case.

In 2011, two individuals filed an application to register "FUCT" as a trademark. *In re Brunetti*, 877 F.3d at 1337. Mr. Brunetti later took over the application. *Id.* However, registration of the brand was refused by the Patent and Trademark Office examiner on the grounds that it was the past tense for a vulgar word, and therefore "scandalous" under the Lanham Act. *Id.* Mr. Brunetti appealed that determination. *Id.*

On appeal to the Federal Circuit, and following this Court's decision in *Matal v. Tam*, 137 S. Ct. 1744 (2017), the court reversed. The Federal Circuit held that the scandalous-marks provision violates the First Amendment because it is an impermissible content-based speech restriction. *Id.* at 1341. This Court granted review. *Iancu v. Brunetti*, ___ S. Ct. ___ (2019); 2019 WL 98541.

Petitioner (government) asserts that it is not a restriction of speech to deny applications to register "scandalous" marks. Pet. Br. at 40–41. But the Court recently rejected a similar argument by the government in *Tam* that rejecting "disparaging" marks is not a speech restriction. *Tam*, 137 S. Ct. at 1757–63. In an effort to avoid that outcome here, the government argues that *Tam* does not apply in this case because it concerned a provision under the Lanham Act that discriminated on viewpoint and, according to the government, even if the scandalous-marks provision restricts speech here, it does so in viewpoint-neutral fashion. Pet. Br. at 15–19. As a result, the government urges the Court to apply less than strict scrutiny. Pet. Br. at 19–40.

But the scandalous-marks provision is viewpoint-based because it requires the government to evaluate proposals based on whether "the ideas are themselves offensive to some of their hearers." Indeed, Mr. Brunetti's mark was rejected because the government determined that its message was "anti-social" and "misogyny[istic]," and "lacking in taste"—a clear value judgment based on viewpoint. And even if the provision is viewpoint-neutral, it is necessarily content-based, and this Court's recent decision in *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015), made clear that content-based restrictions are uniformly subject to strict scrutiny.

Nor is Mr. Brunetti's mark commercial speech. Because the "commercial speech doctrine" only applies when the government regulates to protect the public from commercial harms or fraud, the doctrine is inapplicable here. This is not a case where the public is at risk from misleading advertising, nor is it a case where use of a trademark may potentially defraud the public. In fact, to the extent that "FUCT" is commercial speech, the government can best protect the public by granting the mark trademark protection.

If the Court does hold Mr. Brunetti's mark to be commercial speech, an express overruling of *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980), and the intermediate scrutiny for commercial speech it sets forth, is long overdue. There is no principled distinction between commercial and noncommercial speech in the First Amendment, and the Court should clarify that the Constitution fully protects commercial speech.

ARGUMENT

I

STRICT SCRUTINY MUST APPLY BECAUSE THE SCANDALOUS-MARKS PROVISION IS A VIEWPOINT- AND CONTENT-BASED SPEECH RESTRICTION

The First Amendment prohibits "governmental control over the content of messages expressed by private individuals." *Turner Broadcasting Sys. v. Fed. Comm. Comm'n*, 512 U.S. 622, 641 (1994). This Court applies "the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential burdens upon speech because of its content." *Id.* at 642. Likewise, when the government targets "particular views taken by speakers on a subject, the violation of the First Amendment is all the more blatant." *Rosenberger v. Rector and Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995). Thus, "[v]iewpoint discrimination is [ ] an egregious form of content discrimination." *Id.* Indeed, "[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). The scandalous-marks provision upsets this bedrock principle. It is unconstitutional precisely because it asks the government to deny registration based on whether "society finds [an] idea itself offensive or disagreeable."

In *Tam*, the Court emphasized that its cases "use the term 'viewpoint' discrimination in a broad sense" and that "[g]iving offense is a viewpoint."

137 S. Ct. at 1763. Specifically, "'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Id.* (quoting *Street v. New York*, 394 U.S. 574, 592 (1969)). Accordingly, the Court held that the requirement that a mark not be "offensive to a substantial percentage of the members of any group" was viewpoint-based and subject to strict scrutiny. *Id.* Justice Kennedy further emphasized that "[t]he Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker's audience." *Id.* at 1766 (Kennedy J., concurring).

The scandalous-marks provision is substantially similar to the disparagement provision that was held unconstitutional in *Tam*. In determining whether a mark is "scandalous," the government must consider whether a "substantial composite of the general public" would find it to be "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation." *In re Brunetti*, 877 F.3d at 1336. Thus, marks are approved only if they express a viewpoint that is not "offensive" or "disreputable" to a "substantial composite of the general public." *Id.* The government's determination that a mark is offensive essentially gives the most sensitive ears a speech veto—in clear contravention of the Constitution's demand of viewpoint neutrality.

In determining that "FUCT" was a scandalous mark, the government went far beyond merely appealing to dictionary definitions of the term "fuct." *In re Brunetti*, 877 F.3d at 1337. Instead, the

government conducted a Google Images search and looked at the specific ways that "FUCT" had been utilized. *Id.* It found that the mark had been used in a fashion "that objectifies women and offers degrading examples of extreme misogyny." *Id.* Similarly, the government concluded that the usage of "FUCT" included elements "of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." *Id.* Further, the government found that advertising the "FUCT" brand carried with it "negative sexual connotations" because it promoted group sex. *Id.* at 1338.

The government's analysis is therefore a textbook example of viewpoint discrimination. If the brand promoted a campaign focused on female empowerment and sexual autonomy rather than what the government concluded was an example of "misogyny," then the government would have reached a different conclusion. Indeed, rejecting "FUCT" because it carries "negative sexual connotations" is itself a value judgment against lawful sexual activity. Similarly, if the brand had utilized positive images of rainbows, puppies, and unicorns rather than "anti-social imagery" that the government determined was "lacking in taste," then the mark could have been approved. But the government discriminated precisely because of the viewpoint that "FUCT" expressed in its marketing. There are no objective non-viewpoint-based ways to measure whether an image is "misog[ynistic]," "anti-social," or "lacking in taste," as such characterizations depend solely on the personal subjective judgments of government

employees. As in *Tam*, the government rejected Mr. Brunetti's mark because it is "an expressive message—namely, a message that is scandalous or offensive to a substantial composite of the general population." *In re Brunetti*, 877 F.3d at 1349.

Even if the scandalous-marks provision is viewpoint-neutral, it is plainly content-based and subject to strict scrutiny. In *Reed* this Court clarified long-lingering confusion as to when exactly a law was considered content-based and subject to strict scrutiny. 135 S. Ct. at 2228. The Court emphasized that any law that "target[s] speech based on its communicative content" is "presumptively unconstitutional and may be justified only if the government proves that [it is] narrowly tailored to serve compelling state interests." *Id.* at 2226. Any law that "applies to particular speech because of the topic discussed or the idea or message expressed," is content-based, regardless of whether the law was enacted with benign intentions or can be justified by some other non-speech-suppressing purpose. *Id.* at 2227. Content-based restrictions are constitutionally suspect because such restrictions lend themselves to use "for invidious, thought-control purposes." *Id.* at 2229.

The scandalous-marks provision is content-based on its face because it requires the government to examine the "communicative content" of a mark and to approve or deny the mark based on "the topic discussed or the idea or message expressed." *Id.* at 2227. A policy that requires government to determine which types of messages are permissible is constitutionally suspect because it opens the door to censorship for "invidious, thought-control purposes."

Id. at 2229. Accordingly, under *Reed*, strict scrutiny applies even if the scandalous-marks provision is viewpoint-neutral.

II

THE COMMERCIAL SPEECH DOCTRINE DOES NOT APPLY TO THIS CASE

For the reasons discussed above, the scandalous-marks provision is a viewpoint- and content-based speech restriction. Nonetheless, left open by *Tam* is whether the *Central Hudson* test for commercial speech is applicable to challenges to trademark regulation under the Lanham Act. 137 S. Ct. at 1764 n.17 (Alito, J.). It is not.

In 1976, this Court reinstated the protections of the First Amendment for commercial speech. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761–62 (1976). The Court later created a four-part test for evaluating commercial speech regulations in *Central Hudson*, 447 U.S. at 564, and modified the test in *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 504 (1996).

A. Trademarks Are Fully Protected Because They Combine Expressive Speech with Commercial Components

Commercial speech is speech that "does no more than propose a commercial transaction." *44 Liquormart*, 517 U.S. at 518 (Thomas, J., concurring) (quoting *Va. State Bd. of Pharmacy*, 425 U.S. at 762); *see also* Martin H. Redish, *Commercial Speech, First Amendment Intuitionism and the Twilight Zone of*

Viewpoint Discrimination, 41 Loy. L.A. L. Rev. 67, 74–75 (2007) (the definition of commercial speech for the Court is "speech advocating the sale of commercial products or services"). Trademarks on the other hand—and Mr. Brunetti's mark in particular—do not propose a commercial transaction. On the contrary, trademarks serve many functions, and Mr. Brunetti is using "FUCT" to express a message. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3:2 (4th ed. Westlaw); *see also In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) ("With his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech."); *In re Brunetti*, 877 F.3d at 1349 (noting examples of "uncouth" applied-for trademarks such as "FUCK CANCER" and "FUCK RACISM"). While that message may be crude and discomfiting to some, the First Amendment is designed to protect expressive speech. *See Cohen v. California*, 403 U.S. 15, 25–26 (1971) (invalidating the prosecution of an individual for wearing a jacket that said "Fuck the Draft," and declaring that it is "often true that one man's vulgarity is another's lyric").

When expressive speech is "inextricably intertwined" with commercial components—like the "FUCT" trademark—the Court "cannot parcel out the speech, applying one test to one phrase and another test to another phrase." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988). Here, the government acknowledges that Mr. Brunetti's mark is expressive. Pet. Br. at 7. Therefore, because of its function and purpose, "FUCT" cannot be categorized solely as commercial speech under even the broadest definition. *Cf. Rubin v. Coors Brewing Co.*, 514 U.S. 476, 492 (1995) (Stevens, J., concurring) ("[T]he Government

should not be able to suppress . . . truthful speech merely because it happens to appear on the label of a product for sale.").

B. The Court's Rationales for Less Than Full Protection Do Not Apply to Trademarks

The rationales for affording commercial speech less protection does not apply to Mr. Brunetti's attempt to register "FUCT." Government may restrict commercial speech to protect the public from "commercial harms," *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) (citing *Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 426 (1993)), or lessen the risk of fraud. *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 388–89 (1992) (citing *Va. State Bd. of Pharmacy*, 425 U.S. at 771–72). Because neither concern is implicated here, the Court should not treat Mr. Brunetti's mark as commercial speech.

The Court's concern for protecting the public from "commercial harm[s]" focuses on the financial loss suffered as a result of untruthful or misleading advertising. *See Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 81–82 (1983) (Stevens, J., concurring). But trademarks—and registration with the government—help remedy this problem on their own. Trademarks protect the public from being confused or misled by competing merchants. *See* Pet. Br. 2 (citing, *e.g.*, *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015)). Indeed, to the extent there is concern about misleading or untruthful speech in this case, granting Mr. Brunetti

registration of his trademark would protect the public from confusion.[3]

Likewise, the risk of fraud is not present with Mr. Brunetti's use of his mark. Nowhere does the government contend that the rejection of "FUCT" is necessary to combat fraud. Even if it had, fraud is best mitigated by granting Mr. Brunetti trademark registration for his mark. In any event, "the First Amendment does not shield fraud." *Illinois ex rel. Madigan v. Telemarketing Associates, Inc.*, 538 U.S. 600, 612 (2003). Government can use anti-fraud laws to prosecute, and thereby deter, speech that defrauds the public without running afoul of the First Amendment. *See id.* at 621.

Furthermore, this Court's recent decisions also counsel against expanding the commercial speech doctrine to trademark registration. Instead, the Court has narrowed the applicability of the commercial speech doctrine. *See Reed*, 135 S. Ct. at 2235 (Breyer, J., concurring) ("[T]he Court has applied the heightened 'strict scrutiny' standard even in cases where the less stringent 'commercial speech' standard was appropriate.").

Rather than classify Mr. Brunetti's mark as commercial speech worthy of only limited constitutional protection, the Court should hold that it is fully protected expressive speech.

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[3] Trademark registration provides fashion designers like Mr. Brunetti with valuable tools to combat the $450 billion global problem of counterfeit clothing *See* https://www.businessoffashion.com/articles/intelligence/fighting-the-450-billion-trade-in-fake-fashion.

III

CENTRAL HUDSON SHOULD BE OVERRULED AND THE COMMERCIAL SPEECH DOCTRINE REPUDIATED

Even if the Court were to find Mr. Brunetti's mark to be commercial speech, the intermediate scrutiny described in *Central Hudson*, 447 U.S. at 564, should be repudiated.

A. *Central Hudson* Is Unworkable and Lacks Constitutional Principles

Since *Central Hudson* was decided in 1980, confusion and inconsistency have been the only guarantees in cases analyzing commercial speech regulations. *See 44 Liquormart*, 517 U.S. at 526–28 (Thomas, J. concurring); Daniel Halberstam, *Commercial Speech, Professional Speech, and the Constitutional Status of Social Institutions*, 147 U. Pa. L. Rev. 771, 779–89 (1999) (discussing the inconsistent approach taken by courts and the calling into doubt of *Central Hudson* and the commercial speech doctrine); Deborah J. La Fetra, *Kick It Up a Notch: First Amendment Protection for Commercial Speech*, 54 Case W. Res. L. Rev. 1205, 1216–17 (2004) (noting that courts have acknowledged that the commercial speech doctrine is difficult to apply predictably). In all likelihood, confusion has resulted because there is no "philosophical or historical basis for asserting that 'commercial speech' is of 'lower value' than 'noncommercial' speech." *44 Liquormart*, 517 U.S. at 522 (Thomas, J., concurring) (citing authorities); *Tam*, 137 S. Ct. at 1769 (Thomas, J., concurring); *see also generally* Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 Va.

L. Rev. 627 (1990) (concluding that there is no valid reason for distinguishing between commercial and noncommercial speech); La Fetra, *supra* at 1221 ("[E]xcluding corporate speech from the First Amendment's reach would almost inevitably have a detrimental impact on the most fundamental values underlying the protection of free speech.").

It is increasingly true that distinguishing between commercial and noncommercial speech is hopeless. *Kasky v. Nike, Inc.*, 45 P.3d 243, 269 (Cal. 2002) *dismissed as improvidently granted*, 539 U.S. 654 (U.S. June 26, 2003) (Brown, J., dissenting) ("[T]he commercial speech doctrine, in its current form, fails to account for the realities of the modern world—a world in which personal, political, and commercial arenas no longer have sharply defined boundaries."). The line between commercial speech and fully protected speech has long been blurred, but advances in technology and social connectedness further cloud the distinction. *See* La Fetra, *supra* 1231–36. Examples ranging from music videos, to press releases, to television show product placement, to letters to the editor, to "guerilla" marketing and virtual advertising show that it is quite difficult to distinguish whether speech "does no more than propose a commercial transaction," or expresses views on the issues of the day, or engages in artistic expression. *Id.* at 1231–34.[4]

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[4] It is also common practice for airlines to engage on the Twitter social media platform. Southwest Airlines, for example, uses its @SouthwestAir account to engage with customers, announce airline news, provide customer support, and generally promote itself. Aside from the occasional announcement of a fare sale, however, none of these communications neatly fit the definition for commercial speech.

In two recent First Amendment decisions, the Court declined to distinguish between commercial and noncommercial speech. In *Sorrell*, the Court struck down a Vermont statute that imposed a content- and viewpoint-based ban on commercial speech. 564 U.S. at 563–65, 580. The Court declined to determine which level of scrutiny was appropriate, because the Vermont statute could not withstand intermediate scrutiny. *Id.* at 571. However, the Court did reaffirm the significant value of commercial speech, and explained that its focus was the challenged law's content- and viewpoint-based application. *Id.* at 566–67. Furthermore, the Court limited the availability of intermediate scrutiny to circumstances where the government's interest is to prevent commercial harm and fraud. *Id.* at 579. To the extent that the commercial speech doctrine remains after *Sorrell*, it is significantly limited.

More recently, in *Reed*, this Court held that content- and viewpoint-based speech restrictions are subject to strict scrutiny. 135 S. Ct. at 2226–27. The Court did not limit the rule to noncommercial speech, and cited approvingly to commercial speech decisions to set out the rule. *See id.* at 2226–28 (citing *Sorrell* and *Cincinnati*, 507 U.S. 410). Indeed, the Court cited *Sorrell* as authority for the proposition that before considering the purpose or justification for a speech restriction, the Court must first consider whether the law regulates based on content. *Id.* at 2228. There is no obvious reason to limit that proposition to noncommercial speech. In fact, were a court to consider whether a speech restriction applies to commercial or noncommercial speech first, it would violate *Reed*. *Id.* at 2227 (emphasizing that laws that

cannot be "justified without reference to the content of the regulated speech" are subject to strict scrutiny).

While *Reed* does not expressly hold that it applies to commercial speech, it set out broadly applicable rules for content-based speech restrictions, and did not seek to limit *Sorrell* or its application to commercial speech. Some lower courts have begun applying *Reed* to content-based commercial speech restrictions. *See Thomas v. Schroer*, 127 F. Supp. 3d 864, 873–75 (W.D. Tenn. 2015) (applying strict scrutiny under *Reed* after determining Tennessee's Billboard Act was content-based); *but see Citizens for Free Speech, LLC v. Cty. of Alameda*, 114 F. Supp. 3d 952, 968–69 (N.D. Cal. 2015) (holding *Reed* does not apply to commercial speech). This Court should quell any remaining confusion by expressly overruling *Central Hudson*.

B. Principles of *Stare Decisis* Do Not Support Preserving *Central Hudson*

Respect for precedent and *stare decisis* are insufficient reasons to maintain *Central Hudson*. While *stare decisis* is "of fundamental importance to the rule of law," *Patterson v. McLean Credit Union*, 491 U.S. 164, 172 (1989), "when governing decisions are unworkable or are badly reasoned, 'this Court has never felt constrained to follow precedent.' " *Payne v. Tennessee*, 501 U.S. 808, 827 (1991) (quoting *Smith v. Allwright*, 321 U.S. 649, 665 (1944)). It is appropriate to overrule previous decisions when they are detrimental to "coherence and consistency in the law . . . because of inherent confusion created by an unworkable decision." *Patterson*, 491 U.S. at 173. Once a previous decision has shown to be unworkable,

"the mischievous consequences to litigants and courts alike from the perpetuation of an unworkable rule are too great" to justify upholding the decision. *Swift & Co., Inc. v. Wickham*, 382 U.S. 111, 116 (1965); *see also Montejo v. Louisiana*, 556 U.S. 778, 792 (2009) ("[T]he fact that a decision has proved 'unworkable' is a traditional ground for overruling it.").

Whether it is the confusing and inconsistent application of the four-part test for commercial speech, or the increasing difficulty in distinguishing between commercial and noncommercial speech, many have noted that *Central Hudson* is unworkable. *See, e.g.*, *44 Liquormart*, 517 U.S. at 526–27 (Thomas, J., concurring); *Kasky*, 45 P.3d at 269 (Brown, J., dissenting). Furthermore, the reasoning behind *Central Hudson*'s diminished protection of commercial speech has never been satisfactorily established. *44 Liquormart*, 517 U.S. at 526 (Thomas, J., concurring); *Tam*, 137 S. Ct. at 1769 (Thomas, J., concurring). When a precedent's "logic threatens to undermine our First Amendment jurisprudence and the nature of public discourse more broadly—the costs of giving it *stare decisis* effect are unusually high." *Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 382 (2010). Therefore, considerations of *stare decisis* should not compel the Court to maintain a distinction between commercial and noncommercial speech founded on such questionable footing.

A better approach, more consistent with this Court's First Amendment precedents—including *Reed*—would explain that there is no principled distinction between commercial and noncommercial speech under the First Amendment. As a result, the Court should overrule *Central Hudson* and eliminate

its unprincipled and limited protection of commercial speech. At a minimum, if *Central Hudson* remains good law, the Court should clarify that it only applies where the government's interest is to prevent actual commercial harm or fraud. In either event, *Central Hudson* has no applicability here, where the government's interest has nothing to do with preventing commercial harm or fraud and, accordingly, strict scrutiny must apply.

CONCLUSION

For the foregoing reasons, the decision of the Federal Circuit should be affirmed. Strict scrutiny is the appropriate standard to review the scandalous-marks provision. If this Court holds Mr. Brunetti's mark to be commercial speech, *Central Hudson* should be repudiated.

DATED: March, 2019.

Respectfully submitted,

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IN THE

Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF THE RUTHERFORD INSTITUTE AS *AMICUS CURIAE* IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICUS CURIAE*[1]

The Rutherford Institute is an international civil liberties organization headquartered in Charlottesville, Virginia. Founded in 1982 by its President, John W. Whitehead, the Institute specializes in providing legal representation without charge to individuals whose civil liberties are threatened and in educating the public about constitutional and human rights issues. Attorneys affiliated with the Institute have represented parties and filed numerous *amicus curiae* briefs in the federal Courts of Appeals and Supreme Court. The Rutherford Institute works to preserve the most basic freedoms of our Republic, including the limits placed on government by the First Amendment. The Rutherford Institute opposes governmental action to burden or censor speech for the purpose of protecting the subjective sensibilities of part of the audience.

The Rutherford Institute has helped develop key First Amendment principles informing the reach of government power. *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205 (2013); *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011); *Snyder v. Phelps*, 562 U.S. 443 (2011); *Rust v. Sullivan*, 500 U.S. 173 (1991). The Rutherford Institute also participated as *amicus curiae* in *Matal v. Tam*, 137 S. Ct. 1744 (2017), in which the government similarly claimed the power to

1. Pursuant to Rule 37.3(a), Petitioner and Respondent have provided written consent to the filing of this brief. Pursuant to Rule 37.6, *amicus* affirms that no counsel for a party authored this brief in whole or in part and that no person other than *amicus* and its counsel made a monetary contribution to the preparation or submission of this brief.

judge speech based on viewpoint and content, free from First Amendment scrutiny.

SUMMARY OF ARGUMENT

The government uses the Lanham Act's scandalous-marks provision to suppress speech that may offend members of the public. As Justice Alito's plurality opinion in *Tam* recognized, "that is viewpoint discrimination: Giving offense is a viewpoint." *Tam*, 137 S. Ct. at 1763 (Alito, J.); *see also id.* at 1766 (Kennedy, J., concurring) ("The law thus reflects the Government's disapproval of a subset of messages it finds offensive. This is the essence of viewpoint discrimination."). The government does not deny that it refuses to register trademarks based on whether the government believes the trademark would cause offense. Instead, the government claims that its discretionary refusal to register offensive marks is viewpoint neutral and does not restrict speech at all because it is merely a condition on the availability of a government benefit.

This is nonsense. Trademarks are protected speech. A trademarked name, word, phrase, logo, or design can do far more than identify the source of a product or service. Trademarks—including scandalous trademarks—"often have an expressive content." *Tam*, 137 S. Ct. at 1760 (Alito, J.). Although the speech expressed in trademarks is brief, "powerful messages can sometimes be conveyed in just a few words." *Id.*

For example, SCREW CANCER (Reg. No. 4011638), SCREW YOU, CANCER! (Reg. No. 4685551), CAPITALISM SUCKS DONKEY BALLS (Reg. Nos.

4978662, 4744351), and CAPITALISM SCREWED MY MOTHER (Reg. No. 4629158) are all registered trademarks. At the same time, FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028), FUCK RACISM (Ser. Nos. 87/303302, 85/608559), FUCK SENSITIVITY (Ser. No. 85/761742), F*CK YOU! WOMEN LIFT TOO! (Ser. No. 87/445911) and DON'T FUCK WITH THE JEWS (Ser. No. 78/822587) were all denied registration as scandalous, or the applicant was given notice that the mark "normally would be refused registration" as scandalous but that action was suspended pending the outcome of this case.

These examples belie the government's attempt to separate a mark's emotive element from the ideas a mark communicates. Pet. Br. 27-28. As this Court recognized in *Cohen v. California*, 403 U.S. 15 (1971), it is a "facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process"— an assumption that may lead to "censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* at 26.

The government's refusal to register the trademark at issue here demonstrates the use of the scandalous-marks provision to punish disfavored ideas. The PTO denied registration because it considered "FUCT" to be an "extremely offensive" term that in the context of Respondent's website and products expresses "extreme misogyny, nihilism, or violence." Pet. App. 65a.

Brunetti challenged the PTO's rejection of his mark, and after this Court's decision in *Tam*, the Federal Circuit held that the scandalous-marks provision of Section 1052(a)

is facially invalid under the First Amendment. The appeals court properly determined that the scandalous-marks provision is subject to strict scrutiny because it "targets the expressive components of the speech," and therefore discriminates based on content. Pet. App. 30a.[2] Notably, the court explained that "[a]s in this case, the [PTO] often justifies its rejection of marks on the grounds that they convey offensive ideas," and thus makes "value judgments about the expressive message behind the trademark." *Id.*

Even in the wake of this Court's decision in *Tam*, the United States has again chosen to defend the Lanham Act by embracing its role as the arbiter of taste, making the high-minded claim that the government has a legitimate interest in "avoiding any appearance of government approval of" scandalous marks. Pet. Br. 13. The United States' position undermines the core role of the First Amendment as a check on government power, which the Court has vigorously upheld.

Trademark registration cannot be used to burden speech in an effort to shield the public from offense. This is anathema to the First Amendment. "A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government's benevolence." *Tam*, 137 S. Ct. at 1769 (Kennedy, J., concurring). In light of its decision in *Tam*, this Court should extricate the government from policing offense and confirm that the power of government is not properly deployed by using a

2. The Federal Circuit assumed without deciding that the scandalous-marks provision is viewpoint neutral. Pet. App. 14a.

century-old statute permitting discretionary trademark registration to pick winners and losers on the playing field of expression. The market, and consumers, benefit from vibrant expression free from government interference. This Court should affirm the appeals court decision and continue its longstanding commitment to vindicating the First Amendment, even when it protects unpleasant speakers and speech.

ARGUMENT

I. THE SCANDALOUS-MARKS PROVISION IMPERMISSIBLY RESTRICTS SPEECH THAT GOVERNMENT OFFICIALS DISLIKE BECAUSE IT MAY CAUSE OFFENSE.

A. The Scandalous-Marks Provision Is A Restriction On Speech, Not A Condition On The Availability Of A Government Benefit.

"Federal registration" of trademarks "'confers important legal rights and benefits on trademark owners who register their marks,'" the denial of which places applicants at a legal and financial disadvantage. *Tam*, 137 S. Ct. at 1753 (quoting *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1317 (2015)). As a result, the government finds itself squarely in the heartland of cases holding that the First Amendment imposes limits on government action, even where the action at issue is the denial of a benefit to which the recipient otherwise "has no entitlement." *Agency for Int'l Dev.*, 570 U.S. at 214 (citations omitted); *accord Rumsfeld v. Forum for Acad. & Inst. Rights, Inc.*, 547 U.S. 47, 59 (2006) ("'[T]he government may not deny a benefit to a person on a basis

that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit.'") (citations omitted).

To avoid this, Petitioner argues that the PTO's discretionary review for scandalousness is simply a "condition on the availability of a government benefit," not a restriction on speech. Pet. Br. 20. This argument hinges on the Petitioner's distinction between "us[ing] content-based criteria . . . to determine whether particular private speech should be *prohibited*," and using such criteria "to allocate various government benefits." *Id.* at 22 (emphasis in original). Petitioner claims that the scandalous-marks provision falls within the latter rather than the former, attempting to analogize the scandalous-marks provision to cases that afford the government leeway to make content-based distinctions when the government subsidizes speech. This attempt fails.

As Justice Alito's plurality opinion in *Tam* recognized, "the decisions on which the government relies all involved cash subsidies or their equivalent" (i.e. "tax benefits"), and "[t]he federal registration of a trademark is nothing like the programs at issue in these cases." *Tam*, 137 S. Ct. at 1761 (Alito, J.). Petitioner's theory thus represents an attempt to greatly expand the government-subsidy cases, which would exempt vast and varied government activity from First Amendment scrutiny.

First, although trademark registration confers benefits, federal funds are not one of them. "The PTO does not pay money to parties seeking registration of a mark. Quite the contrary is true: An applicant for registration must pay the PTO a filing fee of $225-$600[,] . . . [a]nd to

maintain federal registration, the holder of a mark must pay a fee of $300-$500 every 10 years." 137 S. Ct. at 1761 (Alito, J.).

Second, the benefits of federal trademark registration simply are not analogous to Congress's grant of federal funds or provision of tax benefits to subsidize speech. Congress did not establish trademark registration to further any message or viewpoint. *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) (noting that "[t]here may be situations where private speakers are selected for a government program to assist the government in advancing a particular message," but trademark registration is not one of them); *Cf. Rust*, 500 U.S. at 192 (permitting a government family-planning program to limit abortion-related speech); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (permitting the National Endowment for the Arts to subsidize certain artistic expression over others).

Petitioner's reliance on *Davenport v. Washington Education Association*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Education Association*, 555 U.S. 353 (2009), is particularly misplaced. Justice Alito's plurality opinion in *Tam* makes clear that these "two cases involving a public employer's collection of union dues from its employees . . . occupy a special area of First Amendment case law, and they are far removed from the registration of trademarks." 137 S. Ct. at 1761-62 (Alito, J.). Although Petitioner acknowledges that "Justice Alito's opinion in *Tam* rejected the government's reliance on *Davenport* and *Ysursa*," Petitioner tries to cabin that rejection by claiming that it took place "in the context of a viewpoint discriminatory provision." Pet. Br. 43. However, Justice Alito's rejection

of the government's reliance on *Davenport* and *Ysursa* was not premised on the disparagement provision's viewpoint discrimination. Instead, Justice Alito's opinion appropriately limited the reach of *Davenport* and *Ysursa* to "a special area of First Amendment case law" not at issue here. *Tam*, 137 S. Ct. at 1762 (Alito, J.).

Even if Section 1052(a) were a subsidy program, the First Amendment limits the government's power to use subsidy programs to discriminate against certain viewpoints. *Tam*, 137 S. Ct. at 1768-69 (Kennedy, J., concurring); *see also Regan v. Taxation With Representation of Washington*, 461 U.S. 540, 550 (1983) (internal quotation marks and citation omitted) (stating that the government may not aim subsidies "at the suppression of dangerous ideas"); *Leathers v. Medlock*, 499 U.S. 439, 447 (1991) ("[D]ifferential taxation of First Amendment speakers is constitutionally suspect when it threatens to suppress the expression of particular ideas or viewpoints"). Imposing burdens on speakers based on the content of their speech "may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991). That is what the government tries to accomplish through the scandalous-marks provision. The government cannot have it both ways. Even if it could treat trademarks as a federal subsidy—which it cannot—it must abide the limitations on that power.

B. The Scandalous-Marks Provision, Like The Disparagement Provision Invalidated By *Tam*, Discriminates Based On Viewpoint And Content.

After this Court's decision in *Tam*, the scandalous-marks provision cannot be construed as viewpoint neutral. This Court's "cases use the term 'viewpoint' discrimination in a broad sense." *Tam*, 137 S. Ct. at 1763 (Alito, J.). Thus, as Justice Alito's plurality opinion concluded, even though the disparagement provision "evenhandedly prohibit[ed] disparagement of all groups[,] . . . that is viewpoint discrimination: *Giving offense is a viewpoint.*" *Id.* (emphasis added); *see also id.* at 1766-67 (Kennedy, J., concurring). The same is true of the scandalous-marks provision. It evenhandedly prohibits offending any substantial portion of the general public. As Justice Alito noted in *Tam*, "we have said time and again that 'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Id.* at 1763 (Alito, J.) (quoting *Street v. New York*, 394 U.S. 576, 592 (1969), and collecting cases); *see also id.* at 1766-67 (Kennedy, J., concurring) ("The Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker's audience. . . . The danger of viewpoint discrimination is that the government is attempting to remove certain ideas or perspectives from a broader debate. That danger is all the greater if the ideas or perspectives are ones a particular audience might think offensive, at least at first hearing.").

And contrary to the government's claims, the scandalous-marks provision does not simply restrict

"especially offensive *mode[s]* of expression." Pet. Br. 28 (emphasis added); *see also id.* at 12, 20, 27-28. It suppresses the underlying *ideas* expressed by the trademark and thus strikes at the heart of the First Amendment. As discussed further below, this Court has long recognized that under the First Amendment, the emotive element of speech cannot be separated from the ideas being communicated. *Cohen*, 403 U.S. at 26.

Notably, the Federal Circuit found that "[a]s in this case, the [PTO] often justifies its rejection of marks on the grounds that they convey offensive ideas." Pet. App. 30a. In rejecting Respondent's mark as scandalous, the PTO's Trademark Trial and Appeal Board emphasized that Respondent uses his mark "in the context of extreme misogyny, nihilism or violence." *Id.* at 65a.[3]

The Federal Circuit correctly observed that "[t]hese are each value judgments about the expressive message behind the trademark. Whether marks comprise . . . scandalous subject matter hinges on the expressive, not source-identifying, nature of trademarks." Pet. App. 30a. Indeed, nihilism is a philosophical viewpoint. Thus, even though individuals may justly be offended by the content associated with the mark at issue here, the speaker clearly has a viewpoint he is expressing.

---

3. According to the Board, Respondent's mark appears on clothing and on his website with "strong, and often explicit, sexual imagery that objectifies women and offers degrading examples of extreme misogyny" as well as imagery "of extreme nihilism – displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." Pet. App. 63a-64a.

1. This Case Is More Like *Cohen* Than The Government Will Admit.

This Court has already held that a jacket bearing the words "Fuck the Draft" is protected by the First Amendment because of the message it conveys. *Cohen*, 403 U.S. 15. The result should be no different for Brunetti's attempt to register "FUCT" as a trademark for clothing and other goods.

While the settings are different, the government's attempt to distinguish *Cohen* is unpersuasive. Pet. Br. 29. Contrary to the government's brief, the Court found that Cohen's conviction "quite clearly rest[ed] upon the asserted offensiveness of the words Cohen used to convey his message to the public," which implicated the First Amendment's ban on viewpoint discrimination. 403 U.S. at 18. The Court described the position the government attempts to advance here as a "facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process"—an assumption that may lead to "censorship of particular words as a convenient guise for banning the expression of unpopular views." *Id.* at 26. The Court correctly refused to condone "running the risk of opening the door to such grave results." *Id.*

The Lanham Act's ban on scandalous marks presents a similar risk and should be given the same reception by this Court. Indeed, the records of the PTO are replete with refusals to register expressive marks as scandalous, or notice to the trademark applicants that the marks "normally would be refused registration" as scandalous

but that action was suspended pending the outcome of this case:

- CORPORATE MASTURBATION (Ser. No. 77/747036)
- PUSSY POWER (Ser. Nos. 88/163730, 87520058)
- F*CK YOU! WOMEN LIFT TOO! (Ser. No. 87/445911)
- I DON'T GIVE A F K WHO YOU LOVE (Serial No. 85/404175)[4]
- FUCK SENSITIVITY (Ser. No. 85/761742)
- FUCK RACISM (Ser. Nos. 87/303302, 85/608559)
- FUCK FEAR (Ser. No. 87/628707)
- FUCK FEAR. MAKE LOVE. (Ser. No. 88/004995)

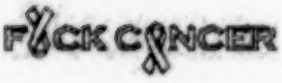
4.

- FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028)[5]

- FUK WHAT SOCIETY SAY (Ser. No. 87/787921)

The government also attempts to downplay the significance of *Cohen* by arguing that "the Court distinguished that 'emotive' element" of Cohen's speech "from the substance of the 'ideas' themselves." Pet. Br. 29. But the Court considered the "emotive function" of speech to be part of the viewpoint it expressed, emphasizing that the emotive function "may often be the more important element of the overall message sought to be communicated." *Cohen*, 403 U.S. at 25-26 ("[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well.").

5.



The Court thus rejected the view—implicitly advanced by the government—that "the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.* at 26.

Thus, even if the PTO were interested only in banning profanity, its attempt to police crude language surely suppresses important messages. For example, the PTO has repeatedly refused to register FUCK CANCER (Ser. Nos. 86/290011, 86/288375, 86/924028), but has allowed SCREW CANCER (Reg. No. 4011638), SCREW YOU, CANCER! (Reg. No. 4685551), and SUCK IT, CANCER (Reg. No. 4999260)—the value judgment apparently being that it is acceptable to oppose cancer, just not too strongly.

2. The Rationale of *Pacifica* Does Not Justify The Scandalous-Marks Provision.

The government also cites *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), for the proposition that the regulation of profanity is viewpoint neutral. Pet Br. 28. But that case is inapposite as the Court was at pains to "emphasize the narrowness of [its] holding." 438 U.S. at 748–50. *Pacifica* concerned a radio broadcast, which "of all forms of communication . . . has received the most limited First Amendment protection" because "indecent material presented over the airwaves confronts the citizen, not only in public, but also in the privacy of the home" and is "uniquely accessible to children." *Id.*; *City of Los Angeles v. Preferred Commc'ns, Inc.*, 476 U.S. 488, 496 (1986)

("Different communications media are treated differently for First Amendment purposes.").[6]

As the Federal Circuit correctly observed, "[t]he government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*." Pet. App. 37a. As the government well knows, "a trademark is not foisted upon listeners by virtue of its being registered," "[n]or does registration make a scandalous mark more accessible to children." *Id.* at 37a-38a.

3. The Scandalous-Marks Provision—Unlike The Other Provisions Of Section 1052(a)-(e)—Targets A Mark's Expressive Message.

The government concedes that the scandalous-marks provision discriminates based on content. Pet. Br. 14 ("In determining whether particular marks are eligible for registration, the USPTO necessarily must consider the content of the marks. Section 1052(a)'s scandalous-marks provision is simply one of many content-based registration bans . . . ."). The government argues, however, that the same is true of many of the other provisions of Section

6. Similarly, this Court's decision in *Bethel School District No. 403 v. Fraser*, 478 U.S. 675 (1986), turned on the unique "[r]ole and purpose of the American public school system" and the fact that the offensive speech at issue was delivered at a school assembly to children, "many of whom were 14-year-olds." *Id.* at 677-81 (citing *Tinker v. Des Moines Indep. Sch. Dist.*, 393 U.S. 503 (1969)).

1052(a)-(e), and that to subject them all to strict scrutiny "would fundamentally disrupt the operation of the federal registration program." *Id.* at 26.

This argument fails to distinguish between the many provisions of Section 1052(a)-(e) that target a mark's source-identifying information, and the scandalous-marks provision, which targets a mark's expressive message. Examples of provisions of Section 1052(a)-(e) that target a mark's source-identifying information include provisions requiring that marks not be deceptive, 15 U.S.C. § 1052(a); not contain a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, *id.* § 1052(b); not include a name, portrait, or signature of a living person without his or her consent, *id.* § 1052(c); not so resemble other marks as to create a likelihood of confusion, *id.* § 1052(d); not be merely descriptive, *id.* § 1052(e)(1); and not be functional, *id.* § 1052(e)(5).

These provisions all relate to "[t]he central purpose of trademark registration," which is "to facilitate source identification." *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring). The scandalous-marks provision, by contrast, bears no plausible relation to that central purpose. Instead, it targets a mark's expressive message, which is separate and distinct from the commercial purpose of a mark as a source identifier. Given this distinction, subjecting the scandalous-marks provision to strict scrutiny would not require subjecting the other provisions of Section 1052(a)-(e) to strict scrutiny.[7]

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7. Although these provisions are not before the Court, it is entirely possible that they would survive heightened scrutiny even if they were subject to it.

C. The Lanham Act Gives Government Officials Near-Unfettered Discretion To Bar Registration Of Marks They Deem Scandalous, Yielding Incoherent Decisions.

The government asserts that the PTO "relies on an objective standard to determine whether registration of a particular mark is prohibited by the scandalous-marks provision." Cert. Reply 4-5. As this Court noted in *Tam*, however, the PTO has acknowledged the opposite: "the guidelines 'for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.'" *Tam*, 137 S. Ct. at 1756 n.5 (quoting *In re In Over Our Heads, Inc.*, 16 USPQ 2d 1653, 1654 (TTAB 1990) (brackets and internal quotation marks omitted)). The admitted vagueness of the scandalous-marks test, like the "admitted vagueness of the disparagement test," coupled with "the huge volume of applications"—"more than 400,000 trademark applications each year," Pet. Br. 46—"have produced a haphazard record of enforcement." *Tam*, 137 S. Ct. at 1757.

Under Section 1052(a) and the PTO's implementing regulations, the PTO polices trademark registration applications for scandalous marks, which are "absolute[ly]" prohibited. Trademark Manual of Examining Procedure ("TMEP") § 1203.01 (Oct. 2018), http://tmep.uspto.gov. The PTO defines the term "scandalous" to mean "*inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation," or "'vulgar,' defined as 'lacking in taste, indelicate, morally crude.'" *Id.* (quoting *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971)).

Using this vague definition, a PTO examiner is supposed to evaluate whether a mark is scandalous from the "standpoint" of a "substantial portion"—but "not necessarily a majority"— "of the general public." TMEP §1203.01. In engaging in this hypothetical, highly subjective exercise, the examiner is supposed to consider the mark "in the context of contemporary attitudes" and "the relevant marketplace for the goods or services identified in the application." *Id.* The examiner, at his or her discretion, may rely on dictionary definitions alone, may consider "newspaper articles" and "magazine articles," and "may look to the specimen(s) or other aspects of the record." *Id.* In short, the examiner is invited to pick and choose sources and to dabble in the social sciences to come to some conclusion as to whether the mark meets this vague standard.[8]

This lawless process does not comport with the strict requirements of the First Amendment. Not surprisingly, with flexible and shifting considerations, review yields unpredictable results, linked by a common theme: subjective and paternalistic review of the potential

8. Even if the mark is meant to convey humor or a double entendre—clearly expressive speech—the TMEP instructs the examiner to focus solely on the offensive aspect of the mark. *See* TMEP § 1203.01 ("Whether applicant intended the mark to be humorous, or even whether some people would actually find it to be humorous, is immaterial.") (citing *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012) ("a mark that creates a double entendre falls within the proscription of §1052(a) where, as here, one of its meanings is clearly vulgar"); *In re Star Belly Stitcher, Inc.*, 107 USPQ 2d 2059, 2063 (TTAB 2013) ("[T]here is no requirement in Section 2(a) that a mark's vulgar meaning must be the only relevant meaning, or even the most relevant meaning.").

to cause offense to some members of the public. Such review is hard to square with our system of content- and viewpoint-neutral government. *Tam*, 137 S. Ct. at 1765 ("it is a fundamental principle of the First Amendment that the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys") (Kennedy, J., concurring).

The lack of administrable standards ensures that trademarks are "contingent upon the uncontrolled will of an official," which this Court has made clear is "an unconstitutional censorship." *Shuttlesworth v. City of Birmingham, Ala.*, 394 U.S. 147, 151 (1969). *See, e.g., Saia v. New York*, 334 U.S. 558, 559-60 (1948) (striking down a New York loud-speaker permitting scheme where the police chief had unbounded discretion to grant or deny permits); *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 764 (1988) ("[The government] may not condition that speech on obtaining a license or permit from a government official in that official's boundless discretion."). Here, these discretionary decisions are particularly troubling since they are "based upon the content of the speech or viewpoint of the speaker." *City of Lakewood*, 486 U.S. at 763-64.

Unsurprisingly, the PTO's record reveals a bevy of content and viewpoint-based judgments that change over time and border on incoherence. For example, while FUCT was refused registration, FCUK was granted registration (Reg. Nos. 3028227, 2520614, and 2920270), as were all of the following arguably vulgar marks: FAUQ-YEAH! (Reg. No. 5282969); MUTHA EFFIN BINGO (Reg. No. 4183272); F'D UP (Reg. No. 4495813); WTF WHERE'S THE FOODTRUCK (Reg. No. 5642124);

WTFHAPPENED.COM (Reg. No. 4389264); and WTF WORK? (Reg. No. 4332574).[9]

The government attempts to downplay the incoherence in these decisions as mere "alleged inconsistencies." Pet. Br. 14, 47. But the issue is not simply a few "allegedly erroneous registration[s]" *id.* at 46, but rather the conscious use of trademark registration to censor some viewpoints under the guise of protecting people from offensive speech. As this Court explained in *Cohen*, "governmental officials cannot make principled distinctions in . . . matters of taste and style." *Cohen*, 403 U.S. at 25.

Inconsistencies serve to highlight the lack of a limiting principle in applying the scandalous-marks provision, making the process ripe for arbitrary application. *Heffron v. Int'l Soc'y for Krishna Consciousness, Inc.*, 452 U.S. 640, 649 (1981) (stating the Court condemns arbitrary discretion because "such discretion has the potential for becoming a means of suppressing a particular point of view"). Such discriminatory treatment of viewpoints is an "'egregious form of content discrimination,' which is 'presumptively unconstitutional.'" *Tam*, 137 S. Ct. at 1766 (Kennedy, J., concurring) (quoting *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829–830 (1995));

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9. For empirical analyses of the PTO's application of the scandalous-marks provision, *see, e.g.*, Emily Kustina, *Discriminatory Discretion: PTO Procedures and Viewpoint Discrimination Under Section 2(a) of the Lanham Act*, 164 U. Pa. L. Rev. 513 (2016); Megan Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L.J. 321 (2015); Anne LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476 (2011).

see also Reed v. Town of Gilbert, Ariz., 135 S. Ct. 2218, 2230 (2015).

II. THE SCANDALOUS-MARKS PROVISION FAILS STRICT AND INTERMEDIATE SCRUTINY.

The government zigzags through several doctrines, disclaiming any viewpoint discrimination, Pet. Br. 26-30, conceding content discrimination but denying the applicability of strict scrutiny, Pet. Br. 25-26, faintly invoking *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980), Pet. Br. 36-38, and ultimately arguing that the scandalous-marks provision is not a restriction on speech at all but merely a condition on the availability of a government benefit, to which highly deferential rational basis review applies. Pet. Br. 22-24, 31-40. This is all wrong.

A. Strict Scrutiny Dooms the Scandalous-Marks Provision.

Petitioner does not even attempt to argue that the scandalous-marks provision survives strict scrutiny, and with good reason. It does not. Section 1052(a)'s scandalous-marks provision is subject to the most stringent judicial review. Laws allowing the government to discriminate among speakers based on viewpoint or content are unacceptable absent narrow tailoring to serve a compelling government interest. *E.g., R.A.V. v. City of St. Paul*, 505 U.S. 377, 395 (1992).

Here, the government asserts interests in (1) "encouraging the use of marks that are appropriate for all audiences, including children," (2) "the orderly

flow of commerce," and (3) "avoiding any appearance of government approval of" scandalous marks. Pet. Br. 13. Even if these interests were compelling—and only the second one arguably is—the government makes no showing of how the scandalous-marks provision is narrowly tailored to serve these interests, nor could it.[10] The scandalous-marks provision thus fails strict scrutiny.

B. The Scandalous-Marks Provision Fails Intermediate Scrutiny Because It Is Not Narrowly Tailored To And Does Not Directly And Materially Advance A Substantial Government Interest.

The government seeks to take advantage of this Court's commercial speech jurisprudence, invoking *Central Hudson*, but in the service of the government's preferred rational basis standard of review. Pet. Br. 36-38. Petitioner does not attempt to argue that the scandalous-marks provision could withstand even intermediate scrutiny. It cannot.

Under *Central Hudson*, a restriction of speech must be narrowly tailored to serve a substantial government interest and must directly and materially advance that interest. *Central Hudson*, 447 U.S. at 566; *see also Edenfield v. Fane*, 507 U.S. 761, 767 (1993) (explaining

10. The government's interest in the orderly flow of commerce is arguably compelling, but it strains credulity to claim, as the government does, that scandalous marks are "disruptive" to the flow of commerce "by making commercial transactions less efficient." Pet. Br. 34. As the Federal Circuit noted, "the government has failed to articulate how this interest is in any way advanced by the [scandalous-marks provision]." Pet. App. 32a n.4.

that under *Central Hudson*, the Court "must ask whether . . . the challenged regulation advances [the government's] interests in a direct and material way"); *Bd. of Tr. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 479-80 (1989) (explaining that *Central Hudson* requires "not necessarily the least restrictive means but . . . a means narrowly tailored to achieve the desired objective"). It is the government's burden to justify its regulation of commercial speech as consistent with the First Amendment. *Sorrell*, 564 U.S. at 565.

The scandalous-marks provision is not narrowly tailored to serve—and does not directly and materially advance—any substantial government interest. The first asserted interest, which seeks to prevent offense, is inconsistent with the First Amendment to such a degree that the Supreme Court has "found it so 'obvious' as to not require explanation." *Simon & Schuster*, 502 U.S. at 115-16 (citation omitted). In any event, the government's reliance on the fact that Respondent remains free to use the mark without federal registration demonstrates that the scandalous-marks provision does not directly or materially serve the asserted interest. *See* Pet. Br. 23 ("the owner may continue using its mark—and any other vulgar term or image it wishes—to identify its goods in commerce").

Although the second asserted interest in the orderly flow of commerce is substantial, the government has failed to show how this interest is in any way advanced by the scandalous-marks provision. As already noted, it strains credulity to claim, as the government does, that scandalous marks are "disruptive" to the flow of commerce "by making commercial transactions less efficient." Pet.

Br. 34; *see Tam*, 137 S. Ct. at 1764-65 (Alito, J.) (rejecting a similar argument that the disparagement provision disrupts the flow of commerce). In any event, as the government concedes, refusing to register scandalous marks does not prevent their use in commerce. Pet. Br. 23.

The third asserted interest—avoiding any appearance of government approval of scandalous marks—is not served by the scandalous-marks provision, even assuming that the interest is substantial. *See* Pet. Br. 34-36. As the Court found in *Tam*, "[t]he PTO has made it clear that registration does not constitute approval of a mark. . . . And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means." 137 S. Ct. at 1759. Moreover, "there is no evidence that the pubic associates the contents of trademarks with the Federal Government." *Id.* at 1760. Thus, Petitioner is simply incorrect in claiming that "[t]he government's association with a registered mark is an unavoidable facet of the trademark-registration program." Pet. Br. 35. Rejecting registration of scandalous marks does nothing to avoid any appearance of government approval of such marks.

While failing to advance any compelling or substantial government interest, the scandalous-marks provision impermissibly chills expression. Entrepreneurs and advocates considering a slogan or name will wonder whether they can register it. They may think twice about whether the PTO will find it "offensive," but will have little ability to predict the vagaries of an examiner. "Many persons, rather than undertake the considerable burden (and sometimes risk) of vindicating their rights through case-by-case-litigation, will choose simply to abstain

from protected speech—harming not only themselves but society as a whole, which is deprived of an uninhibited marketplace of ideas." *Virginia v. Hicks*, 539 U.S. 113, 119 (2003). Consumers will suffer if they are deprived of a robust marketplace of goods, services, and ideas, as they will be under the government's approach, which requires providers of goods and services to play it safe, or to think twice before choosing a controversial logo or slogan because they may not have the endurance to fight the PTO. The Court should not allow the PTO—or members of the public whom the PTO attempts to protect from offense—to exercise a discretionary veto over speech it dislikes.

CONCLUSION

The decision of the Federal Circuit should be affirmed.

Respectfully submitted,

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In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE SIMON TAM IN SUPPORT OF RESPONDENT

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INTEREST OF AMICUS CURIAE[1]

Amicus Simon Tam is a musician, lecturer, and political activist. He is the founder of The Slants Foundation, a nonprofit organization dedicated to supporting the work of artists-activists. Tam was the respondent in *Matal v. Tam*, 137 S. Ct. 1744 (2017), thanks to which the name of his band—The Slants—is now a registered trademark. He has an interest in supporting the civil rights of members of marginalized communities, many of whom, like Tam, use trademarks as a means of expression.

SUMMARY OF ARGUMENT

The ban on registering "immoral" or "scandalous" trademarks is a relic of the Victorian era, when judges and other government officials were often enlisted to scrub public discourse of anything that might offend the most prudish sensibilities. Like the copyright law (which at the time also denied protection to ostensibly immoral works), the Comstock laws, and the early film censorship schemes, the ban on registering immoral trademarks was part of a world in which the government routinely restricted speech that government officials deemed to be immoral.

Needless to say, that world is long gone. We recognized long ago that Americans hold extremely diverse views of what is moral and what is not, and

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[1] No counsel for a party authored this brief in whole or in part, and no person other than amicus and his counsel made a monetary contribution intended to fund the preparation or submission of this brief. The parties have consented to the filing of this amicus brief.

that government officials have no business restricting non-obscene speech to enforce one view of morality over another. Today, the "immoral ... or scandalous" clause of the Lanham Act is a holdover from another age.

ARGUMENT

The ban on registering immoral trademarks is the last vestige of a Victorian legal culture in which government officials routinely restricted speech to promote morality.

Before the enactment of the Trademark Act of 1905, trademarks were governed by common law, under which an immoral mark was ineligible for protection. As one of the earliest American trademark treatises observed, "[t]o be a 'lawful trade-mark' the emblem must not transgress the rules of morality." William Henry Browne, *A Treatise on the Law of Trade-Marks* 465 (1873). This ban on immoral trademarks was incorporated in the Trademark Act of 1905, which required the Patent Office (as it was then called) to refuse registration to any mark that "[c]onsists of or comprises immoral or scandalous matter." Pub. L. No. 58-84, § 5(a), 33 Stat. 724, 725 (1905). *See* Harry D. Nims, *The Law of Unfair Competition and Trade-Marks* 384 (2d ed. 1917) ("The provision of the United States statute excluding from registration marks that are scandalous or immoral

in their purport, corresponds to the common-law rule.").[2]

At the time, there were many other areas of the law in which judges and other government officials were likewise enlisted to purge immorality from public discourse. In these other areas, however, public officials are no longer called upon to perform this role. Today, the prohibition on registering immoral trademarks stands as an anachronistic remnant of an era that vanished long ago.

A. When Congress banned the registration of immoral trademarks, there were many other areas of law in which judges and other officials restricted speech they considered immoral.

Trademark law circa 1905 was typical of the era's law in restricting speech to promote morality. We will discuss three examples: copyright, the Comstock laws, and film censorship.

1. Copyright

The most obvious analogue to trademark law was copyright law, which likewise denied protection to expression a court deemed immoral. *See, e.g.*, Easton S. Drone, *A Treatise on the Law of Property in Intellectual Productions* 185 (1879) ("The protection of the [copyright] law will not be extended to a publication which is obscene, or has a positive immoral tendency."); Joseph Story, *Commentaries on Equity Ju-*

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[2] The PTO has long treated "immoral" and "scandalous" as synonyms, so we will do the same. *Cf.* Gov't Br. 6 (also treating the two terms as synonyms).

risprudence 2:124 (Isaac F. Redfield ed., 10th ed. 1870) ("no copyright can exist, consistently with principles of public policy, in any work of a clearly irreligious, immoral, libellous, or obscene description").

For example, when the owner of a copyrighted play called "The Black Crook" sued an infringer who presented a nearly identical play called "The Black Rook," the court refused to enforce the copyright because the judge believed "The Black Crook" was immoral. "The principal part and attraction of the spectacle seems to be the exhibition of women in novel dress or no dress," he complained. *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867). "[T]he benefit of copyright is a privilege conferred by congress," the court declared. "In conferring this privilege or monopoly upon authors and inventors, I suppose that it is both proper and constitutional for congress so to legislate, as to encourage virtue and discourage immorality." *Id.*

Similarly, in a suit alleging the infringement of a copyrighted song entitled "Dora Dean," the court would not enforce the copyright because the song included this line: "She's the hottest thing you ever seen." *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78 (C.C.N.D. Cal. 1898). The court reasoned: "It is difficult to escape the conclusion that the word 'hottest,' as used in the song 'Dora Dean,' has an immoral signification." *Id.* at 79. The court concluded that the word "has an indelicate and vulgar meaning, and that for that reason the song cannot be protected by copyright." *Id.*

Another court denied copyright protection to a combined stage and film performance portraying "a

human being in nude or seminude conditions making quick changes of dress or costume," on the ground that it was "lascivious and immoral." *Barnes v. Miner*, 122 F. 480, 489 (C.C.S.D.N.Y. 1903). The performance was not "of a nature calculated to elevate, cultivate, inform, or improve the moral or intellectual natures of the audience," the court insisted. *Id.* Because it depicted "domestic infelicity and marital infidelity and gross immorality," it was not entitled to copyright. *Id.*

In such cases, courts earnestly believed they had a duty to shield the public from immoral speech. "The rights of the author are secondary to the right of the public, to be protected from what is subversive of good morals," one court declared. *Shook v. Daly*, 49 How. Pr. 366, 368 (N.Y. Ct. Comm. Pleas 1875). Courts thus refused "to vindicate the claims of any party to the exclusive enjoyment or disposal of an immoral or licentious production." *Keene v. Kimball*, 82 Mass. 545, 549 (1860). It was well established during the era that "[t]o be entitled to be copyrighted, the composition must be original, meritorious, and free from illegality or immorality." *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913) (internal quotation marks omitted).

It has been a very long time since copyright law was used to police morality. By the 1970s, such decisions had long been deemed "vestiges of a bygone era." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 861 (5th Cir. 1979). "[I]t is inappropriate for a court," the Fifth Circuit concluded, to use copyright law "to interpose its moral views between an author and his willing audience." *Id.* In stark contrast to the prim censoriousness of the Vic-

torians, we have come to recognize the wisdom of Justice Holmes's remark that it is "a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations" or indeed any other form of expression. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

2. The Comstock laws

When the ban on registering immoral trademarks was enacted, the state and federal governments were engaged in a similar effort to purge immoral materials from the marketplace and the mail. Under what were colloquially known as the Comstock laws (in honor of Anthony Comstock, their enthusiastic proponent), Congress prohibited the exhibition and sale of any "article of an immoral nature," 17 Stat. 598 (1873), and barred from the mail every "publication of a vulgar or indecent character," 17 Stat. 302 (1872). *See* Amy Werbel, *Lust on Trial: Censorship and the Rise of American Obscenity in the Age of Anthony Comstock* (2018).

In one typical case, the early libertarian Ezra Heywood was convicted and sentenced to two years in prison for publishing a short pamphlet called "Cupid's Yokes," in which he argued that marriage should be abolished. David M. Rabban, *Free Speech in Its Forgotten Years* 32-38 (1997). The pamphlet consisted entirely of policy arguments and could not have been thought, even then, to appeal to anyone's prurient interest. (The most heated passage is one in which Heywood calls Comstock "*a religious monomaniac*" who has contrived "to use the Federal Courts to suppress free inquiry." E.H. Heywood, *Cu-*

pid's Yokes 12 (1876).) The court nevertheless concluded that Heywood's pamphlet was "offensive to decency" and capable of causing "thoughts of an immoral tendency." *United States v. Bennett*, 24 F. Cas. 1093, 1104 (C.C.S.D.N.Y. 1879).

Similar cases were common during the period. In New York, a store clerk was convicted of selling photographs of paintings from the Salon in Paris and the Centennial Exhibition in Philadelphia, paintings that depicted nude women. The fact that experts considered the paintings fine art made no difference, in the view of the state Court of Appeals, because the images might "deprave or corrupt those whose minds are open to such immoral influences." *People v. Muller*, 96 N.Y. 408, 411 (1884). A St. Louis physician was convicted of placing in the mail his treatise on venereal disease, because, as the trial court charged the jury, the treatise included "immodest and indecent matter." *United States v. Clarke*, 38 F. 732, 733 (E.D. Mo. 1889). Even those who wrote sealed personal letters were prosecuted, on the theory that the purpose of the Comstock laws was "to purify the mails by stopping the dissemination of immoral and debasing matter" regardless of whether anyone but the addressee would read it. *United States v. Britton*, 17 F. 731, 732 (S.D. Ohio 1883).

Such opinions seem comically puritanical today, because our world is so different from the one inhabited by the judges and legislators of the era. In the late 19th and early 20th centuries, however, the managers of the legal system were committed to purifying discourse of all kinds, including trademarks.

3. Film censorship

As Americans began watching movies around the turn of the 20th century, judges and legislators placed great importance on preventing the public from seeing any immorality on the screen. *See* Lawrence M. Friedman, *Human Rights, Freedom of Expression, and the Rise of the Silver Screen*, 43 Hofstra L. Rev. 1 (2014). Many states and cities established censorship regimes that required a government official to approve a film as moral before it could be exhibited. *See, e.g.*, *Mutual Film Corp. v. Industrial Comm'n*, 236 U.S. 230, 240 (1915) (upholding an Ohio statute allowing the screening of "[o]nly such films as are, in the judgment and discretion of the board of censors, of a moral, educational, or amusing and harmless character").

In 1907, for example, Chicago enacted an ordinance prohibiting the exhibition of "immoral pictures." *Block v. City of Chicago*, 87 N.E. 1011, 1012 (Ill. 1909). Under this ordinance, the city banned the showing of a 1908 film called "The James Boys," which depicted the career of the outlaw Jesse James and his gang, who had committed a series of celebrated robberies approximately forty years earlier. "It is true that pictures representing the career of the 'James Boys' illustrate experiences connected with the history of the country," the Illinois Supreme Court acknowledged in upholding the ban—"but it does not follow that they are not immoral." *Id.* at 1016. The court reasoned that "[p]ictures which attempt to exhibit that career necessarily portray exhibitions of crime." *Id.* The court concluded of "The James Boys," along with another banned film: "They are both immoral, and their exhibition would neces-

sarily be attended with evil effects upon youthful spectators." *Id.*

A few years later, New York barred the exhibition of a film depicting the life of the birth control advocate Margaret Sanger, because the city official responsible for censoring films determined "that in his judgment the film tends to teach immorality." *Message Photo-Play Co. v. Bell*, 166 N.Y.S. 338, 341 (N.Y. App. Div. 1917). When the ban was challenged, the court had little doubt that "the action of the commissioner is justified, both in the interests of public decency and public welfare," because watching the film might cause audience members to develop an interest in using birth control. *Id.* at 344. "[I]t fairly appears," the court worried, "that the concentration of the minds of those in attendance at such a production on this question of birth control for a considerable period of time—for the film is long—may engender a desire to obtain the information, of the existence of which they are thus assured." *Id.*

These film censorship regimes were held unconstitutional long ago. *See, e.g., Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952); *Hallmark Prods., Inc. v. Carroll*, 121 A.2d 584 (Pa. 1956); *see generally* Samantha Barbas, *How the Movies Became Speech*, 64 Rutgers L. Rev. 665 (2012). But they were just getting off the ground in 1905, when Congress prohibited the registration of immoral trademarks. At the time, regulators and courts vigilantly policed speech of all kinds in order to prevent any sort of immorality from reaching the public.

B. The Lanham Act's "immoral ... or scandalous" clause is the last remnant of federal law authorizing the restriction of immoral but non-obscene speech.

There appear to be only two other federal statutes that, like the Lanham Act, still include text facially authorizing government officials to restrict speech for being immoral. These are the statutes governing obscenity. On their face, these statutes purport to govern *immoral* speech as well as *obscene* speech. 18 U.S.C. § 1461 bars obscene matter from the mail, as well as "[e]very paper, writing, advertisement, or representation ... for any indecent or immoral purpose." 18 U.S.C. § 1465 prohibits the production and transportation of obscene material, as well as "any other matter of indecent or immoral character."

In these two statutes, however, the "immoral" provisions have long been interpreted to be coextensive with the ban on obscenity. That is, for many years it has been the case that speech cannot be restricted as immoral if it is not obscene. *See, e.g.*, *United States v. 31 Photographs*, 156 F. Supp. 350, 352 n.2 (S.D.N.Y. 1957) ("I do not believe that the word 'immoral' adds to the class of material excluded from importation by the word 'obscene,' and the Government has not contended that it does."); *see also Manual Enters., Inc. v. Day*, 370 U.S. 478, 482-84 (1962) (lead opinion); *United States v. 12 200-Ft. Reels of Super 8MM. Film*, 413 U.S. 123, 130 n.7 (1973); *Hamling v. United States*, 418 U.S. 87, 112-14 (1974).

This narrowing construction has been necessary because the Court has made clear that while obscenity is unprotected by the First Amendment, speech

that is not obscene *is* protected even if some consider it immoral. "[W]here obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression." *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 (1977); *see also Roth v. United States*, 354 U.S. 476 (1957); *Miller v. California*, 413 U.S. 15 (1973). It has been well established for more than half a century that expression "should not be suppressed merely because it offends the moral code of the censor." *Roth*, 354 U.S. at 513 (Douglas, J., dissenting).

The Lanham Act thus appears to be the only surviving federal statute ostensibly authorizing the restriction of speech for being immoral but not obscene. When Congress enacted this provision in 1905, examples of such regulation were commonplace. Today, the "immoral ... or scandalous" clause of the Lanham Act is the last one standing.

C. The only interest advanced by the ban on registering immoral trademarks is the now-impermissible Victorian aim of insulating the public from offensive speech.

The government's brief demonstrates all too clearly that the only interest advanced by the "immoral ... or scandalous" clause is that of preventing members of the public from being offended by speech they consider immoral. The government offers a few different euphemisms for this interest: "protecting the sensibilities of the public," Gov't Br. 32; "encouraging the use of trademarks that are appropriate for all audiences," Gov't Br. 33; and preventing members of the public from viewing material they find "shocking

to the sense of propriety," Gov't Br. 34 (internal quotation marks and ellipsis omitted). These all mean the same thing—restricting speech that might offend some people because they find it immoral.

In 1905, when this provision was enacted, the First Amendment was an infrequent basis for litigation. First Amendment doctrine barely existed. The government routinely restricted speech on the ground that it might offend some people's sense of morality.

Today, by contrast, it is a staple of First Amendment jurisprudence that speech may not be restricted for the purpose of preventing listeners from being offended. *See Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (lead opinion) (rejecting the notion that "[t]he Government has an interest in preventing speech expressing ideas that offend"); *Snyder v. Phelps*, 562 U.S. 443, 458 (2011) ("[S]peech cannot be restricted simply because it is upsetting."); *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134-35 (1992) ("Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend."); *Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

The government's proffered interest is thus just as anachronistic as the "immoral ... or scandalous" clause itself. It would have been a good argument in 1905, but it hasn't been for a very long time.

CONCLUSION

The judgment of the U.S. Court of Appeals for the Federal Circuit should be affirmed.

Respectfully submitted,

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